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To: WILLIAM MCCULLOCH JR
Location: RND-6A49
Art Unit: 3714
Monday, April 12, 2010

Case Serial Number: 09/373034

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Search Notes

US Pat. 5655961 was involved in 2 past, but closed federal District Court cases.

Sources:

- Lexis/Nexis
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Continuity/Reexam Information for 08/322172

Parent Data

No Parent Data

Child Data

08465717, filed on 06/06/1995 ,now U.S. Patent #5836817 is a division of 08322172 , filed on 10/12/1994 ,now U.S. Patent #5655961

08465915, filed on 06/06/1995 ,now U.S. Patent #5752882 is a division of 08322172 , filed on 10/12/1994 ,now U.S. Patent #5655961

08465942, filed on 06/06/1995 ,now U.S. Patent #5741183 is a division of 08322172 , filed on 10/12/1994 ,now U.S. Patent #5655961

08467072, filed on 06/06/1995 ,now U.S. Patent #5702304 is a division of 08322172 , filed on 10/12/1994 ,now U.S. Patent #5655961

08467793, filed on 06/06/1995 ,now U.S. Patent #5820459 is a division of 08322172 , filed on 10/12/1994 ,now U.S. Patent #5655961

09373034, filed on 08/11/1999 and having 5 RCE-type filings therein, is a reissue of 08322172 , filed on 10/12/1994 ,now U.S. Patent #5655961

PCT/US95/11610, filed on 10/05/1995 is a continuation of 08322172 , filed on 10/12/1994 ,now U.S. Patent #5655961

322172 (08) 5655961 August 12, 1997 ,

UNITED STATES PATENT AND TRADEMARK OFFICE GRANTED PATENT

5655961

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August 12, 1997 ,

Method for operating networked gaming devices,

REISSUE:

August 11, 1999 - Reissue Application filed Ex. Gp.: 3711; Re. S.N. 09/373,034 , , (O.G. October 5, 1999) ,

APPL-NO: 322172 (08)

FILED-DATE: October 12, 1994

GRANTED-DATE: August 12, 1997 ,

ASSIGNEE-PRE-ISSUE:

October 12, 1994 - ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS)., ACRES GAMING, INC. 887 NW GRANT AVENUE CORVALLIS, OR 97330, 887 NW GRANT AVENUE, CORVALLIS, OREGON, UNITED STATES OF AMERICA (US), 97330, Reel and Frame Number: 007219/0610

ASSIGNEE-AT-ISSUE:

Acres Gaming, Inc., Corvallis, OREGON, United States of America (US)

ASSIGNEE-AFTER-ISSUE:

August 24, 2000 - SECURITY AGREEMENT, WELLS FARGO BANK MINNESOTA, NATIONAL ASSOCIATION SIXTH STREET AND MARGUETTE AVENUE MINNEAPOLIS, MINNESOTA, 55479, Reel and Frame Number: 011190/0948

August 24, 2000 - SECURITY INTEREST (SEE DOCUMENT FOR DETAILS)., WELLS FARGO BUSINESS CREDIT, INC., A MINNESOTA CORPORATION MAC S4101-076 100 W. WASHINGTON STREET, 7TH FLOOR PHOENIX, ARIZONA, 85003, Reel and Frame Number: 011190/0933

May 24, 2006 - ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS)., IGT 9295 PROTOTYPE DRIVE RENO NEVADA 89521-8986, 9295 PROTOTYPE DRIVE, RENO, NEVADA, UNITED STATES OF AMERICA (US), 89521-8986, Reel and Frame Number: 017663/0341

LEGAL-REP: Marger, Johnson, et al.

LEGAL-STATUS:

October 12, 1994 - ASSIGNMENT October 5, 1999 - REISSUE APPLICATION FILED August 24, 2000 - ASSIGNMENT August 24, 2000 - ASSIGNMENT May 24, 2006 - ASSIGNMENT

CORE TERMS: controller, player, message, machine, floor, card, tracking, gaming, bonus, jackpot, network, display, serial, payout, node, interface, reconfiguration, terminal, input,

bezel, identification, processing, connector, coin, loop, conductor, discrete, bonusing, slot, casino

Source: [Legal](#) > / . . . / > [Utility, Design and Plant Patents](#)

Terms: **patno=5655961** ([Edit Search](#) | [Suggest Terms for My Search](#))

View: [Custom](#)

Segments: Assignee, Cert-correction, Legal-rep, Legal-status, Lit-reex, Opposition, Patno, Reexam-cert, Reexam-litigate, Reissue, Reissue-comment, Title

Date/Time: Monday, April 12, 2010 - 1:58 PM EDT



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165 F.3d 891, *; 1998 U.S. App. LEXIS 33122, **;
49 U.S.P.Q.2D (BNA) 1308

MIKOHN GAMING CORPORATION, Plaintiff-Appellee, v. ACRES GAMING, INC., Defendant-Appellant.

98-1216, 98-1217

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

165 F.3d 891; 1998 U.S. App. LEXIS 33122; 49 U.S.P.Q.2D (BNA) 1308

December 30, 1998, Decided

PRIOR HISTORY: [**1] Appealed from: United States District Court for the District of Nevada. Chief Judge Howard D. McKibben.

DISPOSITION: INJUNCTION VACATED.

CASE SUMMARY:

PROCEDURAL POSTURE: Defendant appealed the grant of a preliminary injunction by the United States District Court for the District of Nevada, prohibiting defendant from stating to customers and prospective customers of plaintiff that plaintiff's product appeared to infringe on defendant's patent and pending patent applications.

OVERVIEW: Both plaintiff and defendant were in the business of manufacturing and selling gaming devices. Defendant stated to customers and prospective customers of plaintiff that one of plaintiff's products appeared to infringe on defendant's patent and pending patent applications. Plaintiff charged defendant with intentional interference with existing and prospective business relationships. The district court granted plaintiff's request that defendant be enjoined from making further statements to plaintiff's customers or potential customers. Defendant appealed. The court found that the torts of interference with actual or prospective business relationships required that the purportedly interfering communications be legally justified. This issue was governed by federal law regarding the giving of notice of patent rights. Because the record showed no more than a negligible likelihood of success in showing bad faith by defendant in giving notice regarding the alleged patent infringement, there was no strong showing of irreparable injury or that the balance of harms strongly favored plaintiff. Therefore, the grant of preliminary injunction was inappropriate.

OUTCOME: The grant of injunction was vacated, as there was little likelihood of success in showing bad faith by defendant and there was no strong showing of irreparable injury or that the balance of the harms strongly favored plaintiff.

CORE TERMS: patent, notice, preliminary injunction, patent rights, bad faith, gaming, patent law, infringer, infringe, infringement, business relationships, injunction, customers, patentee's, issuance, federal law, press release, potential customers, legal standard, enjoined, regional, common law, state tort, intentional interference, serious questions, injunctive relief, good faith, irreparable, competitive, vacated

LEXISNEXIS(R) HEADNOTES

Civil Procedure > Jurisdiction > Subject Matter Jurisdiction > Supplemental Jurisdiction > Same Case & Controversy

Governments > Courts > Common Law

Patent Law > Remedies > Declaratory Relief

HN1 ⁺ 28 U.S.C.S. § 1367 provides for pendent or supplemental jurisdiction in the federal courts for claims that form part of the same case or controversy.

Copyright Law > Civil Infringement Actions > Jurisdiction & Venue > General Overview

Patent Law > Jurisdiction & Review > Subject Matter Jurisdiction > General Overview

HN2 ⁺ See 28 U.S.C.S. § 1338(a).

Civil Procedure > Jurisdiction > Subject Matter Jurisdiction > Jurisdiction Over Actions > General Overview

Civil Procedure > Remedies > Injunctions > Preliminary & Temporary Injunctions

Civil Procedure > Appeals > General Overview

HN3 ⁺ The Federal Circuit has generally viewed the grant of a preliminary injunction as a matter of procedural law not unique to the exclusive jurisdiction of the Federal Circuit, and on appellate review has applied the procedural law of the regional circuit in which the case was brought.

Civil Procedure > Remedies > Injunctions > Preliminary & Temporary Injunctions

HN4 ⁺ The Ninth Circuit has stated the general criteria for grant of a preliminary injunction as follows: The moving party may meet its burden by demonstrating either (1) a combination of probable success on the merits and the possibility of irreparable injury or (2) that serious questions are raised and the balance of hardships tips sharply in its favor. These are not two distinct tests, but the poles of a continuum in which the required showing of harm varies inversely with the required showing of meritoriousness. The Ninth Circuit defines serious questions in this context as questions which cannot be resolved one way or the other at the hearing on the injunction and as to which the court perceives a need to preserve the status quo lest one side prevent resolution of the questions or execution of any judgment by altering the status quo. However, the serious questions must carry at least a fair chance of success on the merits in order to warrant interim relief.

Civil Procedure > Remedies > Injunctions > Preliminary & Temporary Injunctions

Civil Procedure > Appeals > Standards of Review > Abuse of Discretion

Civil Procedure > Appeals > Standards of Review > Clearly Erroneous Review

HN5 ⁺ The grant of a preliminary injunction shall be sustained on appeal unless the district court abused its discretion or based its decision on an erroneous legal standard or on clearly erroneous findings of facts. Abuse of discretion is a flexible term whose application can vary broadly. Thus the discretion of the district courts in issuing preliminary injunctions is reviewed with attention to the legal standards applied as well as the equitable considerations underlying the grant of preliminary relief.

Civil Procedure > Remedies > Injunctions > Preliminary & Temporary Injunctions

Civil Procedure > Appeals > Standards of Review

HN6 ⁺ Where the district court is alleged to have relied on erroneous legal premises, review is plenary, as is review of the correctness of the legal standards employed by the district court in evaluating the plaintiff's likelihood of success on the merits. However, the district court's estimates of the balance of harms and the

irreparability of injury, and any policy considerations, raise less tangible aspects whose equitable components may warrant more deferential review. Taken together, in granting a remedy or a restraint before a matter is litigated, the exercise of a power so far-reaching ought to be subject to effective, and not merely perfunctory, appellate review. When judicial discretion is exercised to restrain commercial communications, it is subject to special scrutiny.

Torts > Business Torts > Commercial Interference > Business Relationships > Defenses
Torts > Business Torts > Commercial Interference > Prospective Advantage > Elements

HN7 The tort of intentional interference with prospective business relations contains five elements. In order to prevail, a plaintiff would have to establish: (1) a prospective commercial relationship between the plaintiff and a third party; (2) the defendant's knowledge of this relationship; (3) the defendant's intent to harm the plaintiff by preventing the relationship; (4) the absence of privilege or justification for the defendant; and (5) actual harm to the plaintiff as a result of the defendant's conduct.

Torts > Business Torts > Commercial Interference > Business Relationships > Defenses
Torts > Business Torts > Commercial Interference > Contracts > General Overview
Torts > Business Torts > Commercial Interference > Prospective Advantage > General Overview

HN8 The tort of intentional interference with existing business relations requires: (1) the existence of a business relationship under which the plaintiff has some legal rights; (2) the defendant's knowledge of the relationship; (3) the defendant's intentional interference with that relationship in a manner that is not legally justified or excused; and (4) damage to the plaintiff.

Civil Procedure > Federal & State Interrelationships > General Overview

Constitutional Law > Supremacy Clause > General Overview

Torts > Business Torts > Commercial Interference > Prospective Advantage > Defenses

HN9 To the extent that conflict arises in the interaction between state commercial law and federal patent law, federal law must be applied.

Patent Law > Inequitable Conduct > Effect, Materiality & Scienter > Effect of Inequitable Conduct

Torts > Intentional Torts > Abuse of Process > Elements

Torts > Public Entity Liability > Liability > General Overview

HN10 Federal patent law bars the imposition of liability for publicizing a patent in the marketplace unless the plaintiff can show that the patent holder acted in bad faith. An allegation of inequitable conduct in obtaining a patent is not remediable by state action for abuse of process. It is inappropriate to provide another forum for collateral attack, under the common law, on proceedings for which federal process has been provided.

Patent Law > Infringement Actions > Exclusive Rights > General Overview

HN11 Communication to possible infringers concerning patent rights is not improper if the patent holder has a good faith belief in the accuracy of the communication. Although bad faith may encompass subjective as well as objective considerations, and the patent holder's notice is not irrelevant to a determination of bad faith, a competitive commercial purpose is not of itself improper, and bad faith is not supported when the information is objectively accurate. A threshold showing of incorrectness or falsity, or disregard for either, is required in order to find bad faith in the communication of information about the existence or pendency of patent rights. Indeed, a patentee, acting in good faith on its belief as to the

nature and scope of its rights, is fully permitted to press those rights even though he may misconceive what those rights are. Notifying infringers of the consequences of their infringement, by itself, cannot be said to be illegal.

Patent Law > Infringement Actions > Exclusive Rights > General Overview

HN12 It is not improper for a patent owner to advise possible infringers of its belief that a particular product may infringe the patent. A patentee has the right to inform a potential infringer of the existence of the patent, whereby the recipient of the information may adjust its activities, perhaps seek a license, or otherwise act to protect itself. 35 U.S.C.S. § 287 contemplates such notice.

Civil Procedure > Remedies > Injunctions > Preliminary & Temporary Injunctions

HN13 In determining whether to grant a motion for a preliminary injunction, the judge would be right to require a fairly clear-cut probability of success if he did not find that harm to the plaintiff outweighed harm to the defendant to a significant degree.

COUNSEL: Steven E. Shapiro, Mitchell, Silberberg & Knupp LLP, of Los Angeles, California, argued for plaintiff-appellee. With him on the brief was D. James Chung. Of counsel on the brief were Steve Morris and Adam P. Segal, Schreck Morris, of Las Vegas, Nevada.

Jerry A. Riedinger, Perkins Coie LLP, of Seattle, Washington, argued for defendant-appellant. Of counsel on the brief were Alan T. McCollom, and Stephen S. Ford, Marger, Johnson, McCollom & Stolowitz, of Portland, Oregon.

JUDGES: Before NEWMAN, RADER, and BRYSON, Circuit Judges.

OPINION BY: NEWMAN

OPINION

[*893] NEWMAN, Circuit Judge.

Acres Gaming, Inc. appeals the grant of a preliminary injunction by the United States District Court for the District of Nevada, ¹ prohibiting Acres from stating to customers and prospective customers of Mikohn Gaming Corporation and through the public press that Mikohn's MoneyTime System appears to infringe Acres '961 patent and pending patent applications. Since the criteria were not met for enjoining the giving of such notice, the injunction is vacated.

FOOTNOTES

¹ Mikohn Gaming Corp. v. Acres Gaming, Inc., No. CV-S-97-1383-HDM (LRL) (D. Nev. Jan. 13, 1998).

[**2] BACKGROUND

Both Acres and Mikohn are in the business of manufacturing and selling gaming devices such as slot machines. Acres owns United States Patent No. **5,655,961** entitled "Method for Operating Networked Gaming Devices," and several related patent applications. Acres sells a

gaming system called the "Hurricane Zone," which incorporates the inventions of the '961 patent and pending applications. Mikohn sells a competing gaming system called the "MoneyTime" system. The following excerpt from a letter to the Horseshoe Casino in Robinsonville, Mississippi is representative of notices that Acres sent to several of Mikohn's customers and potential customers upon issuance of the '961 patent. Acres stated:

It appears that the MoneyTime system manufactured and sold by Mikohn Corp. infringes at least some of the claims of the **[*894]** enclosed patent, although this cannot be determined conclusively without a better understanding of the structure and operation of the MoneyTime system.

There are a number of pending US applications owned by Acres Gaming which have the same disclosure as the '961 patent. . . .

You should be aware that when these patents issue, Acres Gaming intends to use **[**3]** its patents to stop use of such systems.

Acres also issued a press release announcing the grant of the '961 patent and stating, "Mikohn is clearly suffering in the marketplace as a result of the issuance of our patent. Customers naturally hesitate to do business with a company whose products appear to infringe a patent" The record does not show the extent of any publication of the release.

Mikohn responded by bringing suit in federal district court in Nevada, requesting a declaration that the MoneyTime System did not infringe the '961 patent. Mikohn also charged Acres with intentional interference with existing and potential business relationships, in violation of Nevada common law. The district court granted Mikohn's request that Acres be enjoined, pendente lite, from further statements to Mikohn's customers or potential customers "either orally or in writing, directly or indirectly, that Mikohn's MoneyTime System infringes on Acres' '961 patent or other pending patent application submitted by Acres to the United States Patent Office."

This appeal followed.

DISCUSSION

Federal jurisdiction was based on the declaratory action filed by Mikohn on the issue of patent **[**4]** infringement. See 28 U.S.C. '1338(a) ("arising under" jurisdiction in patent cases) ² and 28 U.S.C. '2201(a) (declaratory judgment action). ^{HNT} 28 U.S.C. '1367 provides for pendent or supplemental jurisdiction in the federal courts for claims that "form part of the same case or controversy," thus establishing jurisdiction in the district court of the common law tort of interference with business relationships. The issue for which injunction was sought was based on this common law cause of action. However, as we shall discuss, a notice of patent rights that is protected under federal law can not be held violative of state law on a different legal standard. The propriety of the preliminary injunction depends in part on the propriety of the action enjoined, which in turn depends on whether federal patent law or state tort law applies to the notice that Acres gave to its and Mikohn's customers and potential customers and released to the press.

FOOTNOTES

² ^{HNT} 28 U.S.C. '1338(a) provides:

The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, plant variety protection,

copyrights and trade-marks. Such jurisdiction shall be exclusive of the courts of the states in patent, plant variety protection and copyright cases.

[**5] A

^{HN3}↗ The Federal Circuit has generally viewed the grant of a preliminary injunction as a matter of procedural law not unique to the exclusive jurisdiction of the Federal Circuit, and on appellate review has applied the procedural law of the regional circuit in which the case was brought. *National Presto Indus., Inc. v. West Bend Co.*, 76 F.3d 1185, 1188 n.2, 37 U.S.P.Q.2D (BNA) 1685, 1686 n.2 (Fed. Cir. 1996) ("On procedural matters not unique to the areas that are exclusively assigned to the Federal Circuit, the law of the regional circuit shall be applied.") (citing *Lummus Indus. v. D.M. & E. Corp.*, 862 F.2d 267, 8 U.S.P.Q.2D (BNA) 1983 (Fed. Cir. 1988)).

While we recognize that the general considerations underlying the grant or denial of a preliminary injunction do not vary significantly among the circuits, we benefit from the wealth of Ninth Circuit precedent. We also take note that the Federal Circuit has itself built a body of precedent applying these general considerations to a large number of factually variant patent cases, and we give dominant effect to Federal Circuit precedent insofar as it reflects considerations specific to patent issues.³

FOOTNOTES

³ In *Hybritech Inc. v. Abbott Labs.*, 849 F.2d 1446, 1451 n.12, 7 U.S.P.Q.2D (BNA) 1191, 1195 n.12 (Fed. Cir. 1988), we said:

We note that confusion exists on the issue whether, in view of *Panduit Corp. v. All States Plastic Mfg. Co.*, 744 F.2d 1564, 1574-75, 223 U.S.P.Q. (BNA) 465, 471 (Fed. Cir. 1984)], Federal Circuit law or regional circuit law provides the standards governing the issuance of an injunction pursuant to ' 283. Because the issuance of an injunction pursuant to this section enjoins "the violation of any right secured by a patent, on such terms as the court deems reasonable," a preliminary injunction of this type, although a procedural matter, involves substantive matters unique to patent law and, therefore, is governed by the law of this court. We recognize, however, that purely procedural questions involving the grant of a preliminary injunction are controlled by the law of the appropriate regional circuit.

[**6] ^{HN4}↗

[*895] The Ninth Circuit has stated the general criteria for grant of a preliminary injunction as follows: "The moving party may meet its burden by demonstrating either (1) a combination of probable success on the merits and the possibility of irreparable injury or (2) that serious questions are raised and the balance of hardships tips sharply in its favor." *Dollar Rent A Car v. Travelers Indemnity Co.*, 774 F.2d 1371, 1374-75 (9th Cir. 1985). These are not two distinct tests, but the poles of a "continuum in which the required showing of harm varies inversely with the required showing of meritoriousness." *Rodeo Collection, Ltd. v. West Seventh*, 812 F.2d 1215, 1217 (9th Cir. 1987). The Ninth Circuit defines "serious questions" in this context as "questions which cannot be resolved one way or the

other at the hearing on the injunction and as to which the court perceives a need to preserve the status quo lest one side prevent resolution of the questions or execution of any judgment by altering the status quo." Republic of the Philippines v. Marcos, 862 F.2d 1355, 1362 (9th Cir. 1988). However, the "serious questions" must carry at least a "fair chance of success on the merits" in **[**7]** order to warrant interim relief. National Wildlife Federation v. Coston, 773 F.2d 1513, 1517 (9th Cir. 1985).

HNS The oft-stated rule is that the grant of a preliminary injunction shall be sustained on appeal unless "the district court abused its discretion or based its decision on an erroneous legal standard or on clearly erroneous findings of facts." FDIC v. Garner, 125 F.3d 1272, 1276 (9th Cir. 1997). See Hybritech Inc. v. Abbott Labs., 849 F.2d 1446, 1449, 7 U.S.P.Q.2D (BNA) 1191, 1194 (Fed. Cir. 1988) (appellate review is "limited to determining whether, in granting the preliminary injunction, the district court abused its discretion, committed an error of law, or seriously misjudged the evidence.")

Abuse of discretion is a flexible term whose application can vary broadly. Thus the discretion of the district courts in issuing preliminary injunctions is reviewed with attention to the legal standards applied as well as the equitable considerations underlying the grant of preliminary relief. **HNG** "Where the district court is alleged to have relied on erroneous legal premises, review is plenary." Does 1-5 v. Chandler, 83 F.3d 1150, 1152 (9th Cir. 1996), as is review of "the correctness **[**8]** of the legal standards employed by the district court in evaluating the plaintiff's likelihood of success on the merits," Associated General Contractors v. Coalition for Economic Equity, 950 F.2d 1401, 1405 (9th Cir. 1991). However, the district court's estimates of the balance of harms and the irreparability of injury, and any policy considerations, raise less tangible aspects whose equitable components may warrant more deferential review.

Taken together, in granting a remedy or a restraint before a matter is litigated, "the exercise of a power so far-reaching ought to be subject to effective, and not merely perfunctory, appellate review." Roland Machinery Co. v. Dresser Industries Co., 749 F.2d 380, 389 (7th Cir. 1984). When judicial discretion is exercised to restrain commercial communications, it is subject to special scrutiny.

B

The district court held that Mikohn's charge of intentional interference with present and prospective business relationships warranted preliminary injunctive relief. The court explained that "while the following statement in the letter 'it appears that the MoneyTime slot machine infringes' Acres' patent, may not be a statement of fact, **[**9]** all of the statements taken as a whole, including the statements made in the newspaper, the **[*896]** Court concludes could be construed as stating that Mikohn's product does indeed infringe Acres patents, and the jury, the trier of fact, could find that the statement was made and that it was untrue."

Mikohn argued, and the district court apparently agreed, that Acres' statements concerning its patent rights and intentions to enforce them were intended to achieve competitive advantage in an improper way, and grounded the grant of preliminary relief on the count of intentional interference with Mikohn's business relationships. The district court did not discuss the truth or falsity of the statements in Acres' letters or the press release, or the likelihood of Acres' success on a patent infringement claim, other than to conclude that the statements could be understood by the recipient as meaning that Mikohn's system indeed infringes Acres' patent rights. The court's explanation that a jury could find that Acres' patent rights were not infringed was not an evaluation of the merits of possible infringement, or of the likelihood of such a finding by the jury; it was simply a statement of the vagaries **[**10]** of litigation.

As set forth in *Leavitt v. Leisure Sports Incorporation*, 103 Nev. 81, 734 P.2d 1221 (1987), ^{HNS} the tort of intentional interference with prospective business relations contains five elements. In order to prevail, Mikohn as plaintiff would have to establish 1) a prospective commercial relationship between the plaintiff and a third party, 2) the defendant's knowledge of this relationship, 3) the defendant's intent to harm the plaintiff by preventing the relationship, 4) the absence of privilege or justification for the defendant, and 5) actual harm to the plaintiff as a result of the defendant's conduct. *Id.* at 88 (citing *Buckaloo v. Johnson*, 14 Cal. 3d 815, 122 Cal. Rptr. 745, 537 P.2d 865 (1975)). Similarly, ^{HNS} the tort of intentional interference with existing (as contrasted with prospective) business relations requires (1) the existence of a business relationship under which the plaintiff has some legal rights, (2) the defendant's knowledge of the relationship, (3) the defendant's intentional interference with that relationship in a manner that is not legally justified or excused, and (4) damage to the plaintiff. *Feminist Women's Health Ctr., Inc. v. Mohammad*, **[**11]** 586 F.2d 530, 551 (5th Cir. 1978) (cited with approval in *Collins v. Union Federal Savings & Loan Ass'n*, 99 Nev. 284, 301, 662 P.2d 610 (1983)).

The torts of interference with actual or prospective business relationships require that the purportedly interfering communications or other conduct not be legally justified. However, whether Acres' communications were legally justified raises considerations of federal law governing the giving of notice of patent rights. ^{HNS} To the extent that conflict arises in the interaction between state commercial law and federal patent law, federal law must be applied.

The only basis for this action of tortious interference with business relationships was Acres' giving of notice of its patent rights and the intent to enforce them. The propriety of that notice depends on patent law and the patent issues to which the notice pertains. National uniformity, in confluence with the national scope of the patent grant and the general federal exclusivity in patent causes, require that determination of the propriety of Acres' actions in giving notice of its patent rights is governed by federal statute and precedent and is not a matter of state tort law. Thus **[**12]** in *Hunter Douglas, Inc. v. Harmonic Design, Inc.*, 153 F.3d 1318, 1336, 47 U.S.P.Q.2D (BNA) 1769, 1782 (Fed. Cir. 1998) the court observed that ^{HN10} "federal patent law bars the imposition of liability for publicizing a patent in the marketplace unless the plaintiff can show that the patent holder acted in bad faith." In *Abbott Laboratories v. Brennan*, 952 F.2d 1346, 1355-57, 21 U.S.P.Q.2D (BNA) 1192, 1199-1201 (Fed. Cir. 1991) the court held that the allegation of inequitable conduct in obtaining a patent is not remediable by state action for abuse of process. This court affirmed the inappropriateness of "providing another forum for collateral attack, under the common law, on proceedings for which federal process has been provided."

C

Acres states that its letters and press release concerning its patent rights were accurate factual statements and proper notice under the patent law, and thus can not be **[*897]** enjoined under state law. Acres states that bad faith, a necessary element of improper notice under federal patent law, was not shown and can not be inferred on these facts. Mikohn disputes Acres' motive, stating that at best the giving of notice was premature, pointing to Acres' statement in **[**13]** the letters and press release that infringement had not been "determined conclusively" and the fact that Acres had not charged Mikohn with infringement when it sent these letters to potential customers.

Mikohn states that Acres' communications were written in order to intimidate prospective customers, and that Acres' purpose was to obtain an unfair business advantage by placing the Mikohn product under a cloud of potential litigation. Mikohn states that Acres had no intention of bringing suit, and argues that such behavior justifies injunctive relief, citing

Mallinckrodt, Inc. v. Medipart, Inc., 976 F.2d 700, 710, 24 U.S.P.Q.2D (BNA) 1173, 1181 (Fed. Cir. 1992) ("Infringement notices have been enjoined when the patentee acted in bad faith, for example by making threats without intending to file suit") and Betmar Hats, Inc. v. Young America Hats, Inc., 116 F.2d 956, 957, 48 U.S.P.Q. (BNA) 266, 267 (2d Cir.1941) ("Persistent threats to the trade, unsupported by any attempt to have the patentee's claims established by suit, will not be permitted. Failure to assert their rights in the customary way indicated a lack of good faith on the part of the defendants.") (citations omitted). Acres responds **[**14]** that its letters were an accurate statement of its knowledge at that stage, and that it had not yet verified infringement because that would require discovery of the inner workings of the MoneyTime system.

In general, Mikohn's position takes its support from state tort law, and Acres from federal patent law. **HN11** Federal precedent is that communication to possible infringers concerning patent rights is not improper if the patent holder has a good faith belief in the accuracy of the communication. Although "bad faith" may encompass subjective as well as objective considerations, and the patent holder's notice is not irrelevant to a determination of bad faith, a competitive commercial purpose is not of itself improper, and bad faith is not supported when the information is objectively accurate. In general, a threshold showing of incorrectness or falsity, or disregard for either, is required in order to find bad faith in the communication of information about the existence or pendency of patent rights. Indeed, a patentee, acting in good faith on its belief as to the nature and scope of its rights, is fully permitted to press those rights "even though he may misconceive what those rights are." **[**15]** Kaplan v. Helenhart Novelty Co., 182 F.2d 311, 314, 85 U.S.P.Q. (BNA) 285, 287 (2d Cir. 1950). It has long been recognized that "Patents would be of little value if infringers of them could not be notified of the consequences of infringement or proceeded against in the courts. Such action considered by itself cannot be said to be illegal." Virtue v. Creamery Package Mfg. Co., 227 U.S. 8, 37-38, 57 L. Ed. 393, 33 S. Ct. 202 (1913).

HN12 Thus federal authority makes clear that it is not improper for a patent owner to advise possible infringers of its belief that a particular product may infringe the patent. Scosche Indus., Inc. v. Visor Gear Inc., 121 F.3d 675, 681, 43 U.S.P.Q.2D (BNA) 1659, 1664 (Fed. Cir. 1997). See, e.g., Mallinckrodt, Inc. v. Medipart, Inc., 976 F.2d 700, 709, 24 U.S.P.Q.2D (BNA) 1173, 1180 (Fed. Cir. 1992) (a patentee "that has a good faith belief that its patents are being infringed violates no protected right when it so notifies infringers"); Concrete Unlimited, Inc. v. Cementcraft, Inc., 776 F.2d 1537, 1539, 227 U.S.P.Q. (BNA) 784, 785 (Fed. Cir. 1985) (patentee "did only what any patent owner has the right to do to enforce its patent, and that includes threatening alleged infringers **[**16]** with suit").

A patentee has the right to inform a potential infringer of the existence of the patent, whereby the recipient of the information may adjust its activities, perhaps seek a license, or otherwise act to protect itself. Virginia Panel Corp. v. MAC Panel Co., 133 F.3d 860, 869, 45 U.S.P.Q.2D (BNA) 1225, 1232 (Fed. Cir. 1997). The statute contemplates such notice. See 35 U.S.C. '287 (Limitation on damages and other remedies; marking and notice). Federal law has uniformly upheld a patentee's right to publicize the issuance of patents and to so inform potential infringers.

[*898] D

We apply federal patent law and precedent relating to the giving of notice of patent rights, in reviewing the grant of an injunction against the giving of such notice. As we have discussed, federal law requires a showing of bad faith in order to bar such communications. Communication of accurate information about patent rights, whether by direct notice to potential infringers or by publicity release, does not support a finding of bad faith. Indeed, judicially-mandated silence would preserve the ignorance of potential infringers, to the possible benefit of Mikohn but to the possible detriment of others **[**17]** whose liability

could build.

The grant of the preliminary injunction, then, is reviewed in the context of whether, under applicable federal law, the notice of patent rights was properly given. The record provided shows no more than a negligible likelihood of success in showing bad faith in Acres' giving of notice by letters and publicity release. In addition, there was no strong showing of irreparable injury or that the balance of harms strongly favored Mikohn. See *Sampson v. Murray*, 415 U.S. 61, 88, 39 L. Ed. 2d 166, 94 S. Ct. 937 (1974) ("The basis of injunctive relief in the federal courts has always been irreparable harm and inadequacy of legal remedies.") (quoting *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 506-07, 3 L. Ed. 2d 988, 79 S. Ct. 948 (1959)). As explained in *Maxim's, Ltd. v. Badonsky*, 772 F.2d 388, 391, 227 U.S.P.Q. (BNA) 316, 318 (7th Cir. 1985) ^{HN13} the judge "would be right to require a fairly clear-cut probability of success if he did not find that harm to the plaintiff outweighed harm to the defendant to a significant degree." The district court made no reference to the public interest, or to the interest of those to whom the letters were directed.

Although **[**18]** Mikohn states that Acres' purpose was not the giving of notice as a matter of objective information, but as a carefully crafted competitive tactic, this allegation, even if true, does not substitute for the obligation to satisfy the factors predicate to the grant of a preliminary injunction. On the factors before the district court, applying federal law, it exceeded the court's discretionary authority to enjoin Acres' dissemination of information concerning its patent rights. The preliminary injunction is vacated.

Costs

Each party shall bear its costs.

INJUNCTION VACATED







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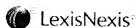
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* Signal Legend:

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610 F. Supp. 2d 288, *; 2009 U.S. Dist. LEXIS 37531, **

IGT, Plaintiff, v. BALLY GAMING INTERNATIONAL INC., et al., Defendants.

Civ. No. 06-282-SLR

UNITED STATES DISTRICT COURT FOR THE DISTRICT OF DELAWARE

610 F. Supp. 2d 288; 2009 U.S. Dist. LEXIS 37531

April 28, 2009, Decided

SUBSEQUENT HISTORY: Injunction denied by, Motion to strike denied by, As moot IGT v. Bally Gaming Int'l., Inc., 2009 U.S. Dist. LEXIS 120065 (D. Del., Dec. 22, 2009)

PRIOR HISTORY: IGT v. Bally Gaming Int'l. Inc., 610 F. Supp. 2d 288, 2009 U.S. Dist. LEXIS 37496 (D. Del., 2009)

CASE SUMMARY:

PROCEDURAL POSTURE: Plaintiff patentee filed a patent infringement case against defendant competitor. The competitor filed counterclaims of invalidity and unenforceability of these patents. Both parties filed motions for summary judgment.

OVERVIEW: This suit related to patents for casino slot machine technology that would network gaming machine to track the play of individual players and, among other things, provide them with player rewards. The patentee alleged that the competitor's technology infringed claims from three of its patents. After the court undertook an analysis of each of the patent claims and the competitor's products, it concluded that the patentee was entitled to summary judgment of infringement on many of the claims. However, it denied summary judgment of infringement as to certain claims. Overall, it found that there was infringement of claims from each of the three patents. As to the competitor's counterclaims of patent invalidity, the court denied the competitor's motion for summary judgment. For example, the competitor failed to demonstrate that summary judgment of obviousness based on any of several different examples of prior art was appropriate. The court also granted the patentee's motions for summary judgment of validity as to two of the patents. For example, the court found no obviousness and no anticipation by certain prior references to the patents at issue.


OUTCOME: The court granted in part and denied in part the patentee's motion for summary judgment of infringement. The court also granted in part and denied in part the competitor's motion for summary judgment of non-infringement. The patentee's motion for summary judgment of validity of two patents was granted and the competitor's motions for summary judgment of invalidity of the three patents was denied.

CORE TERMS: gaming, player, machine, casino's, bonus, winner, controller, promotion, promotional, message, reward, patron, predetermined, memory, responsive, occurrence, disclose, patent, host, prior art, network, progressive, jackpot, winning, invention, skill, summary judgment, issuing, infringement, payout

LEXISNEXIS(R) HEADNOTES


Civil Procedure > Summary Judgment > Burdens of Production & Proof > General Overview

Civil Procedure > Summary Judgment > Standards > General Overview

HN1  A court shall grant summary judgment only if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The moving party bears the burden of proving that no genuine issue of material fact exists. Facts that could alter the outcome are material, and disputes are genuine if evidence exists from which a rational person could conclude that the position of the person with the burden of proof on the disputed issue is correct. If the moving party has demonstrated an absence of material fact, the nonmoving party then must come forward with specific facts showing that there is a genuine issue for trial.

Civil Procedure > Summary Judgment > Evidence


Civil Procedure > Summary Judgment > Standards > General Overview

HN2  With respect to a motion for summary judgment, the court will view the underlying facts and all reasonable inferences therefrom in the light most favorable to the party opposing the motion. The mere existence of some evidence in support of the nonmoving party, however, will not be sufficient for denial of a motion for summary judgment; there must be enough evidence to enable a jury reasonably to find for the nonmoving party on that issue. If the nonmoving party fails to make a sufficient showing on an essential element of its case with respect to which it has the burden of proof, the moving party is entitled to judgment as a matter of law.


Patent Law > Infringement Actions > General Overview

Patent Law > Infringement Actions > Burdens of Proof

Patent Law > Infringement Actions > Claim Interpretation > Fact & Law Issues


HN3  A patent is infringed when a person without authority makes, uses or sells any patented invention, within the United States during the term of the patent. 35 U.S.C.S. § 271(a). A court should employ a two-step analysis in making an infringement determination. First, the court must construe the asserted claims to ascertain their meaning and scope. Construction of the claims is a question of law subject to de novo review. The trier of fact must then compare the properly construed claims with the accused infringing product. This second step is a question of fact. Literal infringement occurs where each limitation of at least one claim of the patent is found exactly in the alleged infringer's product. If any claim limitation is absent from the accused device, there is no literal infringement as a matter of law. If an accused product does not infringe an independent claim, it also does not infringe any claim depending thereon. The patent owner has the burden of proving infringement and must meet its burden by a preponderance of the evidence.

Patent Law > Infringement Actions > Infringing Acts > General Overview

HN4  An accused device may be found to infringe if it is reasonably capable of satisfying the claim limitations, even though it may also be capable of non-infringing modes of operation.


Patent Law > Infringement Actions > Burdens of Proof

Patent Law > Infringement Actions > Defenses > Patent Invalidity > Validity Presumption


HN5  Issued patents are presumed valid, and the underlying determination of invalidity

must be predicated on facts established by clear and convincing evidence. The United States Court of Appeals for the Federal Circuit has stated that this burden is especially difficult when the asserted prior art was before the Patent and Trademark Office examiner during prosecution of the application. The presumption of validity under 35 U.S.C.S. § 282 carries with it a presumption that the examiner did his duty and knew what claims he was allowing.


Patent Law > Anticipation & Novelty > General Overview

HN6  An anticipation inquiry involves two steps. First, the court must construe the claims of the patent in suit as a matter of law. Second, the finder of fact must compare the construed claims against the prior art.

Patent Law > Anticipation & Novelty > Elements

HN7  Proving a patent invalid by anticipation requires that the four corners of a single, prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. There must be no difference between the claimed invention and the referenced disclosure, as viewed by a person of ordinary skill in the field of the invention. The elements of the claimed invention must be arranged or combined in the same manner as in the claim, but the reference need not satisfy an *ipse dixit* test. In determining whether a patented invention is explicitly anticipated, the claims are read in the context of the patent specification in which they arise and in which the invention is described. The prosecution history and the prior art may be consulted if needed to impart clarity or avoid ambiguity in ascertaining whether the invention is novel or was previously known in the art.


Patent Law > Anticipation & Novelty > Elements

HN8  A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled. Additionally, the reference must enable one of ordinary skill in the art to make the invention without undue experimentation. As long as the reference discloses all of the claim limitations and enables the subject matter that falls within the scope of the claims at issue, the reference anticipates - no actual creation or reduction to practice is required.


Patent Law > Nonobviousness > Elements & Tests > General Overview

Patent Law > Nonobviousness > Elements & Tests > Secondary Considerations

Patent Law > Nonobviousness > Evidence & Procedure > Fact & Law Issues

HN9  A patent may not be obtained if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. 35 U.S.C.S. § 103(a). Obviousness is a question of law, which depends on several underlying factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

Patent Law > Nonobviousness > Evidence & Procedure > Presumptions & Proof

HN10  Because patents are presumed to be valid, 35 U.S.C.S. § 282, an alleged

infringer seeking to invalidate a patent on obviousness grounds must establish its obviousness by facts supported by clear and convincing evidence.

Patent Law > Infringement Actions > Burdens of Proof

Patent Law > Nonobviousness > Elements & Tests > Prior Art

Patent Law > Nonobviousness > Evidence & Procedure > Presumptions & Proof

HN11 ⚡ A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Likewise, a defendant asserting obviousness in view of a combination of references has the burden to show, by clear and convincing evidence, that a person of ordinary skill in the relevant field had a reason to combine the elements in the manner claimed. The Supreme Court has emphasized the need for courts to value common sense over rigid preventative rules in determining whether a motivation to combine existed. Any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed. In addition to showing that a person of ordinary skill in the art would have had reason to attempt to make the composition or device, or carry out the claimed process, a defendant must also demonstrate, by clear and convincing evidence, that such a person would have had a reasonable expectation of success in doing so.

Patent Law > U.S. Patent & Trademark Office Proceedings > General Overview

HN12 ⚡ Non-final opinions and decisions issued by the Patent and Trademark Office are not binding on federal district courts and such decisions are ultimately not final absent review by the United States Court of Appeals for the Federal Circuit.

Patent Law > Anticipation & Novelty > General Overview

HN13 ⚡ Typically, testimony concerning anticipation of a patent must be testimony from one skilled in the art.

Patent Law > Nonobviousness > Elements & Tests > General Overview

HN14 ⚡ In appropriate circumstances, a single prior art reference can render a claim obvious. However, there must be a showing of a suggestion or motivation to modify the teachings of that reference to the claimed invention in order to support the obviousness conclusion. This suggestion or motivation may be derived from the prior art reference itself, from the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved.

Patent Law > Nonobviousness > General Overview

HN15 ⚡ See 35 U.S.C.S. § 103(a).

Patent Law > Nonobviousness > Elements & Tests > Prior Art

HN16 ⚡ A prior art reference may anticipate without explicitly disclosing a feature of the claimed invention if that missing characteristic is inherently present in the single anticipating reference. An inherent limitation is one that is necessarily present and not one that may be established by probabilities or possibilities. That is, the mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Patent Law > Infringement Actions > Claim Interpretation > General Overview

Patent Law > Infringement Actions > Claim Interpretation > Fact & Law Issues

HN17 ⚡ In patent cases, incorporation by reference is a legal issue to be determined by the court. Incorporation by reference requires a statement clearly identifying the subject matter which is incorporated and where it is to be found. A mere

reference to another application, or patent, or publication is not an incorporation of anything contained therein. Put another way, the host document must cite the material in a manner that makes clear that it is effectively part of the host document as if it were explicitly contained therein. It must, therefore, both (1) identify with detailed particularity what specific material it incorporates; and (2) clearly indicate where that material is found in the various documents.

Patent Law > Nonobviousness > Elements & Tests > Claimed Invention as a Whole

Patent Law > Nonobviousness > Elements & Tests > Prior Art

HN18 + In determining obviousness, the inquiry is not whether each limitation existed in the prior art, but whether the prior art made obvious the claimed invention as a whole.

Patent Law > Nonobviousness > Elements & Tests > General Overview

Patent Law > Nonobviousness > Elements & Tests > Ordinary Skill Standard

HN19 + The test for obviousness is not whether it would have been obvious to try to make the invention. Further, the decision of obviousness vel non is made not from the viewpoint of the inventor, but from the viewpoint of a person of ordinary skill in the field of the invention.

Patent Law > Nonobviousness > Elements & Tests > Prior Art

HN20 + With respect to obviousness, there is no absolute requirement that each patent claim limitation be disclosed in a prior art reference, however, it is the rare invention that is not a combination of prior art elements.

COUNSEL: **[**1]** William J. Wade, Esquire and Anne Shea Gaza, Esquire of Richards, Layton & Finger, Wilmington, Delaware. Counsel for Plaintiff. Of Counsel: David P. Enzminger, Esquire and David P. Dalke, Esquire of O'Melveny & Myers LLP, Los Angeles, California.

Jack B. Blumenfeld, Esquire and Karen Jacobs Loudon, Esquire of Morris, Nichols, Arst & Tunnell LLP, Wilmington, Delaware. Counsel for Defendants. Of Counsel: Charles K. Verhoeven, Esquire of Quinn Emanuel Urquhart Oliver & Hedges, LLP, San Francisco, California; Edward J. DeFranco, Esquire and Alexander Rudis, Esquire of Quinn Emanuel Urquhart Oliver & Hedges, LLP, New York, New York.

JUDGES: Sue L. Robinson, United States District Judge.

OPINION BY: Sue L. Robinson

OPINION

[*295] MEMORANDUM OPINION

Dated: April 28, 2009

Wilmington, Delaware

Sue L. Robinson, District Judge

I. INTRODUCTION

IGT ("plaintiff") filed this action against Bally Gaming International Inc., Bally Technologies, Inc. and Bally Gaming, Inc. d/b/a Bally Technologies (collectively, "Bally" or "defendants") on April 28, 2006, alleging infringement of U.S. Patent Nos. RE 38,812 ("the '812 patent"), RE 37,885 ("the '885 patent"), 6,832,958 ("the '2958 patent"), 6,319,125 ("the '125 patent"), 6,224,958 ("the '4958 patent") [****2**], 6,431,983 ("the '983 patent"), 6,607,441 ("the '441 patent"), 6,565,434 ("the '434 patent"), and 6,620,046 ("the '046 patent"). (D.I. 1) ¹ Plaintiff alleges that defendants' "Bally Power Bonus(R)" slot machine technology infringes one or more claims of the asserted patents.

FOOTNOTES

¹ Plaintiff originally filed the complaint in the name of "International Game Technology" (D.I. 1); plaintiff amended its complaint on May 8, 2005 and recaptioned itself "IGT." (D.I. 6)

On June 30, 2006, defendants filed their answer, and asserted counterclaims for a declaratory judgment of noninfringement, invalidity and unenforceability of each asserted patent (counts I - IX); attempted monopolization in violation of Section 2 of the Sherman Antitrust Act, 15 U.S.C. § 2 (count X); false representation in violation of the Lanham Act, 15 U.S.C. § 1125 (count XI); and "intentional interference with business relationships" (count XII). (D.I. 40) Plaintiff moved to dismiss defendants' counterclaim counts X - XII. (D.I. 53) Plaintiff also moved for a preliminary injunction. (D.I. 75) The case was assigned to this judicial officer on April 2, 2007. Following a discovery conference, on June 21, 2007, plaintiff's [****3**] pending motions were withdrawn. Discovery proceeded and has now since closed. (D.I. 160, 175)

On February 25, 2008, by agreement of the parties, all claims, defenses, and counterclaims related to the '125, '434, '4958, '046, and '2958 patents were dismissed. (D.I. 152) The parties entered into an agreement on May 14, 2008 removing the '441 patent from issue. (D.I. 165) Remaining at issue is infringement of the '812, '885, and '983 patents, defendants' counterclaims of invalidity and unenforceability of these patents, and defendants' counts X-XII. This case is set for a jury trial commencing May 26, 2009.

Currently pending before the court are seven motions for summary judgment. Plaintiff has filed motions: (1) of infringement (D.I. 178); (2) of validity of the '885 and '812 patents (D.I. 180); and (3) that Bally does not have either an express or implied license to practice the '885, '812, or '983 patents ("no licensing defense") (D.I. 182). Defendants have filed motions: (1) of noninfringement (D.I. 191); (2) of invalidity of the '983 patent (D.I. 193); (3) of invalidity of the '885 and '812 patents (D.I. 219); and (4) that Bally has a valid license defense with respect to the '983 patent [****4**] (D.I. 221). ² The court has jurisdiction [***296**] over these matters pursuant to 28 U.S.C. § 1338.

FOOTNOTES

² Plaintiff objects to the latter two motions as having been filed outside of the schedule and the parties' agreed-upon extensions. The court's consideration of these cross motions, the subject matter of which is already before the court, does not prejudice plaintiff. In addition, defendants have not filed a reply brief in support of either motion.

II. BACKGROUND

A. Technology at issue

This suit relates to casino slot machine technology and player rewards. Casino slot machines may be networked together. Networking allows for advantages such as the casino's ability to monitor patrons' slot play and to extract accounting data from individual machines.

(JA01631-32) Monitoring systems require the use of player-tracking cards (hereinafter "PTC"s) and machines equipped with card-tracking devices. Casinos typically issue PTCs to patrons who sign up for an account through the casino's promotions department, and use PTCs to track play, allow players to obtain rewards or participate in promotions when their PTC is in use, and to enable players to access funds that they previously have deposited with the casino. [**5] for use at a gaming device or table. The casino maintains a database of its patrons on a host computer. PTCs can be inserted into a tracking device that includes a magnetic card reader, display for messages and a keypad to accept any inputs from the patron; such devices are typically found on slot machines.

Both parties in this case provide software products used by casinos to provide awards to players who are gambling on a networked gaming device such as a slot machine. Such "bonusing" increases player loyalty and entertainment, and can be provided in many ways, such as by special awards or free play credits. A "progressive" jackpot is a common jackpot that increases a small amount for every game played on the machines included within a certain network whereon the progressive is offered.

Defendants manufacture a product suite called Bally Power Bonusing, which includes the following accused products: Power Winners, Power Rewards, Power Promotions, and Power Bank. These systems will be discussed in greater detail *infra* in connection with the court's infringement analyses. Each comprises hardware and software to run on a slot network, the software having main components: a slot management [**6] system (or "SMS") and a casino management system (or "CMS"). (D.I. 142 at 8) The SMS handles the slot accounting functions and collects player tracking data such as a player's wages. The SMS provides this data to the CMS, which handles the marketing and reporting functions of the casino. (*Id.*)

There are several components to the slot network. A "host computer" is located at the back end of the system in the control room and maintains a database of PTC holders. A slot interface board, or "controller," is located between the gaming machine and the host computer; it receives and transmits instructions and messages between the components. Finally, the "player account" is the location on the network that records the amount of funds available to a player. Player accounts are often categorized according to the level of gaming activity by the player (e.g., silver, gold or platinum); defendants' products are targeted to specific players as compared to specific gaming devices. (*Id.*)

B. The Patents in Suit

All three patents in suit share the same named inventors (John F. Acres, Alec Ginsburg, and David Wiebenson) and assignee [**297] (Acres Gaming Incorporated ("Acres")) on the face of the patents. Plaintiff [**7] acquired each patent when it acquired Acres in 2003.

1. The '885 Patent

The '885 Patent is a reissue of U.S. Patent No. 5,752,882 ("the '882 patent"), issued May 19, 1998. The '882 patent was filed on June 6, 1995 as U.S. Patent Application 08/465,915, a divisional application claiming priority to U.S. Patent Application No. 08/322,172, filed October 12, 1994, now U.S. Patent No. 5,655,961 ("the '961 patent"). The reissue application (No. 09/573,470) leading to the '812 patent was filed on May 16, 2000.

Plaintiff asserts that defendants' products infringe claims 1, 10, 22, 33 and 46 of the '885 Patent. All five independent claims share the backbone reproduced below.

A method of operating gaming devices interconnected by a host computer having a user-operated input device comprising: associating each gaming device with a unique address code; preselecting less than all of the gaming devices interconnected by the host computer responsive to a user-effected action at the input device which identifies the preselected gaming devices with the respective associated address codes; using the network to track activity of the preselected gaming devices [. . .]

In addition to the foregoing, claims 1, **[**8]** 10, 22, 33 and 46 contain additional limitations, as reproduced below.

1. [. . .] initiating a bonus play period; issuing a command over the network to each of said preselected gaming devices responsive to initiation of the bonus play period; and paying a bonus at each of said preselected gaming devices in accordance with the command.

10. [. . .] issuing a command over the network to one of said preselected gaming devices responsive to a predetermined event; and paying at said one gaming device in accordance with the command.

22. [. . .] initiating a bonus play period; issuing a command over the network to each of said preselected gaming devices responsive to initiation of the bonus play period; and paying a bonus via each of said preselected gaming devices in accordance with the command.

33. [. . .] initiating a bonus play period; generating a message including data related to a payment amount; transmitting the message over the network to at least one of said preselected gaming devices responsive to a predefined event; and paying via at least said one gaming device during the bonus play period in accordance with the message.

46. [. . .] issuing a command over the network to at least one **[**9]** of said preselected gaming devices responsive to a predefined event; and paying via at least said one gaming device in accordance with the command.

2. The '812 Patent

The '812 patent is a reissue of U.S. Patent No. 5,836,817 ("the '817 patent"), issued November 17, 1998. The '812 patent is related to the '855 patent; it was issued from divisional application 08/465, 717, the sister application to U.S. Patent Application 08/322,172 (issuing as the '961 patent). The reissue application (No. 09/574,632) leading to the '812 patent was also filed on May 16, 2000.

Plaintiff asserts that defendants' products infringe claims 21 and 44 of the '812 patent, as reproduced below.

22. A method of operating gaming devices interconnected by a computer network to a host computer having a user-operated **[*298]** input device comprising: preselecting less than all of the gaming devices interconnected by the computer network responsive to a user-effected action at the input device; using the network to track the amount of money played on the preselected gaming devices; allocating a predetermined percentage of the money played to a bonus pool; and

issuing a command over the network to cause a bonus to be paid from the **[**10]** pool by one of said preselected gaming devices upon the occurrence of a predetermined event.

44. A method of operating gaming devices interconnected by a computer network to a host computer comprising: selecting a plurality of the gaming devices; generating a message including data establishing criteria to cause a bonus to be paid via one of said selected gaming devices upon the occurrence of a predetermined event; transmitting the message over the network; storing the message in a memory connected to a controller associated with only one of the gaming devices; transmitting data indicative of gaming device activity from the gaming device to the controller; transmitting a pay command from the controller to the gaming device upon the occurrence of the predetermined event; and paying the bonus via the gaming device responsive to receipt of the pay command. .laddend..ladd.

3. The '983 Patent

The '983 patent issued from U.S. Patent Application No. 09/832,425, filed April 10, 2001, a continuation of U.S. Application No. 08/672,217, filed on June 25, 1996, now U.S. Patent No. 6,244,958. John Acres is the sole named inventor. Plaintiff asserts infringement of claim 1, which reads as follows:

1. **[**11]** A method for providing incentive to play gaming devices connected by a network to a host computer comprising: associating each gaming device with an input device for receiving player identification; associating unique player identification with a gaming device player; creating a player account accessible by the host computer; associating the unique player identification with the player account; applying a promotional credit to the player's account; permitting the player to access the account; transferring promotional credit in the account to the gaming device; permitting the player to wager the promotional credit; and preventing the promotional credit from being cashed out by the player.

III. STANDARD OF REVIEW

HN1↗ A court shall grant summary judgment only if "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). The moving party bears the burden of proving that no genuine issue of material fact exists. See *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586 n.10, 106 S. Ct. 1348, 89 L. Ed. 2d 538 (1986). **[**12]** "Facts that could alter the outcome are 'material,' and disputes are 'genuine' if evidence exists from which a rational person could conclude that the position of the person with the burden of proof on the disputed issue is correct." *Horowitz v. Fed. Kemper Life Assurance Co.*, 57 F.3d 300, 302 n.1 (3d Cir. 1995) (internal citations omitted). If the moving party has demonstrated an absence of material fact, the nonmoving party then "must come forward with 'specific facts showing that there is a genuine issue for trial.'" *Matsushita*, 475 U.S. at **[*299]** 587 (quoting Fed. R. Civ. P. 56(e)). *HN2*↗ The court will "view the underlying facts and all reasonable inferences therefrom in the light most favorable to the party opposing the motion." *Pa. Coal Ass'n v. Babbitt*, 63 F.3d 231, 236 (3d Cir. 1995). The mere existence of some evidence in support of the nonmoving party, however, will not be sufficient for denial of a motion for summary judgment; there must be enough evidence to enable a jury reasonably to find for the

nonmoving party on that issue. See *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986). If the nonmoving party fails to make a sufficient showing on an essential element of its case **[**13]** with respect to which it has the burden of proof, the moving party is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 322, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986).

IV. DISCUSSION

A. Infringement

^{HN3} A patent is infringed when a person "without authority makes, uses or sells any patented invention, within the United States . . . during the term of the patent." 35 U.S.C. § 271(a). A court should employ a two-step analysis in making an infringement determination. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995). First, the court must construe the asserted claims to ascertain their meaning and scope. *Id.* Construction of the claims is a question of law subject to de novo review. See *Cybor Corp. v. FAS Techs.*, 138 F.3d 1448, 1454 (Fed. Cir. 1998). The trier of fact must then compare the properly construed claims with the accused infringing product. *Markman*, 52 F.3d at 976. This second step is a question of fact. See *Bai v. L&L Wings, Inc.*, 160 F.3d 1350, 1353 (Fed. Cir. 1998). Literal infringement occurs where each limitation of at least one claim of the patent is found exactly in the alleged infringer's product. *Panduit Corp. v. Dennison Mfg. Co.*, 836 F.2d 1329, 1330 n.1 (Fed. Cir. 1987). **[**14]** "If any claim limitation is absent from the accused device, there is no literal infringement as a matter of law." *Bayer AG v. Elan Pharm. Research Corp.*, 212 F.3d 1241, 1247 (Fed. Cir. 2000). If an accused product does not infringe an independent claim, it also does not infringe any claim depending thereon. *Wahpeton Canvas Co. v. Frontier, Inc.*, 870 F.2d 1546, 1553 (Fed. Cir. 1989). The patent owner has the burden of proving infringement and must meet its burden by a preponderance of the evidence. *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 889 (Fed. Cir. 1988) (citations omitted).

1. Power Rewards

a. The Power Rewards product ³

FOOTNOTES

³ The parties do not dispute the functionality of Power Rewards. (D.I. 179 at 8; D.I. 192 at 11-13; D.I. 213 at 3, 21-22; D.I. 218 at 1)

Power Rewards gives players an opportunity to win rewards based on their gaming play. Its functionality has been described by the parties as "Play 'X', Get 'Y'," since an eligible patron that wagers 'X' dollars while a promotion is active will get 'Y' dollars as an award.

A Power Rewards progressive promotion operates in four steps. In the first step, a casino operator sets up a Power Rewards promotion on the **[**15]** host computer by setting the relevant parameters for the promotion. In the Power Rewards context, these parameters are start and end date, the type of award credit, the amount of dollars the player must play to receive the award amount ("Play X"), the number **[*300]** of days the player has to reach the play amount, the award amount the player will receive upon reaching the play amount ("Get Y"), and the types of participating gaming devices. In step two, the casino operator selects a group of players (such as by account status) and assigns the Power Rewards promotion to those players. The promotion becomes active at the start time specified by the operator in step one. In step three, a qualified player places his PTC in a Power Rewards-

eligible gaming device. At this time, the host computer sends "transaction # 151," containing information about the promotion (such as the Play X, Get Y, and amounts already wagered by a player) to the controller associated with that gaming device. The controller then tracks the amount of credits played by that player during that playing session at that gaming device.

At step four, once a player reaches the appropriate "Play X" amount, the controller causes the **[**16]** "Promo" function key associated with the gaming device to flash. The player can then press the Promo key and choose the amount of "Get Y" credits to put on the gaming device. If the player does not press the Promo key, the "Get Y" amount is stored in a "promotional detail file" at the host computer.

b. Claim limitations at issue

Plaintiff asserts that Power Rewards infringes claims 21 and 44 of the '812 patent and claims 1, 10, 22, 33 and 46 of the '885 patent.

As a threshold matter, each of these claims requires that a "command" or "message" be issued over the network causing payment to be made to a player. The parties dispute whether transaction # 151 is such a "command" or "message." The parties also dispute whether Power Rewards pays a "bonus" as that term is used in claims 1 and 22 of the '885 patent and claims 21 and 44 of the '812 patent.

Claim 21 of the '812 patent requires "issuing a command over the network including data establishing criteria to cause a bonus to be paid via one of said selected gaming devices upon the occurrence of a predetermined event." Claim 44 of the '812 patent requires "generating a message including data establishing criteria to cause a bonus to be paid **[**17]** via one of said selected gaming devices upon the occurrence of a predetermined event." Assuming transaction # 151 is a "command," the parties disagree about whether Power Rewards issues transaction # 151 "upon the occurrence of a 'predetermined event,'" as required by these claims. Claim 10 of the '885 patent similarly requires "issuing a command over the network to one of said preselected gaming devices responsive to a predetermined event." The parties present the above arguments as to claim 10.

In addition, the parties dispute whether Power Rewards issues transaction # 151 "responsive to initiation of the bonus play period" as required by claims 1 and 22 of the '885 patent. The parties also debate whether Power Rewards pays a reward "in accordance with" transaction # 151, as required by all asserted claims of the '885 patent.

c. "Command" or "message" (claims 21 and 44 of the '812 patent and claims 1, 10, 22, 33 and 46 of the '885 patent)

Plaintiff asserts that transaction # 151 of Power Rewards is the "command" or "message" containing such a command as defined by the court, which is "a command that rearranges the previous configuration of the gaming device so that the gaming device **[**18]** pays out extra money it would not have paid in its previous configuration." Defendants assert that transaction **[*301]** # 151 is not a reconfiguration command because it does not alter the jackpot or winning payouts on a participating machine; it only provides that if a player "plays X" she will "get Y." (D.I. 192 at 26) All regular payouts remain the same.

The reconfiguration command can provide a variety of promotional bonuses described as multiple jackpot bonuses, mystery jackpot bonuses, progressive jackpot bonuses, or player-specific bonuses. ('812 patent, abstract; col. 3, ll. 10-21) Mystery jackpots, for example, may be paid "even when a jackpot was not won." (*Id.*, col. 36, ll. 55-64) The court has defined "bonus" as used in the claims as a payment that can be awarded regardless of the outcome on the gaming device. Consistent with this definition, the court does not limit a

"reconfiguration command" to one directing additional payment on a jackpot or winning pull; any payment that the device would not have paid in its previous configuration will suffice.

There is no genuine dispute that transaction # 151 is a "command" or "message" as described by the claims because it directs the machine **[**19]** to "pay Y," or "extra money it would not have paid in its previous configuration." Defendants' expert, Mr. Dwight Crevelt, admits that "an eligible patron receives a Power Rewards reward merely by playing the required amount on eligible machines during the time period set for the promotion, regardless of whether that patron ever won a jackpot on any eligible machine during that promotion." (D.I. 179 at 17, citing JA1904-05) That is, transaction # 151 provides for an award that a player would not receive during regular play ("Y"). The fact that a player may not "Get Y," in the event she does not "Play X," does not change the fact that transaction # 151 was issued or transmitted to the gaming device to cause payment of "Y" under those circumstances.

d. "Bonus" (claims 1 and 22 of the '885 patent and claims 21 and 44 of the '812 patent)

For similar reasons, defendants' argument that Power Rewards does not pay a "bonus" is unpersuasive. (D.I. 192 at 32) By its order of the same date, the court has construed "bonus" as a "reward or payment in addition to any payout specified by the normal gaming device pay table," which "may be awarded to a player whether the outcome on the gaming device **[**20]** is a win, loss, or no outcome at all." There is no dispute that "Get Y" is a reward or payment in addition to the standard gaming machine payouts; therefore, this limitation is met.

e. "Upon the occurrence of" or "responsive to" a "predetermined event" (claims 21 and 44 of the '812 patent, claim 10 of the '885 patent)

Claim 10 of the '885 patent requires "issuing a command over the network to one of said preselected gaming devices responsive to a predetermined event." In contrast, claims 21 and 44 of the '812 patent require issuing a "command" (claim 21) or "message" (claim 44) "including data establishing criteria to cause a bonus to be paid via one of said selected gaming devices upon the occurrence of a predetermined event." That is, in the context of the '812 patent, it is not the command itself that is generated in response to the predetermined event -- the command contains data including the predetermined event upon which to pay the bonus.

i. '885 patent

With respect to the '885 patent, plaintiff argues that the player's insertion of the **[*302]** PTC is the "predetermined event" that causes the "command" itself, transaction # 151, to be generated. (D.I. 239 at 10) Plaintiff cites Mr. Crevelt's **[**21]** expert report, stating that "the transaction # 151 message is sent in response to an eligible patron inserting his card at one of the gaming machines preselected to be a part of the Power Rewards promotion." (*Id.*, citing D.I. 237 at JA1903, PP 237-38)

By its order of the same date, the court has construed the "issuing a command over the network to one of said preselected gaming devices responsive to a predetermined event" limitation as "issuing a command in reply or reaction to the occurrence of one or more conditions chosen in advance." ⁴ The court does not limit the term, as defendants suggested, by requiring a determination of what time the triggering condition will occur. (D.I. 218 at 19) While the predetermined event must obviously be "predetermined," or contemplated in advance, its occurrence may be random and still satisfy the court's construction. Put another way, it is the fact of the occurrence, not the timing of the occurrence, that is dispositive. That

the event may not happen at all does not mean that the event was not a condition "chosen in advance."

FOOTNOTES

4 By letter dated March 4, 2009, the parties informed the court that they now agree on the following construction of "predetermined [****22**] event": "a triggering event that is determined in advance of its occurrence." (D.I. 273) The dispute now centers around how the claim is read as a whole and the "upon the occurrence of" and "responsive to" terms. For this reason, the court has construed the limitation as a whole. Notwithstanding, the court discerns no significant difference between its definition of "predetermined event," as incorporated therein, and that posed by the parties.

Under the court's construction, the insertion of a PTC qualifies as a "predetermined event" regardless of the fact that the precise time that this may occur is unknown. The parties do not dispute that the insertion of an eligible PTC causes transaction # 151 to be sent to the gaming device. Defendants essentially concede infringement under this construction. (D.I. 218 at 19-20)

ii. '812 patent

With respect to the '812 patent, plaintiff argues that "Play X" is the "predetermined event," or the precedent contained within transaction # 151 that triggers payment ("Get Y"). (D.I. 239 at 4-6) More specifically, the Power Rewards User's Guide provides that Power Rewards "directly credit[s] slot machines with either cashable or non-cashable credits upon [****23**] playing to a variable set amount in order to achieve the reward." (*Id.*, citing D.I. 237 at JA2074) In plaintiff's view, Power Rewards "pays 'upon the occurrence' of the predetermined event [Play X] because the player is paid at the gaming device 'automatically' (i.e., 'non-manually') 'upon playing to the variable set amount'." (*Id.* at 6)

The debate between the parties centers around the construction of the full limitation: "issuing a command over the network including data establishing criteria to cause a bonus to be paid via one of said selected gaming devices upon the occurrence of a predetermined event." Plaintiff argues that, properly read, the "upon the occurrence of a predetermined event" modifies the "bonus to be paid," rather than the command or message. (D.I. 213 at 28) Defendants assert that "upon the occurrence" modifies the word "command." In their view, Power Rewards "does not infringe because the 'command' is not sent 'responsive to' or 'upon the occurrence of the start time of the promotion [the 'predetermined event']'." (D.I. 192 at 29)

[***303**] As indicated previously, and as reflected in the court's claim construction order, the court agrees with plaintiff that "it is the payment [****24**] of the bonus, as opposed to the command, that responds to the predetermined event" pursuant to claims 21 and 44. (D.I. 213 at 28) Removing the adverbial phrases, the limitation reads: "issuing a command . . . to cause a bonus to be paid . . . upon the occurrence of a predetermined event." The plain import of the phrase is that the bonus is paid upon the occurrence of the predetermined event. In the case at bar, the parties do not dispute that "Get Y" (the "bonus") is paid upon the occurrence of "Play X" (the "predetermined event").

The court notes that "predetermined event" appears later in claims 21 and 44, which also require "transmitting a pay command from the controller to the gaming device upon the occurrence of the predetermined event." The court has construed this limitation as "transmitting an instruction related to payment from the controller to the gaming device in response or reply to the occurrence of one or more conditions chosen in advance."

Plaintiff characterizes the "pay command" as "credit the slot machine with the 'Get-This-Amount' converted to credits" identified in the Power Rewards manual. (D.I. 179 at 15, citing D.I. 237 at JA2076) This instruction follows the **[**25]** player's pressing of the "PROMO" key. That is, the manual provides that if the "Amount-Already-Played" "gets greater than or equal to the 'Play-This-Amount,' flash the PROMO button key and stop the accumulation"; thereafter, "[i]f the PROMO button is pressed while it is flashing, credit the slot machine with the 'Get-This-Amount'" (D.I. 237 at JA2076) In their opening brief, defendants argue that a pay command is not transmitted "upon the occurrence of" "Play X" because a player must initiate the withdrawal of funds by pressing the PROMO button. (D.I. 192 at 31; D.I. 218 at 10)

Defendants consistently interpret both "upon the occurrence of" and "in accordance with" as being synonymous with the term "automatic." ⁵ With respect to the '812 patent, defendants argue that the reward withdrawal process (initiated by pressing the PROMO button) is an intervening step between "Get Y" and the receipt of the reward, bringing Power Rewards outside of the claims.

FOOTNOTES

⁵ Defendants' argument regarding the "upon the occurrence of" limitation parallels that made in the context of the "in accordance with" limitation found in the '885 patent, discussed *infra*.

Defendants cite a single sentence in the **[**26]** specification in support of their construction: that "a need remains for an automated method and apparatus to provide bonusing for gaming devices." (D.I. 218 at 12, citing '885 patent, col. 22, ll. 25-27 ⁶) The patents are directed to eliminating the technique of "having an attendant manually pay out the additional payout amount," and do not describe (or claim) any particular manner of automated payout. ('812 patent, col. 2, ll. 21-22) Defendants point to no express disclaimers over a method of payment comprising a withdrawal process with more than one step. The patents are not directed to a precise method of automated redemption. For these reasons, the court declines to limit the claims to require an "automatic" payment in the manner advocated by defendants. ⁷

FOOTNOTES

⁶ Corresponding to col. 2, ll. 36-38 of the '812 patent.

⁷ In their claim construction papers, the parties specifically disputed the term "pay command": plaintiff argued that this is an instruction related to payment, while defendants argued that it is a command causing automatic payment of the bonus. (D.I. 167) The parties focus more on the "upon the occurrence of" segment than "pay command" in their summary judgment briefs. The **[**27]** court has construed the limitation as a whole, noting that payment need not be "automatic" or effected without any additional steps.

[*304] f. "Issuing a command over the network to each of said preselected gaming devices responsive to initiation of the bonus play period" (claims 1 and 22 of the '885 patent)

Claims 1 and 22 of the '885 patent require that the command be issued "responsive to the

initiation of the bonus play period." By its order of the same date, the court has construed "bonus play period" as "the period during which the bonus promotion is active." According to defendants, the "bonus play period" is the "time during which Power Rewards is configured to start and stop." (D.I. 192 at 27) Plaintiff asserts that the "bonus play period" is initiated when an eligible player inserts his PTC. (D.I. 179 at 26) That is, inserting the PTC causes transaction # 151, including the "Play X, Get Y" pay instruction to be generated. (*Id.*)

The specification states that a bonus can play until the bonus payout exceeds the bonus pool -- an unspecified amount of time. ('885 patent, col. 37, ll. 5-48) For this reason, the court did not limit its construction of "bonus play period" to a pre-specified **[**28]** period of time, as defendants advocated. Nevertheless, the court finds plaintiffs infringement evidence deficient under the court's construction. Power Rewards has a defined start time, specified by the casino operator in step one. Plaintiff does not dispute this point. (D.I. 213 at 3 & n.3; D.I. 179 at 8) Power Rewards thus becomes "active" at the predetermined start time - regardless of whether any players have inserted their PTCs at that time. There is no indication that a Power Rewards promotion commences upon the insertion of a PTC; rather, the insertion of a PTC during an active promotion simply enrolls the player in the promotion. Insertion of the PTC may initiate transaction # 151, but there is no direct link between the start of Power Rewards (by the casino operator in step one) and transaction # 151 (following the insertion of a PTC during an active promotion). Plaintiff points to no such evidence. (D.I. 179 at 27; D.I. 213 at 24; D.I. 239 at 7-8)

g. Paying "in accordance with" the "command" or "message" (claims 1, 10, 22, 33 and 46 of the '885 patent)

The asserted claims of the '885 patent require paying a bonus "in accordance with" the command or message. Defendants assert **[**29]** that Power Rewards does not pay an award in accordance with transaction # 151 because it is undisputed that a player must initiate a series of funds-withdrawal commands on a machine (starting with pressing the PROMO button) in order to actually obtain the award. * (D.I. 192 at 30) Defendants assert that payment must be made "automatically" upon the receipt of the command. (D.I. 171) Plaintiff asserts that this limitation is met when transaction # 151 makes the bonus available, regardless of the subsequent withdrawal step(s). (D.I. 213 at 26) According to plaintiff, the relevant innovative aspect of the '885 patent is the automation of the **[*305]** payment process; thus, "automatic" payment is made when a player is eligible for payment at the gaming device without having to receive a manual payout. (*Id.*)

FOOTNOTES

* The Power Rewards User's Guide, cited by plaintiff in its infringement chart for this limitation, confirms that the PROMO key must be pressed to convert the "Get-This-Amount" reward to cashable or non-cashable credits as instructed by transaction # 151. (D.I. 179 at 25, citing JA2076 at BALLY236075)

As indicated previously, the court finds plaintiff's position more convincing, and has provided **[**30]** in its claim construction order that "the command or message makes the bonus available. The claims do not require that the bonus is paid 'automatically' or without any subsequent withdrawal steps upon receipt of the pay command." The specification does not support effectively narrowing the claims to require "automatic" payment of the bonus. ⁹ Defendants point out that the specification does describe a bonus as being "automatically paid," without further detail, but this phrase was contained in a paragraph describing "another embodiment of the bonus time promotion." (D.I. 190 at 35, citing '885 patent, col. 26:24-31) Again, the patents are directed to eliminating manual payouts, and do not describe particular methods of automated payouts.

FOOTNOTES

⁹ The claim term that the parties sought the court's construction of was not "in accordance with," but "paying." In this context, defendants asserted that "paying" means "paying a bonus . . . automatically upon receipt of the command," while plaintiff advocated that "paying" means "making a bonus available at each of the preselected gaming devices in accordance with the command." (D.I. 190 at 34)

In their claim construction brief, defendants cite several **[**31]** statements made to the examiner during prosecution of the '885 patent, in which the applicants distinguished the "automatic" payment of the invention from "payment to the player by the cashier." (D.I. 190 at 36-37) None of these statements specifically disclaim or distinguish an automated payment that is immediately usable by the player with one that requires any withdrawal steps. The applicants' use of the word "automatic" in this context is not controlling, especially considering the context of discussing "automated" payments. Defendants point to no express disclaimers over a method of payment comprising a withdrawal process with more than one step.

Based on the foregoing, the court does not restrict the claim to the "automatic" availability of the promotional reward as defendants suggest. ¹⁰ The claims require only that the "command" or "message" (transaction # 151) provides for the payment of the bonus at the gaming device. There is no dispute that a player who "Plays X" will "Get Y" and that the "Get Y" award is available on the gaming device. ¹¹

FOOTNOTES

¹⁰ The court notes that claims 21 and 44 of the '812 patent also require "paying the bonus via the gaming device responsive to receipt **[**32]** of the pay command." The parties did not specifically dispute the construction of "responsive to" as used in this limitation. (D.I. 167 (claim chart); D.I. 190) Insofar as the court is not aware of any disclaimer with respect to this term, the court's analyses with respect to "upon the occurrence of" and "in accordance with" is equally applicable to the "responsive to" limitation of claims 21 and 44 the '812 patent. The court construes these phrases consistently.

¹¹ This is the case regardless of whether a player actually presses the "PROMO" button or elects not to, foregoing the immediate opportunity to access the award in favor of, perhaps, redemption at another eligible machine.

h. Conclusion

For the aforementioned reasons, the court finds the following. Summary judgment of infringement is appropriate on claims 10, 33, and 46 of the '885 patent, insofar as Power Rewards meets the following contested limitations: "command" (claims 10, 46); "message" (claim 33); "initiating a bonus play period" (claim 33); "responsive to a predetermined event" (all **[*306]** claims); "paying at said one gaming device in accordance with the command" (claim 10); and "paying . . . in accordance with the message" (claims **[**33]** 33, 46).

Summary judgment of noninfringement is appropriate on claims 1 and 22 of the '885 patent, insofar as Power Rewards does not issue a "command" (claim 1) or "message" (claim 22) that is "responsive to initiation of the bonus play period" as required by those claims.

Summary judgment of infringement is appropriate on claims 21 and 44 of the '812 patent, insofar as Power Rewards meets the following contested limitations: "command" (claim 21); "message" (claim 44); "issuing a command . . . to cause a bonus to be paid . . . upon the occurrence of a predetermined event" (claim 21); and "generating a message . . . to cause a bonus to be paid . . . upon the occurrence of a predetermined event" (claim 44).

2. Power Winners

a. The Power Winners product ¹²

FOOTNOTES

¹² The parties do not dispute the basic operation of Power Winners. (D.I. 192 at 9-11; D.I. 213 at 3) With respect to each accused product, the court omits pinpoint citations to the record, noting that it has summarized the parties' resuscitation of the facts from their opening briefs, and neither party specifically contested the facts in their answering briefs.

Power Winners allows a casino operator to create and run progressive jackpot promotions. **[**34]** Power Winners has two main components: the Power Winners Manager and the Promotional Progressive Engine ("PPE"). The Power Winners Manager includes software that performs "front end" processing. It provides the user interface that the casino marketing manager uses to set a promotion, polls the PPE for promotions that have ended and are ready for a winner to be picked, selects the winning player(s) at the end of the promotion, and calculates the payouts. The PPE performs the "back end" processing for Power Winners; it uses random numbers to periodically check for a winner and, if one is not picked, the progressive jackpot is increased.

A Power Winners progressive promotion operates in six steps. ¹³ In step one, the casino operator configures the promotion. Similar to Power Rewards, step one includes the operator's entering the parameters for the promotion (including time, date, average win amount, average length of the promotion, player eligibility information, gaming devices to be included, and payment type). In the second step of Power Winners, these parameters are passed to the PPE, which stores them so that it can process the promotion as its intended start time.

FOOTNOTES

¹³ As described by **[**35]** plaintiff's expert. Defendants agree that this description is accurate. (D.I. 192 at 9-11, citing D.I. 237 at JA04368 et seq.)

The PPE processes the promotion in the third step. It divides the total approximate time for the promotion into 125 separate "time slices." At each slice, a "ticket" is drawn from a pool of 1,000,000 tickets and if the drawn ticket is a winner, the progressive ends. If the drawn ticket is not a winner, the PPE increases the size of the progressive jackpot and proceeds to the next time slice. In defendants' first version of the PPE, if no winning ticket had been picked by the 125th time slice, the PPE would end the promotion. In Power Winners' current version, the promotion continues until the winning ticket is picked. ¹⁴

FOOTNOTES

14 It is not clear from the record when the functionality of the PPE was changed. The parties frame their arguments in terms of the current version of Power Winners.

[*307] In step four, the PPE notifies the host computer that a winning ticket has been picked. The Power Winners application on the host computer then randomly picks a winning player. There are two platforms upon which its SMS and CMS systems can run: the SDS/CMP platform, and the ACSC platform. **[**36]** Power Winners operates differently based on the underlying platform. In the SDS/CMP version of Power Winners, the jackpot is placed in the winning player's account if the promotion is not configured to manually pay out the jackpot. In the ACSC version of Power Winners, Power Rewards is the jackpot notification and partial delivery mechanism.

In step five, the host computer notifies the winners. The parties do not dispute that "transaction # 151 is the Power Rewards, 'Play X, Get Y' transaction used by Power Winners to facilitate the transfer of the progressive jackpot to the winning player. After the ACSC Power Winners application randomly selects a winning player, it sends the 'Play X, Get Y' transaction to the controller associated with the gaming device that hosts the winning player. In this case, the 'Play X' amount is \$ 0 and the 'Get Y' amount is the Power Winners progressive jackpot." (D.I. 192 at 16-17; D.I. 213 at 6, n.6)

In the last step, the winning player withdraws the jackpot. In SDS/CMP Power Winners, the jackpot is withdrawn at this step from the player's account through a series of withdrawal steps at the gaming device; in ACSC Power Winners, a Power Rewards transaction **[**37]** is sent and the player must initiate the withdrawal process by pressing the "PROMO" button on the gaming device, which also involves a series of withdrawal steps. In either format, the winner may withdraw less than the total jackpot awarded.

b. Claim limitations at issue

Plaintiff asserts that Power Winners infringes claims 10, 33 and 46 of the '885 patent. Specifically, the parties dispute whether Power Winners issues a "command" (claims 10, 46) or "message" (claim 33) over the network "responsive to a predefined event" (claim 33, 46) or to a "predetermined event" (claim 10). The parties also contest whether Power Winners pays a reward "in accordance with" the command or message (all claims) and/or pays "during the bonus play period" (claim 33).

c. "Command" or "message" (all claims)

Plaintiff asserts that the "command" or "message" is transaction # 151 for ACSC Power Winners, and "DM33" for SDS/CMP Power Winners. (D.I. 213 at 6) For the reasons previously stated, the court agrees that transaction # 151 is a "command" or "message" under its construction. In the context of Power Winners, transaction # 151 provides a jackpot that was not available under the machine's normal gaming pay table. **[**38]** The court will proceed to address DM33.

The court first notes that plaintiff does not identify DM33 in its infringement claim chart. Plaintiff asserts that the "command" or "message" relating to payout is made by the PPE in response to the drawing of a winning ticket. (D.I. 179 at 31 (claim chart)) In support, plaintiff cites defendants' "Promotional Progressive Engine (PPE) Installation Guide," dated 2006, which provides that the PPE determines a winner when a winning ticket is drawn, but does not describe a particular instruction to pay an award. (*Id.*, citing D.I. 237 at JA2227-28) Plaintiff also cites Mr. Crevelt's expert report, in which he states that, after a winning patron is selected, "the winning patron is notified that they have won the jackpot[.]" (*Id.*, citing **[*308]** D.I. 237 at JA1799, P 39) Plaintiff does not identify any evidence describing DM33

in any detail.

According to defendants, "DM33 is a notification sent by the host computer to the display on the gaming device that informs the player that they have won Power Winners. It is not a reconfiguration command and does not contain one." (D.I. 192 at 16) In support, defendants cite the expert report of Dr. Kelly, which states [**39] that Power Winners "formulates and sends a message to the GMU associated with the gaming device that hosts the winning patron. This message includes the patron's first name and winning amount. The message is displayed to the player at the Player Tracking Display associated with the gaming device." (*Id.*, citing D.I. 237 at JA4412-13, P 93) Additionally, Dr. Kelly stated at his deposition that he had not analyzed whether DM33 rearranges the previous configuration of the gaming device, and was not sure that it did. (D.I. 237 at JA3564, 150:17-23) Plaintiff did not refute defendants' arguments in its answering brief, only arguing that defendants themselves agree that DM33 is an "instruction" that would infringe under a broader claim interpretation. (D.I. 213 at 6)

There is no indication of record that DM33 does anything other than inform a player of his bonus winnings. A message that simply informs the Winning Powers player that he has won is not a "command" or "message" as defined by the court, that is, it does not rearrange the previous configuration of the gaming device so that it pays out extra money it would not have paid in its previous configuration. Summary judgment of noninfringement [**40] is granted with respect to SDS/CMP Power Winners.

d. issuing a "command" (claims 10, 46) or "message" (claim 33) "responsive to a predetermined event" (claim 10) or "responsive to a predefined event" (claim 33, 46)

As stated previously, the parties agree that in Power Winners, transaction # 151 is sent to the controller associated with the gaming device with the "Play X" (\$ 0), "Get Y" (jackpot) instruction. (D.I. 192 at 16-17; D.I. 213 at 6, n.6) The dispositive question is whether transaction # 151 is issued responsive to a "predetermined" or "predefined" event. The event, or "trigger," according to plaintiff, is the "pull from the hat" that has a number less than or equal to the number from the Winning Ticket Table" by the PPE. (D.I. 179 at 32, citing D.I. 237 at JA2227-28 (PPE Installation Guide))

The parties do not dispute that the winning "pull from the hat" causes the issuance of transaction # 151, rather, the parties primarily dispute whether knowing what occurrence will cause the command to be issued (the pull from the hat), without necessarily knowing the time of that occurrence, suffices to make the event "predetermined" or "predefined." As with Power Rewards, plaintiff argues [**41] that the fact that an event will occur upon a set of conditions is all that need be known in advance, while defendants argue that more concrete information must be ascertainable. As discussed previously, the court finds plaintiff's interpretation more convincing. An event may be "predetermined" or "predefined" notwithstanding that the precise time of its occurrence is unascertainable.

Defendants also argue that transaction # 151 is not sent "responsive to" the winning ticket pull, it is sent "responsive to" the selection of a winning player. (D.I. 192 at 19-20) That is, "the random winning [**309] player selection process is a major intervening step between [when] the PPE picks a random winning 'ticket' . . . and when . . . transaction # 151 . . . is sent." (*Id.* at 21) In defendants' logic, "if events A, B, C, D, and E occur in order, E is 'responsive to' D, D is 'responsive to' C, and so on." (*Id.* at 20) Defendants essentially advocate a definition of "responsive to" that includes within its definition a time limit requirement, that is, an immediate result between events. Defendants, however, do not support their reading with any evidence, either in the specification, prosecution history of [**42] the patents, or otherwise, and the court declines to effectively limit the claims on

this record.

e. Paying "in accordance with" the "command" or "message" (claims 1, 10, 22, 33 and 46)

Defendant reiterates its arguments with respect to ACSC Power Winners that the act of pressing the "PROMO" button to obtain a bonus award means that the award is not paid "in accordance with" the "command" or "message." For reasons discussed *supra*, the court disagrees.

f. "Paying via at least said one gaming device during the bonus play period in accordance with the message" (claim 33)

Claim 33 of the '885 patent requires that the gaming device is paid "during the bonus play period in accordance with the message." As noted previously, the court has construed "bonus play period" as "the period during which the bonus promotion is active." According to defendants, the Power Winners jackpot is paid after - not during - the bonus play period insofar as the Power Winners promotion ends when the PPE picks a winner. (D.I. 192 at 24) Dr. Kelly reflects in his expert report that "CMP Power Winners Manager allows up to 10 players to be chosen as winners when the promotion ends [ACSC Power Winners Manager chooses only **[**43]** one winner]." (*Id.*, citing D.I. 237 at JA4407-08, P 85) That is, "if the drawn ticket is one among the winning tickets, the progressive ends. This idea is implemented in the source code, for example, PPE version 1.0[.]" (*Id.*, citing D.I. 237 at JA4415, P 103) A winning patron receives the message and win amount on the display associated with the gaming device; "[i]n response to the message, the player may choose to withdraw the winning amount onto the credit meters of the gaming device." (*Id.*, citing D.I. 237 at JA4415, P 93) According to defendants, there is no indication that the player may make this withdrawal during the bonus play period, because that has ended prior to the award notification. (*Id.*)

Plaintiff points out that Dr. Kelly, during his deposition, stated that the bonus play period is still active while a player is in the process of being paid. (D.I. 213, citing D.I. 237 at JA3588, 245-46) Plaintiff generally argues that "every Power Winners promotion continues until these two components [the PPE and Power Winners Manager] have performed their respective processing," but the PPE Installation Guide, cited by plaintiff, does not directly support its interpretation. (*Id.*, **[**44]** citing D.I. 237 at JA2222-23)

Clearly, the PPE "only functions . . . to add money to a growing time-based progressive and determine when the award is won." (D.I. 237 at JA2225) The Power Winners Manager ("casino-side software"), after being notified that there is a winner and the value of the pot, is responsible for the selection of the winner (*id.*) and Power Rewards is the mechanism by which the winner is paid (D.I. 192 at 16-17; D.I. 213 at 6, n.6). The dispositive question is not what software is active and when, but at what point the bonus promotion ceases to be "active." In ACSC Power Winners, after the PPE determines that an award is **[*310]** won and after the Power Winners Manager notifies the winner, there is no bonus available to other players.¹⁵ Presumably, to make another bonus available, the casino operator would have to configure another promotion. Plaintiff points to no evidence suggesting that the promotion, a randomized award contest amongst eligible players, continues past the selection and notification of the winner. (D.I. 213 at 20; D.I. 239) On this record, the court declines to find that ACSC Power Winners pays the winning player "during the bonus play period."

FOOTNOTES

¹⁵ In the **[**45]** court's view, the Power Winners Manager must select a winner prior to the end of the promotion, insofar as the possibility that an eligible player may win an

award is not foreclosed until one winning player is definitely selected by that software.

g. Conclusion

For the aforementioned reasons, the court grants summary judgment of infringement of claims 10 and 46 of the '885 patent with respect to ACSC Power Winners, insofar as ACSC Power Winners issues a "command" (claims 10, 46) "responsive to a predefined event" (claim 46) or to a "predetermined event" (claim 10), and pays a reward "in accordance with" the command (claims 10, 46). Summary judgment that ACSC Power Winners does not infringe claim 33 of the '885 patent is appropriate insofar as ACSC Power Winners does not pay "during the bonus play period." Summary judgment of noninfringement is granted with respect to SDS/CMP Power Winners (all claims), because DM33 is not a "command" or "message" under the court's construction.

3. Power Promotions

a. The Power Promotions product ¹⁶

FOOTNOTES

¹⁶ The parties are in agreement regarding the operation of Power Promotions. (D.I. 179 at 9; D.I. 192 at 13; D.I. 213 at 31-32; D.I. 218 at 1)

Power Promotions **[**46]** allows two-way transfers of promotional credits awarded to a player account by the casino to the credit meter on the gaming device. With Power Promotions, casino operators can apply a promotional credit to a player's account in a variety of ways, such as directly crediting the account or awarding credits based on an amount of play. For example, a casino may set up a system whereby "Gold" members earn one point per dollar spent, and "Platinum" members earn two points per dollar spent. Power Promotions allows the casino to convert earned points into credits. Credits, which may be designated cashable or non-cashable, may also be awarded by the casino at its discretion, for example, on a player's birthday. Power Promotions points or credits are not automatically transferred onto a gaming device when a player's PTC is inserted. Instead, the player must draw them down onto the gaming device by proceeding through a system-specific withdrawal process. Once withdrawn, a player can wager the promotional credit to play the gaming device. A player is free to transfer credits back to his player account at any time.

b. Infringement analysis

Plaintiff asserts that Power Winners infringes claim 1 of **[**47]** the '983 patent. The limitation at issue in this regard is "transferring promotional credit in the account to the gaming device." By its order of the same date, the court has defined this limitation as "applying the promotional credit in the player account to a credit meter on the gaming device in response to the insertion of a player card alone or with a wager." **[*311]** Plaintiff argued against the inclusion of the "in response to . . ." language, and did not argue in its briefing that credits are applied "in response to" the insertion of a player card. (D.I. 179 at 36-37, D.I. 213 at 32; D.I. 239 at 16-17) Plaintiff only argues that Power Promotions generally applies the credit from the account to the credit meter.

Plaintiff cites defendants' "SDS 9 Slot Data Systems Marketing User Guide," dated March 3, 2006, which provides that Power Promotions allows the withdrawal of player funds as follows: "Once a card is issued, the player inserts the card into any promotional electronic enabled

slot machine to download credits. When the card is inserted, the casino's greeting scrolls across the display. Using the keypad, the player selects a transaction type and then follows the instructions that **[**48]** scroll across the display." (D.I. 179 at 35 (claim chart); D.I. 188, ex. 29 at BALLY11835) This selection demonstrates that the transfer of credits is not automatic. The court stops short of specifically equating the "in response to" language of claim 1 with the term "automatic," as defendants suggest, however, plaintiff does not clearly iterate how a multi-step withdrawal process satisfies the "in response to" limitation.

Dr. Kelly acknowledged in his report that a "patron may choose to withdraw funds from the player's account" when his PTC is in use. (D.I. 237 at JA04431, P 142) Plaintiff also cites Mr. Crevelt's rebuttal report, stating that "SDS Power Promotions allows two-way transfers of promotional credits awarded to the patron's club account by the casino to the credit meter on the gaming device" and that "Bally's ACSC Power Promotions is similar to that of SDS Power Promotions[.]" (D.I. 188, ex. 8 at PP 125, 130) Neither statement relates to the "in response to" question at hand.

In short, plaintiff has failed to raise a genuine issue of material fact with respect to whether credits are issued "in response to" the insertion of a player card in Power Promotions, and judgment **[**49]** must be entered for defendants.

4. Power Bank

a. "Promotional credit"

Power Bank allows patrons to make deposits into their player accounts on the host computer for subsequent access at the gaming device. As with Power Promotions, the parties dispute whether Power Bank allows the transfer of promotional credits, rather than money, between a player's account and a gaming machine. According to defendants, Power Bank does not involve the transfer of non-cashable credits; it is directed to player-deposited money that is always cashable.

Plaintiff states that there are two versions of Power Bank - SDS Power Bank and ACSC Power Bank. (D.I. 179 at 37) Only the latter is accused of infringement. (*Id.* at 9) ACSC Power Bank, plaintiff argues, is marketed as handling both patron-deposited money as well as casino-awarded promotional credits. (*Id.*) According to the "ACSC 10.0 Power Bank User's Guide" (May 1, 2007) cited by plaintiff, Power Bank enables patrons to play "cashless" by depositing funds with the casino cage to be used later via their PTCs. (D.I. 188, ex. 20) "The SMS allows patrons to redeem these credits (via the cash-out button) or, **if supported by the manufacturer's protocol, play only **[**50]** credits (non-cashable)** which may be played at that specific game." (*Id.*) (emphasis added)

Dr. Kelly testified that he reviewed the source code and has identified functionality allowing Power Bank to download both cashable and non-cashable credits to the gaming device. (D.I. 188, ex. 57 at 264-66) **[**312]** In contrast, Mr. Crevelt states in his rebuttal declaration that "Power Bank has nothing at all to do with non-cashable credits"; the code for Power Promotions cannot be compiled with code conferring ACSC Power Bank capability. (D.I. 188, ex. 8 at P 140) Dr. Kelly testified that he has seen documents in which the code for both products was compiled together. (D.I. 237 at JA3595, 273-76)

Defendants cite marketing materials that indicate that Power Bank allows patrons to deposit and later access their money via their PTC. ¹⁷ Defendant also cites plaintiffs interrogatory response, stating the same. (D.I. 218 at 22, citing JA05021-25) These documents do not contradict the Power Bank manual, which clearly indicates that ACSC Power Bank may also, depending on manufacturer protocol, transfer promotional (non-cashable) credits.

FOOTNOTES

¹⁷ The court notes that the citation provided for this document, JA01771, [****51**] does not correspond to the marketing documents quoted. (D.I. 218 at 22) Plaintiff does not specifically contest the content of this citation in its reply papers. (D.I. 239 at 18-19)

Defendants argue, without support, that the "source code for transferring non-cashable credits actually belongs to Power Promotions, not Power Bank." (*Id.* at 23) Defendants also assert that a casino could not run both Power Promotions and Power Bank together without a "license key," however, they have never sold a "license key" for Power Bank; "ACSC Power Bank is only operational at two casinos," which have not purchased Power Promotions. (D.I. 192 at 23-24) Defendants do not point to any supporting evidence (or testimony by Mr. Crevelt) on this point. These bare assertions do not raise a genuine issue of material fact. See *Hilgraeve Corp. v. Symantec Corp.*, 265 F.3d 1336, 1343 (Fed. Cir. 2001) (^{HN4} "[A]n accused device may be found to infringe if it is reasonably capable of satisfying the claim limitations, even though it may also be capable of non-infringing modes of operation.").

b. "In response to" the insertion of a PTC

Defendants' alternate non-infringement argument is that Power Bank does not "transfer[****52**] promotional credit in the account to the gaming device" because, as with Power Promotions, a player must initiate the withdrawal of credits; withdrawal is not automatic. (D.I. 192 at 37) Plaintiff relies on the same evidence discussed with respect to Power Promotions, the "SDS 9 Slot Data Systems Marketing User Guide," for its infringement analysis of both Power Promotions and Power Bank. (D.I. 179 at 35 (claim chart)) As an initial matter, the court is not inclined to apply this document - clearly labeled for "Power Promotions" - to Power Bank. Notwithstanding, as discussed previously, there is no indication from this document that the promotional credit is applied "in response to insertion of a player card." Plaintiff presents no specific arguments vis-a-vis Power Bank in this regard. (D.I. 179 at 35, 37-38; D.I. 213 at 33-35; D.I. 239 at 18-19) Because there is no indication of record that the transfer of credits, where it is provided for by manufacturer protocol, occurs "in response to insertion of a player card," judgment must be entered for defendants.

5. Conclusion regarding infringement

For the foregoing reasons, Power Rewards infringes claims 10, 33 and 46 of the '885 patent [****53**] and claims 21 and 44 of the '812 patent, and does not infringe claims 1 and 22 of the '885 patent. ACSC Power Winners infringes claims 10 and 46 of the [****313**] '885 patent and does not infringe claim 33 of the '885 patent. SDS/CMP Power Winners does not infringe the asserted claims. Power Promotions and Power Bank do not infringe the asserted claims.

B. Validity

1. Standards

^{HN5} Issued patents are presumed valid, and the "underlying determination of invalidity . . . must be predicated on facts established by clear and convincing evidence." *Rockwell Int'l Corp. v. United States*, 147 F.3d 1358, 1362 (Fed. Cir. 1998) (citations omitted). The Federal Circuit has stated that "[t]his burden is especially difficult when the [asserted] prior art was before the PTO examiner during prosecution of the application." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1467 (Fed. Cir. 1990) (citation omitted). "The presumption of validity under 35 U.S.C. § 282 carries with it a presumption that the examiner did his duty and knew what claims he was allowing." *Intervet Am., Inc. v. Kee-Vet*

Labs., Inc., 887 F.2d 1050, 1054 (Fed. Cir. 1989) (citation omitted).

a. Anticipation

HN6 "An anticipation inquiry involves two **[**54]** steps. First, the court must construe the claims of the patent in suit as a matter of law. See *Key Pharms. v. Hercon Lab. Corp.*, 161 F.3d 709, 714 (Fed. Cir. 1998). Second, the finder of fact must compare the construed claims against the prior art. See *id.*

HN7 "Proving a patent invalid by anticipation 'requires that the four corners of a single, prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation.' *Advanced Display Sys. Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000) (citations omitted). The Federal Circuit has stated that "[t]here must be no difference between the claimed invention and the referenced disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). The elements of the claimed invention must be arranged or combined in the same manner as in the claim, but the reference need not satisfy an *ipsissimis verbis* test. *In re Gleave*, 560 F.3d 1331, 2009 WL 777398, *2 (Fed. Cir. 2009) **[**55]** (citations omitted). "In determining whether a patented invention is [explicitly] anticipated, the claims are read in the context of the patent specification in which they arise and in which the invention is described." *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554 (Fed. Cir. 1995). The prosecution history and the prior art may be consulted "[i]f needed to impart clarity or avoid ambiguity" in ascertaining whether the invention is novel or was previously known in the art. *Id.* (internal citations omitted).

HN8 "A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled." *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354 (Fed. Cir. 2003). Additionally, the reference must "enable one of ordinary skill in the art to make the invention without undue experimentation." *In re Gleave*, 560 F.3d 1331, 2009 WL 777398 at *2 (citing *Impax Labs., Inc. v. Aventis Pharms. Inc.*, 545 F.3d 1312, 1314 (Fed. Cir. 2008)). "As long as the reference discloses all of the claim limitations and enables the 'subject matter that falls within the scope of the claims at issue,' the reference anticipates **[**56]** - no 'actual creation or reduction to practice' is required." *In [**314] re Gleave*, 560 F.3d 1331, 2009 WL 777398 at *2 (quoting *Schering Corp. v. Geneva Pharms., Inc.*, 339 F.3d 1373, 1380-81 (Fed. Cir. 2003) and *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985)).

b. Obviousness

HN9 "A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a). Obviousness is a question of law, which depends on several underlying factual inquiries.

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 127 S. Ct. 1727, 1734, 167 L. Ed. 2d 705 (2007) [****57**] (quoting *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966)). ^{HN10} "Because patents are presumed to be valid, see 35 U.S.C. § 282, an alleged infringer seeking to invalidate a patent on obviousness grounds must establish its obviousness by facts supported by clear and convincing evidence." *Kao Corp. v. Unilever U.S., Inc.*, 441 F.3d 963, 968 (Fed. Cir. 2006) (citation omitted).

^{HN11} "[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR*, 127 S. Ct. at 1741. Likewise, a defendant asserting obviousness in view of a combination of references has the burden to show, by clear and convincing evidence, that a person of ordinary skill in the relevant field had a reason to combine the elements in the manner claimed. *Id.* at 1741-42. The Supreme Court has emphasized the need for courts to value "common sense" over "rigid preventative rules" in determining whether a motivation to combine existed. *Id.* at 1742-43. "[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* at 1742.

In [****58**] addition to showing that a person of ordinary skill in the art would have had reason to attempt to make the composition or device, or carry out the claimed process, a defendant must also demonstrate, by clear and convincing evidence, that "such a person would have had a reasonable expectation of success in doing so." *PharmaStem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342, 1360 (Fed. Cir. 2007).

2. Defendants' motion for summary judgment of invalidity of the '983 patent

a. '983 patent intrinsic record

The '983 patent was filed as United States Patent Application No. 0/832,425 ("the '425 application") on April 10, 2001. The '425 application is a continuation of U.S. Patent Application No. 08/672,217, filed June 25, 1996, now issued as U.S. Patent No. 6,244,958.

The claim ultimately issuing as claim 1 of the '983 patent was submitted by preliminary amendment on December 17, 2001. (D.I. 237 at JA1539) An office action [****315**] was issued by the examiner on January 15, 2002, in which all of the claims were rejected for obviousness-type double patenting over copending U.S. Application No. 09/134,598. (*Id.* at JA1551-52) The examiner stated the following:

Allowable Subject Matter

As indicated in copending [****59**] Application 09/134,598 the features of applying a promotional credit to a player's account and not allowing this credit to be cashed out are not taught by the prior art of record (see pertinent prior art below.)

Pertinent Prior Art

Yamamoto et al. [U.S. Patent No. 5,135,224], Bittner et al [U.S. Patent No. 5,290,033], Boushy ([U.S. Patent No.] 5,761,647), Tillery et al ([U.S. Patent No.] 5,197,094) and Dorrough et al ([U.S. Patent No.] 5,287,269) teach gaming device crediting/debiting systems.

(*Id.* at JA1553)

The applicant filed a terminal disclaimer (*id.* at JA1558), as well as copies of foreign

references which the examiner had indicated had not been reviewed (*id.* at JA1561). A Notice of Allowability was issued thereafter. This notice contained an examiner's amendment to the abstract, shortening its length, but no other substantive information. ¹⁸ (*id.* at JA1571)

FOOTNOTES

¹⁸ The court is aware that the '983 patent is currently under reexamination based on the prior art asserted in this litigation. ^{HN12} Non-final opinions and decisions issued by the PTO are not binding on this court. Additionally, even if the '983 patent is ultimately rejected by the PTO and claim 1 cancelled, that decision is ultimately **[**60]** not a "final" one absent Federal Circuit review. Insofar as the Federal Circuit has had no occasion to examine the validity of the '983 patent to date, the court is not bound by any authority on the matter and does not substantively address the parties' arguments regarding the propriety and/or impropriety of the PTO's rejections.

b. Anticipation by Craine

i. Disclosure

Defendants assert that claim 1 of the '983 patent is invalid as anticipated by U.S. Patent No. 5,321,241 to Craine (hereinafter, "Craine"). Craine was issued June 14, 1994. It discloses a system for tracking casino promotional funds given to a patron over a network of gaming machines. In typical casino promotional packages issued to travelers, coupons are issued to patrons which are redeemable for currency, which could be taken home, spent on food or spent in another casino. (Craine col. 1, ll. 11-29) Craine provides a method of providing promotional packages to tour patrons that "ensures that the promotional funds are expended in the casino" issuing them. (*Id.*, col. 1, ll. 29-40)

The tracking method described in Craine is accomplished by either a key or player card, which is "encoded so that it can only be used in the casino **[**61]** issuing the key or card." (*Id.*, col. 1, ll. 45-54) In another embodiment, a "touch-memory device" is used in place of a key. ¹⁹ (*Id.*, col. 1 l. 67-col. 2 l. 2) The system is described as follows:

In general the system for tracking casino promotional funds given to casino patrons is comprised of a plurality of gaming machines in a casino. A bank controller is provided for the plurality of gaming machines. A server is coupled to the bank controller for receiving information from and transmitting information to the bank controller. A plurality of memory devices is provided with **[*316]** each memory device having encoded a serial number which can be assigned to the casino patron. An account balance remote from the memory device is placed in the system for each casino patron. An interface device is provided with each gaming machine and is adapted to receive a memory device to permit operation of the gaming machine and to supply information to the bank controller as the account balance is debited thereby making it possible for the casino to track the promotional funds issued by the casino and to ensure that the promotional funds are only expended in that casino.

(*Id.*, col. 3, l. 58-col. 4, l. 7)

FOOTNOTES

¹⁹ "[C]ards **[**62]** can be utilized in place of keys if desired and can be magnetically or optically programmed in a similar manner to provide a currency value in the card which

can be utilized in connection with the controller box or device 41 in the same manner as the keys." (Craine col. 8, ll. 18-23)

The keys have microprocessors which are programmed with a serial number for identification, and a code which "represents casino identification and permits the system of the present invention to differentiate one casino's keys from another casino's keys." (*Id.*, col. 6, ll. 62-68) Craine discloses a central computer, the "mainframe" (Fig. 1) or "main server" (Fig. 12). "The main server **152** keeps track of the historical data of activity on the casino floor," and "also keeps track of inactive keys that are not currently being utilized on the casino floor." (*Id.*, col. 4, l. 24 & col. 8, ll. 63-66) Information relating to the activities of the patron can be "accumulated in the server and/or in the mainframe computer **21**," alternatively, historical data can be maintained in the "main server **152**." (*Id.*, col. 8, ll. 50-66)

Craine generally provides that, "[u]pon the arrival of tours at the casinos, the casino patrons [****63**] would be called by name and be given their assigned touch-memory devices." (*Id.*, col. 13, ll. 26-28) The specification provides that "[a]ll of the activities of the casino patron utilizing the key are recorded in the bank controller **16** which supplies the information to the server **19**. This information can be accumulated in the server and/or in the mainframe computer **21** provided in the computer and at periodic times the information can be printed out on the printer **33** in an appropriate format." (*Id.*, col. 8, ll. 50-56) A patron may request that more funds be placed "in his or her account associated with his or her touch-memory device" by making such a request (and deposit) at the cashier cage. (*Id.*, col. 14, ll. 12-20) "[P]ersonal information on the patron is only ascertained if funds are expended that are greater than those which have been given to the casino patron in connection with the promotion." (*Id.*, col. 14, ll. 20-23) The goal is to keep the amount of information conveyed between the slot machine and the slot bank server "to a minimum thereby increasing the speed of the transaction." (*Id.*, col. 14, ll. 23-25 & 61-65)

If a touch-memory device is lost or stolen, the casino can [****64**] issue a new device to the patron by "deleting the assignment of the earlier serial number to that patron and assigning a new serial number to that casino patron." (*Id.*, col. 14, ll. 35-49) The system described in Craine allows the casino to "readily track the expenditure of [] promotional funds and at the same time ensure that the promotional funds are expended in the casino[.]" (*Id.*, col. 15, ll. 42-54)

ii. "Player account"

The parties dispute, for purposes of anticipation, whether Craine discloses a "player account" as claimed in the '983 patent. According to defendants, Craine discloses a "player account" insofar as it provides that "[a]n account balance remote from the memory device is placed in the system for each casino patron." (D.I. 194 at 17, citing Craine col. 3, ll. 64-68) In addition, defendants point out that in claim 16, Craine discloses "opening an account [***317**] having an account identification at the central data storage for the casino patron assigning a serial number of a memory device to the account of the casino patron." (D.I. 244 at 4, citing Craine col. 17, ll. 17-21)

According to plaintiff, "those of ordinary skill in the art understand that a player account is one in [****65**] which data is continually associated with one particular player and one particular player's club card." (*Id.* at 13) In support, plaintiff cites the deposition transcript of defendants' software engineer, who testified that, in his understanding, a "player account" is "an account that is set up by the casino where one or more data elements are continuously associated with one particular player and one particular card so that the card is used to track player play and give comps and possibly other promotional issues." (*Id.*, citing JA4700 at 63) Plaintiff argues that the account described in Craine is not a "player account" because Craine

is "unconcerned with the identity of the patrons" unless a patron requests additional funds be added to the external device. (D.I. 214 at 12-13)

Defendants do not specifically dispute that Craine discloses a temporary account used to track promotional credits, which account is later recycled,²⁰ but argues that claim 1 of the '983 patent does not require a "particular process for setting up the player account or a "permanent association between a particular player and a particular account" and, therefore, a "player account" is **【**66】** generally disclosed by Craine.

FOOTNOTES

²⁰ (See Craine, col. 2, l. 6 (describing the touch-memory device as "reusable"); col. 7, ll. 28-36 (describing a process of returning keys to the casino); col. 8, ll. 43-49 (same))

The parties did not seek the court's construction of "player account" (D.I. 167); notwithstanding, because claim construction is a matter of law, the court must ultimately make findings sufficient to facilitate disposition of the issue presented to it.

The '983 patent generally provides that the player "account file" contains "the player's name, the amount of credit issued and other information to be described." ('983 patent, col. 36, ll. 63-65) It is unclear from the specification what "other information" may be maintained, and plaintiff does not identify a specific portion of the '983 specification shedding light on the matter. (D.I. 214 at 13) No other intrinsic (or extrinsic) evidence is provided by plaintiff. There is, therefore, no indication on this record that the player account described in the '983 patent contains different information, or is otherwise distinguishable, from that disclosed in Craine. Put another way, the court does not find that the '983 specification **【**67】** supports limiting "player account" in the manner espoused by plaintiff, that is, to an account containing a particular type or quantum of player information and which can not later be recycled or reassigned to another player.

iii. "Accessible by the host computer"

According to Mr. Crevelt, defendants' expert, the player account disclosed in Craine is accessible by the host computer because a "player's account information is accumulated in a server or mainframe, either of which can serve as 'the host computer' in the '983 patent." (D.I. 196 at P 50) Additionally, claim 16 of Craine discloses "transmitting the serial number of the memory device to the central data storage and debiting the account of the casino patron at the central data storage as the gaming machine is utilized by the casino patron." (D.I. 194 at 19; citing Craine col. 17, ll. 27-30) Defendants also **【*318】** point out that, in a response to an Office Action dated June 28, 1993, Craine remarked that "in applicant's method, the player tracking is done in the central computer which only needs to receive the serial number from the memory device." (D.I. 196, ex. 4 at p.5)

Aside from its arguments regarding whether a "player account" **【**68】** is disclosed in the first instance, plaintiff contests the "accessibility" portion of the limitation only on the ground that, in its characterization, "the Craine system tracks when and at which machines the patron is using the promotional credits provided on the external device," and "traces the path this tracking information traverses from the slot machine to the main server." (D.I. 214 at 12, citing Craine col. 13, ll. 58-63) Plaintiff does not explain, nor does it offer any expert testimony regarding: (1) how the mainframe computer (21) or main server (152), disclosed as storing data regarding patron play,²¹ do not necessarily have "access" to a player account; or (2) how, in its view, Craine's system can "trace the path" of patron play without "accessing" the player account. (*Id.*) Plaintiff has failed to establish that a genuine issue of material fact exists on this point.

FOOTNOTES

21 (Craine col. 4, l. 24; col. 8, ll. 50-66)

iv. Location of data

The parties' remaining arguments hinge on whether promotional credits are stored on the memory device or key as disclosed by Craine.

According to defendants and Mr. Crevelt, Craine discloses that the casino applies a promotional credit to the player's **["*69]** account. Under their interpretation, Craine discloses "applying a promotional credit to the player's account," "permitting the player access to the account," and "transferring promotional credits in the account to the gaming device" as required by claim 1 of the '983 patent, because a player's wagering of promotional credits at the gaming device ("debiting" of his or her player account) requires transfer of credits directly to the gaming machine. (D.I. 194 at 19-20; D.I. 244 at 5-8; D.I. 196 at PP 53, 55)

Defendants point to several portions of Craine in support of their interpretation, for example: (1) "[a]n interface device . . . permit[s] debiting of the account balance of the casino patron" (abstract); (2) "[a]n account balance **remote from the memory device** is placed **in the system** for each casino patron" (Craine col. 3, ll. 66-68) (emphasis added); (3) "[a]n interface device is provided . . . to supply information to the bank controller as the account balance is debited thereby making it possible for the casino to track the promotional funds by the casino" (*id.*, col. 3, l. 68-col. 4, l. 7); (4) "crediting a currency value representing a promotional fund of the casino to **["*70]** the account of the casino patron" (claim 16) (emphasis added); and (4) "debiting the account of the casino patron **at the central data storage** as the gaming machine is utilized by the casino patron" (claim 16) (emphasis added).

Plaintiff presents a different view of Craine. According to plaintiff's expert, Mr. Spencer,²² Craine discloses that **["*319]** "[c]redits are transferred from the memory device to the gaming machine - not from the player account to the gaming device[.]" (D.I. 185 at P 296) In support for his opinion that promotional credits are stored on the memory key or card in Craine, and not in a remote player's account, Spencer relies on several portions of the Craine specification, including: (1) the "controller box or device **41** makes the slot machine believe . . . that a physical coin has been dropped into the machine when in fact only a debit has been removed **from the key or card** as hereinafter described" (col. 6, ll. 13-21; see also col. 4, ll. 59-68) (emphasis added); (2) "[t]he microprocessor **121** in each key] also has the capability of being encoded with a specific amount of money which can be varied in accordance with the desires of the casino issuing the key" (col. 7, ll. **["*71]** 3-6); (3) "it should be appreciated that cards can be utilized in place of keys if desired and can be magnetically or optically programmed in a similar manner to provide a currency value **in the card** which can be utilized in connection with the controller box or device **41** in the manner as the keys" (col. 8, ll. 18-24) (emphasis added); and (4) "[w]ithin the control set by the casino, the casino patron can then use the credit amount **on the key or card** to operate the slot machines and to attempt to achieve winnings from those slot machines" (col. 8, ll. 35-39) (emphasis added). (D.I. 185 at P 300)

FOOTNOTES

22 Notably, plaintiff did not cite Mr. Spencer's report in support of its opposition to

defendants' motion on the "applying a promotional credit to the player's account" or "permitting the player to access the account" limitations of the '983 patent; plaintiff first cited Mr. Spencer's report in the context of discussing "transferring promotional credit in the account to the gaming device." (D.I. 214 at 14-17) As the parties' arguments demonstrate, Craine (and the '983 patent) are not so easily understandable such that expert testimony would not be required to demonstrate anticipation. *See Koito Mfg. Co., Ltd. v. Turn-Key-Tech, LLC*, 381 F.3d 1142, 1152 n.4 (Fed. Cir. 2004); **[**72]** *see also Schumer v. Lab. Computer Sys., Inc.*, 308 F.3d 1304, 1315-16 (Fed. Cir. 2002) (**HN13**—"Typically, testimony concerning anticipation must be testimony from one skilled in the art[.]"") On the papers, the court was prepared to find that plaintiff failed to raise a genuine issue of material fact with respect to the former limitations. Because Mr. Spencer's opinion supports plaintiff's position, however, the court will allow the jury to hear argument on all of the limitations.

The court does not substitute itself for the jury and make credibility determinations regarding the experts' conflicting views of the disclosure of Craine. Summary judgment of anticipation is inappropriate with respect to whether Craine discloses "applying a promotional credit to the player's account," "permitting the player access to the account," and "transferring promotional credits in the account to the gaming device."

v. "Preventing the promotional credit from being cashed out by the player"

Defendants assert that Craine discloses "preventing the promotional credit from being cashed out by the player" in several portions of its specification: (1) an "object of the invention" is to "ensure that the promotional funds **[**73]** are expended in the casino issuing the promotional funds" (col. 1, ll. 36-40); (2) an interface device is provided for this purpose (col. 3, l. 68-col. 4, l. 7); and (3) claim 16 discloses "[a] method for tracking casino promotional funds given to a casino patron to require that such promotional funds given to a casino patron be utilized on gaming machines of the casino" (col. 17, ll. 9-12). Plaintiff does not dispute that Craine seeks to prevent promotional credit from being cashed out by the player, but argues that it discloses no specific mechanism for doing so. (D.I. 214 at 18) A prior art reference must be enabled to be anticipatory. *See, e.g., In re Donohue*, 766 F.2d at 533.

At his deposition, Mr. Crevelt did not identify a particular disclosure in Craine to this effect, but also noted that there is no indication in Craine of a player being able to cash out the promotional credits. (D.I. 237 at JA2937, 342-44) As defendants point out in their reply papers, Craine discloses that it is an object of the invention to provide a system "in which the key **[*320]** or card is encoded so that it only can be utilized in the casino issuing the key or card" (col. 1, ll. 53-54) and provides that the **[**74]** "interface device" makes it possible to ensure that promotional funds are only expended in the casino issuing the device (col. 3, ll. 68-col. 4, l. 7). The dispositive issue, therefore, is whether these disclosures are enabling, or sufficient to place the claimed invention in the possession of the public.

Neither party points to expert testimony on this subject, and the briefing provided on the limitation at issue is limited. As discussed previously, the court does not grant defendants summary judgment that claim 1 of the '983 patent is anticipated because of disputes of fact surrounding several limitations. With respect to the "preventing the promotional credit from being cashed out by the player" limitation, the court additionally notes that defendants have not responded to plaintiff's enablement argument with any evidence. Summary judgment is denied on this additional ground. Because plaintiff has not cross-moved for summary judgment of no anticipation based on Craine, the court need not further evaluate plaintiff's argument in this regard.

c. Obviousness in view of Craine

Defendants argue that if any elements of claim 1 of the '983 patent are not found to be present in Craine, they **[**75]** nonetheless would have been obvious to one of ordinary skill in the art. (D.I. 194 at 21-23)

HN14 In appropriate circumstances, a single prior art reference can render a claim obvious. However, there must be a showing of a suggestion or motivation to modify the teachings of that reference to the claimed invention in order to support the obviousness conclusion. This suggestion or motivation may be derived from the prior art reference itself, . . . , from the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved.

SIBIA Neurosciences, Inc. v. Cadus Pharmaceutical Corp., 225 F.3d 1349, 1356 (Fed. Cir. 2000) (internal citations omitted). In support of their argument, defendants rely on the opinion of Mr. Crevelt. Mr. Crevelt's declaration, however, contains little more than conclusory allegations of obviousness and fails to identify any supporting evidence for his opinions regarding the knowledge of one skilled in the art. (D.I. 196 at PP 51, 52, 54, 56)

Mr. Crevelt offers only one short paragraph of analysis regarding the scope or content of the art at all, and this concerns the Caesars Request System, a system used at the Caesars Palace Casino in Las Vegas **[**76]** in 2001 or thereabouts. (D.I. 196 at P 59) According to defendants, the Caesars Request System is relevant to the knowledge of ordinary skill in the art as it relates to the '983 patent; specifically, that systems employing non-cashable credits existed and were "spurred by market forces, not scientific or technological innovation." ²³ (D.I. 194 at 24-25; see also D.I. 196 at P 59)

FOOTNOTES

²³ To be clear, defendants do not specifically assert that a combination of Craine and the Caesars Request System renders claim 1 of the '983 patent obvious.

Defendants' argument that the Caesars Request System can be used to demonstrate the differences between the prior art and the claims, pursuant to *Graham v. John Deere Co.*, 383 U.S. at 17-18, is fatally flawed insofar as defendants admit the Caesars Request system is not prior art. (D.I. 194 at 13 & 24); see 35 U.S.C. § 103(a) (**HN15** "A patent may not be obtained though the invention is not identically disclosed or described as set forth in **[*321]** section 102 of this title, if the differences between the subject matter sought to be patented and the **prior art** are such that the subject matter as a whole would have been obvious at the time the invention was made to a person **[**77]** having ordinary skill in the art to which said subject matter pertains.") (emphasis added). ²⁴

FOOTNOTES

²⁴ Compare *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1403-04 (Fed. Cir. 1997) (holding that § 102(f) non-public subject matter can be used to reject a claim of invention by another in possession of the § 102(f) subject matter under a combination of § 102(f) and § 103). Plaintiff claims that defendants copied the "Acres Lucky Coin" (D.I. 179 at 6) and "XTRA Credit" (D.I. 214 at 26) products for which it acquired rights; there is no claim that defendants copied the Caesars Request System.

Notwithstanding the defects in defendants' case, the court notes that plaintiff has adduced

evidence which demonstrates that genuine issues of fact remain as to obviousness. Mr. Spencer opines that Craine teaches away from the '983 patent insofar as it uses a memory device extraneous to the system as a means to store and debit the promotional credits. (D.I. 185 at PP 298, 302) Mr. Schwartz, plaintiff's expert, opines that secondary considerations of nonobviousness exist in this case: (1) defendants copied the invention (D.I. 215 at P 98); and (2) the claimed inventions solved a long-felt need to **[**78]** create a bonusing system that could be limited to play on the casino floor, compared to previous methods such as free rolls of quarters (*id.* at PP 112-13). Summary judgment of obviousness is inappropriate.

d. Conclusion

For the foregoing reasons, defendants have not demonstrated the lack of a genuine issue of material fact with respect to anticipation by Craine. Defendants have also not demonstrated that summary judgment of obviousness based on Craine is appropriate. Defendants' motion, therefore, is denied. There is no cross motion by plaintiff regarding the validity of the '983 patent.

3. Cross-motions regarding the validity of the '812 and '885 patents

a. The asserted prior art references

U.S. Patent No. 5,580,309 to Piechowiak et al. ("Piechowiak"), entitled "Linked gaming machines having a common feature controller," was filed on February 22, 1994 and issued on December 3, 1996. **[**78]** Piechowiak describes a networked gaming system in which one or more "features," such as a "bonus award," is provided to "all of the gaming machines linked to the system." (Piechowiak col. 1, ll. 47-57) Alternatively, "only selected ones of the gaming machines are temporarily provided with a certain feature, **[**79]** where the feature is enabled based on the occurrence of some event." (*Id.*, col. 1, ll. 67) "[A] criterion for enabling the feature may be a specified number of occurrences of a predetermined combination of indicia displayed by the gaming machines" or a "predetermined lapse of time between periods during which the feature has been disabled." (*Id.*, col. 3, ll. 6-10; col. 4, ll. 2-5) A feature controller periodically polls each of the networked gaming machines, comparing the results of each machine to predetermined criteria stored on the system. (*Id.*, col. 3, ll. 1-5) If the feature-enabling criteria have been met, "the feature is made available to all linked gaming machines"; a win is thereafter awarded based on the **[*322]** enabled feature "to the first linked gaming machine to generate a game result which matches the feature award criteria." (*Id.*, col. 3, ll. 22-41)

FOOTNOTES

25 The parties do not dispute that each of the asserted references predate the inventions at issue and constitute prior art.

U.S. Patent No. 4,652,998 to Koza et al. ("Koza"), entitled "Video gaming system with pool prize structures," was filed on January 4, 1984 and issued on March 24, 1987. Koza provides an arcade game network that **[**80]** awards prize awards "based upon a random shuffling of a set of prize awards among a predetermined pool of plays for each remote game terminal." (Abstract) "Video amusement game lottery terminals" are connected to a central computer (a "central controller"). (Koza, col. 2, ll. 16-29 & Fig. 1) Multiple network components exist between the central computer and the arcade device. (*Id.*, Fig. 4) Among these components is a "terminal controller processor" which "insure[s] accurate prize payouts guaranteeing a predetermined total prize value within a preselected group of plays, referred to as a 'pool.'" (*Id.*, col. 11, ll. 26-30) The pool is divided into a thousand mini-pools of a thousand plays each; this "mini-pool" is used to implement a low-end prize structure. (*Id.*,

col. 11, ll. 30-58)

U.S. Patent No. 5,280,909 to Tracy ("Tracy"), entitled "Gaming system with progressive jackpot," was filed February 6, 1992 and issued January 25, 1994. Tracy describes a progressive gaming system. Multiple gaming machines are linked together via a "programmed controller" that "receives from the machines [a] unit bet and machine identification information and supplies to the players . . . information as to **[[**81]]** the common jackpot." (Tracy, col. 1, ll. 45-58) The current jackpot value, updated by the controller, is compared to a "jackpot-win value"; when the current jackpot reaches this threshold, the controller determines that a jackpot has been won by the winning machine and payment is made to the player. (*Id.*, col. 2, ll. 13-32) A modification is described whereby the controller conveys "payout and control signal information for enabling the gaming machine to make the payout." (*Id.*, col. 6, ll. 62-69) "With this modification each gaming machine is itself adapted to recognize and respond to the payout and control signal information from the controller and to make the required payout." (*Id.*, col. 7, ll. 1-4) "[T]he payout need not be based on a fixed or randomly generated jackpot-win value. Instead, the payout can be based on other predetermined criteria which the gaming machine can assess and follow in making a payout in response to the control signal in the signaling information. These criteria can include, for example, conditions at the gaming machine itself." (*Id.*, col. 7, ll. 10-17)

Piechowiak, Koza, and Tracy were each before the examiner during prosecution of the '882 and '817 patents, **[[**82]]** from which the '885 and '812 patents were respectively reissued, and a second time during reissue proceedings. (D.I. 181 at 9; D.I. 220 at 14)

PCT Application No. WO 80/02515 to Krause et al. ("Krause"), entitled "Computerized gaming system," was published on November 27, 1980. (JA5140) Krause describes a plurality of gaming devices connected to a remote central computer. The central computer "continuously communicates" with the gaming devices. (Krause, col. 2, ll. 13-19) The gaming device allows a player to select random indicia, such as a number between 0 and 9, to be matched with a randomly-generated number (or other indicia such as a symbol). If a match is made, a prize is paid out; if the prize amount exceeds a predetermined amount, the prize is awarded by issuing a ticket which must be redeemed at another location. (*Id.*, col. 2, l. 23-col. 3, l. 26) In one embodiment of Krause, **[[**323]]** "the prize structure of the game may be changed randomly or according to the time of day." (*Id.*, col. 19, ll. 8-11) This change may be controlled by an internal clock in the game machine terminal or by signals received from the central computer. (Col. 19, ll. 18-24) In either case, the central computer **[[**83]]** keeps track of "which machines are under the control of which prize structure." (*Id.*)

U.S. Patent No. 5,046,736 to Bridgeman, et al. ("Bridgeman"), entitled "Imitative-opponent gambling devices," was filed on October 11, 1988 and issued September 10, 1991. Bridgeman describes an electronically-simulated poker game, or video poker. "Several video screens controlled by a central processor can be hooked together, allowing several lead players to play the same game at the same time." (Bridgeman, col. 2, ll. 15-17; Fig. 1C; col. 8, l. 62-col. 9 l. 2) Several different payoffs are provided, including a "winner bonus, loser bonus, fold bonus, and jackpot bonus." (*Id.*, col. 2, ll. 11-14; Fig. 15) These bonuses generally correspond to provided bonus tables. (*Id.*; Fig. 15)

b. Plaintiff's motion of no anticipation by Piechowiak ²⁶

FOOTNOTES

²⁶ There is no cross-motion by defendants.

i. '885 Patent

Plaintiff moves for summary judgment of no anticipation by Piechowiak. (D.I. 181 at 11) With respect to the '885 patent, the parties dispute whether Piechowiak discloses "preselecting less than all of the gaming devices interconnected by the host computer **responsive to a user-effected action [or host computer action]**" **[**84]** as required by the '885 patent. According to defendants, Piechowiak discloses this limitation by generally stating that, in one embodiment, "only selected ones of the gaming machines are temporarily provided with a certain feature" award. (D.I. 220 at 17, citing Piechowiak, col. 1, ll. 64-67) At his deposition, Crevelt admitted that Piechowiak does not explicitly disclose a user interface which could be used to "preselect" participating devices. (JA2840 at 202:10-17)

(a) Law of anticipation based upon inherency

HN16 A prior art reference may anticipate without explicitly disclosing a feature of the claimed invention if that missing characteristic is inherently present in the single anticipating reference. See *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). The Federal Circuit has explained that an inherent limitation is one that is "necessarily present" and not one that may be established by "probabilities or possibilities." See *id.* at 1268-69. That is, "[t]he mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at 1269 (emphasis in original) (citations omitted).

(b) Defendants' arguments

Relying on Mr. Crevelt, **[**85]** defendants argue that the user-operated input device is inherent in Piechowiak. (D.I. 220 at 17, 34-35) At his deposition, Mr. Crevelt stated that Piechowiak's disclosure that a feature is provided "only to selected ones of the gaming machines" "implies that there is some [user] input device or method to make such a selection"; "[I]t would be inherent in this patent that you would have some method of making that user interface of some sort to make that selection . . . the input device would be inherent to the system." (JA2840 at 201:17-202:14) Defendants point to no explanation by Mr. Crevelt of how Piechowiak "necessarily" **[**324]** discloses that "user-effected action" or "host computer action" can take place, or other evidence in this regard. In contrast, plaintiff points out that Piechowiak discloses that the feature-enabling criteria of its system are stored in ROM (read-only memory), which Mr. Crevelt himself characterized in his deposition as "unalterable memory." (D.I. 181 at 10; JA2843 at 213:20-25; Piechowiak, col. 2, ll. 40-42 ("The operation of feature controller **110** is controlled by a program stored on ROM **126**," described as hard-wired by communication lines)) According to Mr. Spencer, **[**86]** Piechowiak teaches away from user configurability by disclosing a system where the "feature" criteria are stored in unalterable memory. (D.I. 185 at P 68) Defendants opted not to file a reply brief addressing these arguments.

Even should a jury credit Mr. Crevelt's testimony and discredit Mr. Spencer's interpretation of Piechowiak, defendants point to no evidence that Piechowiak "necessarily" discloses a user input device (or other means) to effectuate a selection of only some of the networked gaming machines. Defendants did not dispute that the Piechowiak "feature" is stored in ROM, an unalterable memory component. Mr. Crevelt has done nothing more than state that Piechowiak inherently anticipates; more than this conclusion is required for a reasonable jury to find in defendants' favor.

(c) Lack of enabling disclosure

As noted previously, to serve as an anticipating reference, Piechowiak must enable that which it is asserted to anticipate. See *Amgen, Inc.*, 314 F.3d at 1354. Plaintiff asserts that "Piechowiak's lack of disclosure of any method for providing a feature to only certain gaming

devices is fatal to [defendants'] assertion of invalidity[.]" (D.I. 240 at 11) Mr. Crevelt admitted **[**87]** at his deposition (in July 2008) that Piechowiak did not specifically list a selection methodology. (JA2841 at 206:15-17) In November 2008, Mr. Crevelt submitted a supplemental declaration in which he stated the following:

Piechowiak '309's system includes "suitable decoders within the gaming machines 101-108 so that the gaming machines 101-108 can be addressed using digital codes." ([Piechowiak] 2:20-22) The central server may include "an address/data bus" for communicating with specific gaming devices via the specific suitable decoders. ([Piechowiak] 2:13-18)

(D.I. 223, ex. 6) This is the sole evidence pointed to by defendants in response to plaintiffs enablement argument. (D.I. 220 at 35)

In view of Mr. Crevelt's admission that Piechowiak does not disclose a preselection method and, therefore, does not teach one of ordinary skill in the art how to carry out the "preselecting" limitation, Mr. Crevelt's subsequent statement falls short of demonstrating a genuine issue of material fact with respect to enablement. The cited Piechowiak disclosure is extremely general:

[Multiplexer/de-multiplexer circuit] **120** may be replaced with an address/data bus and suitable decoders within the gaming **[**88]** machines **101-108** so that the gaming machines **101-108** can be addressed using digital codes.

(Piechowiak, col. 2, ll. 19-22) Mr. Crevelt does not state that (let alone explain how) this disclosure enables one of ordinary skill in the art to "preselect[] less than all of the gaming devices interconnected by the host computer responsive to a user-effected action [or host computer action]." Nor does he indicate that this disclosure would sufficiently enable one of ordinary skill in **[*325]** the art to do so without undue experimentation. This is not the case where an expert has conclusively provided a response to plaintiffs anticipation defense; defendants point to no opinion at all.

(d) Conclusion

In view of the fact that two separate patent examiners found that Piechowiak did not anticipate the '885 patent, a fact that a jury would be entitled to consider, no reasonable jury could find that defendants meet the "especially difficult" clear and convincing burden to demonstrate that Piechowiak disclosed the "preselecting less than all of the gaming devices interconnected by the host computer responsive to a user-effected action [or host computer action]" limitation. See *PharmaStem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342, 1371 (Fed. Cir. 2007) **[**89]** (citing *Hewlett-Packard Co.*, 909 F.2d at 1467). Summary judgment of no anticipation by Piechowiak is granted in favor of plaintiff with respect to the '885 patent. ²⁷

FOOTNOTES

²⁷ The court need not address the parties' arguments regarding the other contested limitations, for example, "issuing a command or a message."

ii. '812 patent

Piechowiak is also asserted as an anticipatory reference against claims 21 and 44 of the '812 patent, which require "storing the message in a memory connected to a controller associated with only one of the gaming devices." In support of its argument that Piechowiak does not

disclose this limitation, plaintiff cites the following portion of Mr. Crevelt's testimony regarding Piechowiak:

Q. Is the memory of the gaming machine connected to a controller associated with only one gaming device?

A. That memory in the gaming machine would be in the gaming device, and it's connected to the feature controller.

Q. And is the feature controller associated with only one gaming device?

A. Only if you had a network of one machine.

Q. Does Piechowiak disclose a network of one machine?

A. It does - it generally discloses a network of multiple machines.

Q. For purposes of this litigation, are **[**90]** we interested in networks of one gaming machine?

[Objection]

A. Generally not.

(JA2931 at 323:24-324:20) Mr. Spencer opines that the memory of the gaming device itself does not satisfy this limitation because "according to the language of claims 21 and 44, the controller must receive data indicative of gaming device activity from the gaming device and issue a pay command to the gaming device." (D.I. 185 at P 283) Therefore, the memory must be independent of the device itself. (*Id.*)

Defendants point to the following disclosure of Piechowiak in response: Gaming Machines **101-108** may operate independently of each other during this normal operation mode and award wins based on a normal payout criteria stored in either ROM **126** of feature controller **110** or in a memory (i.e., an award table) contained within each of the linked gaming machines.

(D.I. 220 at 27 & 47, citing Piechowiak, col. 2, ll. 53-58) The above-referenced passage indicates that there is a memory contained in each machine that can contain an award table and be accessed when a win occurs. It does not shed light, however, on whether the feature controller can store a message in the memory of one machine. In other words, certain information **[**91]** can clearly **[*326]** flow "out" of this independent memory; it is not clear from this passage that information can flow "in" to a single machine's memory. Defendants point to no expert opinion interpreting this passage. (*Id.*)

Defendants also point to U.S. Patent No. 4,837,728 to Barrie et al. ("Barrie"), and assert that Barrie "discloses a separate controller associated with each individual game in the linked system and 'coupled for two way communication with' the central controller." (D.I. 220 at 27) Barrie is generally incorporated by reference by Piechowiak. The "Background of the Invention" portion of the Piechowiak specification comprises the following passage:

Progressive jackpot gaming systems, comprised of one or more interconnected gaming machines which award a progressive jackpot award, are well known. . . U.S. Pat. No. 4,837,728 to Barrie et al., incorporated herein by reference, describes one such progressive gaming system comprised of linked slot machines. The circuitry and software used to fabricate and operate these conventional linked gaming machines are well known to those skilled in the art.

(Piechowiak, col. 1, ll. 30-43) The subject matter sought to be incorporated into Piechowiak **[**92]** from Barrie is the disclosure of a central progressive controller, as follows:

Each game controller is coupled for two-way communication with a rapidly incrementing progressive controller. The progressive controller receives data from each game controller indicating coin receipt and game wins. The progressive controller assigns a portion of each coin to increment progressive bonus meters in accordance with a payout schedule, such as described above. The progressive controller then forwards the meter totals to each game controller to increment the meter amounts displayed by the game controllers.

When win information is received by the progressive controller, the game controllers are reset When game play is complete, a win is paid or loss is generated and the meters are thereafter reset by the progressive controller to the current progressive bonus value.

(D.I. 220 at 27, citing Barrie, col. 2, ll. 38-58) According to defendants, "there is no dispute that controllers in the prior art stored criteria for bonus awards to be paid." (*Id.*) Again, no expert opinion is cited in support. Plaintiff does not specifically address anticipation in its reply papers. (D.I. 240)

It is ultimately **[**93]** defendants' burden to prove anticipation at trial by clear and convincing evidence. Having reviewed the present record, the court finds that defendants have not adduced evidence upon which any reasonable jury could find that Piechowiak anticipates claims 21 or 44 of the '812 patent, more specifically, the "storing the message in a memory connected to a controller associated with only one of the gaming devices" limitation.

There is no evidence that Piechowiak discloses to one of ordinary skill in the art that a command or message including criteria to cause a bonus to be paid via one gaming device is "stored" in memory connected to a "controller" that is associated with only one machine. As defined by the court in its order of the same date, a "command" or "message" results in the reconfiguration of the device such that the device pays out extra money it would not have paid in its regular configuration. Piechowiak discloses only that an independently-operating machine can award a win based on "normal payout criteria" stored in its own memory. There is no indication that a reconfiguration command or message is stored in the machine at all, let alone in a memory "connected to a controller" **[**94]** associated with only one device; defendants **[**327]** point to no testimony in support of their assertion to the contrary.

The quoted portion of Barrie, even if incorporated into Piechowiak, ²⁸ does not provide these details. Barrie provides that two-way communication occurs between the progressive controller and the gaming controller, but the information received is data "indicating coin receipt and game wins" and the information forwarded is "meter totals . . . to increment the meter amounts displayed by the game controllers." Again, there is no indication that a reconfiguration command or message is stored in the machine in a memory "connected to a controller" associated with only one device; defendants proffer only attorney argument to the contrary.

FOOTNOTES

²⁸ *HN17* Incorporation by reference is a legal issue to be determined by the court. See *Advanced Display Sys. Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000) Incorporation by reference requires a statement "clearly identifying the subject matter which is incorporated and where it is to be found." *In re Severisky*, 474 F.2d 671, 674 (C.C.P.A. 1973). "[A] mere reference to another application, or patent, or publication is

not an incorporation **[**95]** of anything contained therein. . . ." *Id.* Put another way, the host document "must cite the material in a manner that makes clear that it is effectively part of the host document as if it were explicitly contained therein." *Advanced Display Sys.*, 212 F.2d at 1282. It must, therefore, both (1) "identify with detailed particularity what specific material it incorporates"; and (2) "clearly indicate where that material is found in the various documents." *Id.* (citations omitted).

The parties have not focused on this issue and, therefore, have not put forth evidence regarding what one reasonably skilled in the art would find incorporated by reference by the language of Piechowiak. *Id.* On its face, Piechowiak incorporates Barris as a "background" reference describing networked gaming devices. It also imports Barrie's disclosure of the "circuitry and software" used to operate its network. Piechowiak does not specifically mention the progressive controller computer program described in Barrie. Because the progressive controller appears to be "software," there is a colorable argument for incorporation by reference of this feature, generally. However, Piechowiak does not mention two-way communication **[**96]** with such a progressive controller - such communication is neither "circuitry" nor "software." In short, Piechowiak does not "identify with **detailed** particularity" the specific material in Barrie referenced by defendants nor does it "clearly indicate where that material is found in [Barrie]." *Id.* (emphasis added)

The court concludes that defendants did not meet their burden to demonstrate the existence of a genuine issue of material fact on this issue. As with the '885 patent, the court's conclusion is bolstered by the fact that a jury would be entitled to consider the fact that two separate examiners found that Piechowiak does not anticipate the '812 patent claims. See *PharmaStem Therapeutics, Inc.*, 491 F.3d at 1371 (citation omitted). For the aforementioned reasons, the court grants plaintiff's motion of summary judgment of no anticipation of claims 21 and 44 of the '812 patent by Piechowiak.

c. Cross-motions on obviousness

i. Claims 1 and 22 of the '885 patent

(a) "Preselecting" limitation

Mr. Crevelt opines that claims 1 and 22 of the '885 patent are rendered obvious by Koza, in view of Piechowiak, Bridgeman, Krause and Tracy. (D.I. 223 at P 26) The primary disagreement between the **[**97]** parties is whether the prior art teaches (or suggests) the "preselecting less than all of the gaming devices interconnected by the host computer responsive to a user-effected action [or host computer **[*328]** action]" limitation of the '885 patent. ²⁹ Defendants highlight the following selection of Koza as providing this disclosure:

The sophisticated centrally controlled lottery system can draw a random sampling of players who can be asked to participate in an electronic marketing survey. In the electronic marketing survey a free game play is offered on the remote terminal if the player will answer a few, simple market survey questions.

(Koza, col. 22, ll. 62-68) Defendants point to no expert testimony (or other evidence) in support of their interpretation in their papers. (D.I. 220 at 19) On its face, this portion of Koza does not clearly describe "a central host [computer] that is capable of making certain features available to a select group of machines." It is unclear whether the "random sampling" of players for a survey (resulting in a "free play") is comparable to a "user-effected" or "host computer" action causing the preselection of certain gaming machines to

participate in a promotion. **[**98]** Mr. Crevelt conclusorily states in his declaration that Koza "discloses a plurality of gaming machines, wherein at least some of the gaming machines provide for bonusing games/pools that are independent of bonusing games/pools offered on other gaming machines of the gaming system." (D.I. 223 at PP 30, 40 & ex. 5 at 3, 9) No rationale for his opinion that the "preselecting" limitation is taught by Koza is provided. (*Id.*)

FOOTNOTES

²⁹ *HN187* In determining obviousness, the inquiry is not whether each limitation existed in the prior art, but whether the prior art made obvious the claimed invention as a whole. See *Hartness Int'l, Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108 (Fed. Cir. 1987). The court evaluates, therefore, whether a genuine issue of fact exists with respect to whether any asserted reference discloses the "preselecting" limitation and, if not, whether a question of fact exists with respect to whether this limitation was suggested by the prior art.

On this record, and in view of defendants' high burden to show obviousness by clear and convincing evidence, the court finds that defendants have not demonstrated a genuine issue of material fact with respect to whether Koza demonstrates the **[**99]** "preselecting" limitation.

The court finds, however, that an issue of fact exists with respect to whether Piechowiak suggests the "preselecting" limitation. As discussed previously, Piechowiak does not expressly disclose the "preselecting" limitation. Mr. Crevelt opines that Piechowiak suggests a user input device when it describes the selection of a subset of gaming machines. (D.I. 220 at 18, citing JA2840 at 201:17-202:14) Plaintiff's expert, Mr. Spencer, opines that Piechowiak teaches away from user configurability by disclosing a system where the "feature" criteria are stored in unalterable memory (or ROM). (D.I. 185 at P 68) On this record, there are conflicting expert opinions regarding the disclosure of Piechowiak, evidencing a triable issue.

Finally, defendants argue that, even if no reference discloses the "preselecting" limitation, that limitation was obvious to a person of ordinary skill in the art. ³⁰ Defendants emphasize that John Acres, a named inventor on the '885 patent, testified that the design of the patented system, including the "preselected" element, was driven by the design consideration of eliminating wires from the casino floor. (D.I. 220 at 20-23, citing JA5040-43 **[**100]** at 91:22-94:21) Acres' motivation **[*329]** is not determinative on the issue of obviousness.

^{HN19} The test for obviousness is not whether it would have been obvious to try to make the invention. Further, "[t]he decision of obviousness *vel non* is made not from the viewpoint of the inventor, but from the viewpoint of a person of ordinary skill in the field of the invention." *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 956 (Fed. Cir. 1997) (citations omitted). In short, defendants point to no expert testimony regarding the viewpoint of one of ordinary skill in the art, and cannot prove obviousness under this "general obvious" theory.

FOOTNOTES

³⁰ *HN20* "There is no absolute requirement that each claim limitation be disclosed in a prior art reference," however, "it is the rare invention that is not a combination of prior art elements." *Abbott Laboratories v. Sandoz, Inc.*, 544 F.3d 1341, 1377-78 (Fed. Cir. 2008) (citations omitted).

(b) Motivation to combine

In view of the fact that defendants can potentially demonstrate that the "preselecting" limitation is suggested by Piechowiak, the next inquiry is whether defendants have iterated a motivation to combine Piechowiak with the other asserted prior art references. **[**101]** ³¹ Mr. Crevelt summarily opines that, "[i]n light of the teachings of Koza [] and Krause [],[³² it would have been obvious to one of skill in the art to program the central computer of Piechowiak [] to cause a given feature to be enabled, at least temporarily, at a subset of connected gaming machines." (D.I. 223 at PP 30, 40, ex. 5 at 3-4) Mr. Crevelt does not specifically state that there was a motivation for a person of skill in the art to combine Koza with the additional references, with the exception of one statement in the context of the "associating each gaming device with a unique address code" limitation. ³³ Accordingly, there is no rationale provided by Mr. Crevelt for why a person of ordinary skill in the art would make the asserted combination of five references, or would have reasonably expected success as a result. On this record and in view of defendants' heightened burden to show obviousness by clear and convincing evidence, the court finds that no reasonable jury could find in favor of defendants. Summary judgment is granted for plaintiff on claims 1 and 22 of the '885 patent.

FOOTNOTES

³¹ The court notes that defendants very briefly address two other limitations, "using the **[**102]** network" and "issuing a command or message." (D.I. 220 at 24-25) The parties have not focused on these arguments, and the court need not issue a finding on this record in view of its ultimate finding that defendants cannot demonstrate a motivation to combine the asserted references.

³² Defendants do not argue in their papers that the "preselecting" limitation is disclosed in Krause. (D.I. 220 at 17-19) Mr. Crevelt provides a citation to Krause in his claim chart, and states that the central computer of Krause "can be programmed to award a bonus win responsive to a predetermined number of game plays." (D.I. 223, ex. 5 at 3, citing Krause, col. 13, ll. 12-19 and col. 19, ll. 30-34) Plaintiff's expert, Mr. Spencer, opines in his declaration that the central computer of Krause does not relate to the "preselecting" limitation and, absent any relevant disclosure, "one of ordinary skill in the art would not have been motivated to combine these references in the manner suggested by Mr. Crevelt." (D.I. 185 at PP 97-98)

³³ It "would have been obvious to combine [the] address codes [of Piechowiak and Tracy] with the Koza [] sytem to achieve the greater efficiency and ease of monitoring that those **[**103]** codes provide." (D.I. 223 at PP 29, 39)

ii. Claims 10, 33 and 46 of the '885 patent

Defendants' assertions regarding the remaining claims of the '885 patent suffer from the same deficiencies. Again, with the exception of one statement in the context of the "unique address code" limitation, Mr. Crevelt does not specifically state that there was a motivation to combine Piechowiak with Bridgeman, Krause and Tracy. Mr. Crevelt merely opines that, "[i]n light of the teachings of Krause [], it **[*330]** would be obvious to one of ordinary skill in the art to program the central computer of Piechowiak [] to cause a given feature to be enabled, at least temporarily, at a subset of connected gaming machines." (D.I. 223 at PP 51, 61, 73, ex. 7 at 3, 7-8, 13) Absent any rationale for why a person of ordinary skill in the art would make the asserted combination of four references, or would have reasonably expected success as a result and, in view of defendants' heightened burden to show obviousness by

clear and convincing evidence, the court finds that no reasonable jury could find in favor of defendants and grants summary judgment for plaintiff on claims 10, 33 and 46 of the '885 patent.

iii. Claims 21 [**104] and 44 of the '812 patent

Defendants assert that claims 21 and 44 of the '812 patent are rendered obvious by Piechowiak in view of Tracy. The primary dispute between the parties is whether the prior art discloses or suggests the "storing the command or message in a memory connected to a controller associated with only one of the gaming devices" limitation of claims 21 and 44. To this end, defendants argue that Barrie discloses a separate controller associated with individual games in a linked system. (D.I. 220 at 27) As discussed *supra*, the parties have not focused on the extent to which Barrie is incorporated by reference into Piechowiak. Even assuming that Piechowiak's general incorporation of Barrie's "circuitry and software" suffices to incorporate the controller, there is no disclosure in Barrie that a reconfiguration command, as defined by the court, is stored in memory "connected to a controller" associated with only one device. Defendants point out that Piechowiak discloses storing award criteria in a single machine's memory (D.I. 220 at 27); again, award criteria is distinguishable from a reconfiguration command.

Mr. Crevelt states that "it would be obvious to one of ordinary [**105] skill in the art to program the central computer of Piechowiak [] to establish criteria, at least temporarily, for a bonus to be paid at one of the connected gaming machines upon the occurrence of a predetermined event. For example, as described above, bonus conversion tables for groups of gaming machines on a casino floor . . . have long been sent to the machines and are stored in the [standby memory image buffer] in each applicable machine. This provides a casino operator with additional and more efficient ways to monitor the casino floor and to provide patrons with incentives to play the casino's machines." (D.I. 223 at PP 85, 97) Mr. Crevelt does not specifically explain why a person of ordinary skill in the art would be motivated to store a reconfiguration command, as compared to a regular payout command, in a memory connected to only one machine.³⁴

FOOTNOTES

³⁴ As explained previously, the court finds Acres' motivation for the development of the patented technology irrelevant to the question of obviousness; defendants can not demonstrate that the "storing the command" limitation is obvious as a matter of law in view of this evidence. (D.I. 220 at 28)

The court notes at this juncture that, [**106] in its reply papers, plaintiff introduces arguments that the asserted prior art does not disclose the "transmitting a pay command from the controller to the gaming device upon the occurrence of the predetermined event" limitation of claims 21 and 44 of the '812 patent. (D.I. 240 at 24-25) The filed copy of Mr. Crevelt's supplemental declaration is incomplete. Exhibit 9, that addressing where each limitation of claims 21 and 44 is disclosed in the prior art, contains only one page. (D.I. 223, ex. 9) For this reason, and in view of the fact that defendants did not file a reply brief as per their stipulation, the court is not in a position to evaluate plaintiffs arguments on this limitation.

[*331] Notwithstanding the foregoing, Mr. Crevelt does not specifically state that a person of ordinary skill in the art would have been motivated to combine Piechowiak with Tracy. Mr. Crevelt states only that limitations, if not disclosed in Piechowiak, are disclosed in Tracy. (D.I. 223 at PP 82, 84, 86, 93, 95, 96, 98, 100) Mr. Crevelt does not substantively address Tracy at all, providing only in the context of the "paying the bonus via the gaming device

responsive to the receipt of the pay command" limitation **[**107]** that, "[i]n light of the teaching of Tracy [], it would therefore be obvious to pay the bonus at the gaming machine in accordance with the command." (*Id.* at PP 88, 100) No reasonable jury could find in favor of defendants absent a proffer on a motivation to combine (and reasonable expectation of success as a result of the proffered combination). Summary judgment is granted for plaintiff on the validity of claims 21 and 44 of the '812 patent.

4. Conclusion regarding validity

Based upon the foregoing, the court denies defendants' motion for summary judgment that the '983 patent is invalid as anticipated or being rendered obvious by Craine. Defendants' motion for summary judgment that the asserted claims of the '812 and '885 patents are invalid for obviousness is denied. Plaintiff's motion for summary judgment that the asserted claims of the '812 and '885 patent are not invalid is granted, insofar as defendants cannot prove that: (1) either patent is anticipated by Piechowiak; (2) claims 1 and 22 of the '885 patent are rendered obvious by Koza in view of Piechowiak, Bridgeman, Krause and Tracy; (3) claims 10, 33 and 46 of the '885 patent are rendered obvious by Piechowiak in view of Bridgeman, **[**108]** Krause and Tracy; or that (4) claims 21 and 44 of the '812 patent are rendered obvious by Piechowiak in view of Tracy.

C. Cross-Motions Regarding Implied License

In their amended answer, defendants asserted as an affirmative defense to infringement the existence of a license between the parties covering the '885, '812, and '983 patents. (D.I. 173) Plaintiff moves for summary judgment that no such license exists, either express or implied. (D.I. 182) In their response, defendants concede that no such express license exists and further concede that no such implied license exists covering the '885 and '812 patents. (D.I. 222 at 1) Defendants contend, however, that an implied license does exist covering the '983 patent and cross-move for summary judgment on that point. (D.I. 221)

In light of defendants' concessions, the court grants plaintiff's motion for summary judgment that there exists no express or implied license covering the '885 and '812 patents and no express license covering the '983 patent. Furthermore, in light of the court's conclusion that defendants do not infringe the '983 patent, the court denies as moot both parties' motions for summary judgment with respect to whether an **[**109]** implied license covers the '983 patent.

V. CONCLUSION

For the foregoing reasons, plaintiff's motion for summary judgment of infringement (D.I. 178) is granted in part and denied in part; defendants' motion for summary judgment of noninfringement (D.I. 191) is also granted in part and denied in part. Plaintiff's motion for summary judgment of validity of the '812 and '885 patents (D.I. 180) is granted. Defendants' motions for summary judgment of invalidity of the '812 and '885 patents (D.I. 219) and the '983 patent (D.I. 193) are **[**332]** denied. Plaintiff's motion that defendants have no valid license defense (D.I. 182) is granted in part and denied in part as moot. Defendants' motion that it has a valid license defense (D.I. 221) is denied as moot. An appropriate order shall issue.

ORDER

At Wilmington this 28th day of April, 2009, consistent with the opinion issued this same date;

IT IS ORDERED that:

1. Plaintiff's motion for summary judgment of infringement (D.I. 178) is granted in part and denied in part.
2. Defendants' motion for summary judgment of noninfringement (D.I. 191) is also granted in part and denied in part.
3. Plaintiffs motion for summary judgment of validity of the '812 and '885 patents **[**110]** (D.I. 180) is granted.
4. Defendants' motion for summary judgment of invalidity of the '983 patent (D.I. 193) is denied.
5. Defendants' motion for summary judgment of invalidity of the '812 and '885 patents (D.I. 219) is denied.
6. Plaintiff's motion that defendants have no valid license defense (D.I. 182) is granted in part and denied in part as moot.
7. Defendants' motion that it has a valid license defense (D.I. 221) is denied as moot.

/s/ Sue L. Robinson

United States District Judge







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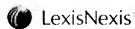
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2001 U.S. Dist. LEXIS 23416, *

MIKOHN GAMING CORP., Plaintiff, v. ACRES GAMING, INC., Defendant,

Case No.: CV-S-97-1383-EJW (LRL) (Base File), Case No.: CV-S-98-1462-EJW (LRL) (Base File)

UNITED STATES DISTRICT COURT FOR THE DISTRICT OF NEVADA

2001 U.S. Dist. LEXIS 23416

August 1, 2001, Decided

August 2, 2001, Received and Filed; August 3, 2001, Entered and Served

DISPOSITION: [*1] Plaintiff's Renewed Motion for Judgment as a Matter of Law and Motion for New Trial denied. Defendant's Motion to Amend Judgment, for an Accounting of Sales, for Entry of Permanent Injunction Regarding plaintiff's MoneyTime System, and for an Award of Prejudgment Interest granted. Permanent injunction stayed pending resolution of any appeals.

CASE SUMMARY:

PROCEDURAL POSTURE: After a jury found that the plaintiff infringer infringed upon the patents of the defendant assignee, and awarded \$ 1,500,000 in damages to the assignee, the infringer filed a renewed motion for judgment as a matter of law and motion for a new trial. The assignee filed motions for prejudgment interest, accounting of sales, and a permanent injunction.

OVERVIEW: The patents at issue related to the assignee's system of networked gaming devices designed to provide various promotional bonuses. The infringer listed several claim limitations upon which it argued the assignee failed to prove that the infringer infringed. The court held that there was sufficient evidence presented at trial to support the jury's verdict as to each of these claim limitations. The court reasoned that the infringer had not cited evidence that greatly outweighed the expert testimony. The court also reasoned that the authorities cited by the infringer warning against applying the doctrine of equivalents too broadly were inapplicable to the facts of this case. The infringer also argued that the verdict was against the weight of the evidence, the verdict was excessive, and the court rendered judgment without due consideration of the infringer's affirmative defense of inequitable conduct. The court held that the verdict of infringement was not against the clear weight of the evidence. Finally, the court concluded that the infringer should pay prejudgment interest at the rate of 4.78 percent compounded annually.

OUTCOME: The infringer's motions were denied. The motions of the assignee for prejudgment interest and accounting of sales were granted.

CORE TERMS: gaming, accounting, bonus, patent, prejudgment interest, infringement, payout, royalty, controller, machine, injunction, network, mystery, matter of law, weighted, winning, new trial, infringing, infringe, pretrial, selecting, screen, predetermined, inequitable, occurrence, plurality, connected, slot, pool, specific order

LEXISNEXIS(R) HEADNOTES

Civil Procedure > Jurisdiction > Subject Matter Jurisdiction > General Overview
 Copyright Law > Civil Infringement Actions > Jurisdiction & Venue > General Overview
 Patent Law > Jurisdiction & Review > Subject Matter Jurisdiction > General Overview
HN1 See 28 U.S.C.S. § 1338(a).

Civil Procedure > Trials > Judgment as Matter of Law > General Overview
HN2 See Fed. R. Civ. P. 50(a)(1).

Civil Procedure > Trials > Judgment as Matter of Law > General Overview
HN3 Where a party has made a motion for judgment as a matter of law at the close of evidence, and that motion was denied and the case sent to the jury, the moving party may renew its motion after verdict. Fed. R. Civ. P. 50(b).

Civil Procedure > Trials > Judgment as Matter of Law > General Overview
HN4 In the context of a motion for judgment as a matter of law, in order to determine whether a legally sufficient basis in fact exists, the trial court must consider all the evidence in a light most favorable to the non-mover, must draw reasonable inferences favorable to the non-mover, must not determine the credibility of witnesses, and must not substitute its choice for that of the jury.

Civil Procedure > Judicial Officers > Judges > Discretion
 Civil Procedure > Judgments > Relief From Judgment > Motions for New Trials
 Civil Procedure > Judgments > Relief From Judgment > Motions to Alter & Amend
HN5 A motion for a new trial falls under Fed. R. Civ. P. 59, which provides a new trial may be granted to all or any of the parties and on all or part of the issues in an action in which there has been a trial by jury, for any of the reasons for which new trials have heretofore been granted in actions at law in the courts of the United States. Fed. R. Civ. P. 59(a). The standard set by case law is that a verdict may be set aside and new trial granted, when the verdict is contrary to the clear weight of the evidence, or whenever in the exercise of a sound discretion the trial judge thinks this action necessary to prevent a miscarriage of justice.

Civil Procedure > Pleading & Practice > Motion Practice > Content & Form
 Civil Procedure > Appeals > Standards of Review > Substantial Evidence > Sufficiency of Evidence
HN6 In ruling upon a motion, a court relies upon the entire record in this case, and not simply upon the few examples of testimony or exhibits.

Patent Law > Infringement Actions > Burdens of Proof
HN7 The standard applied to patent infringement is a preponderance of the evidence. Preponderance of the evidence means the greater weight of evidence, evidence which is more convincing than the evidence which is offered in opposition to it.

Patent Law > Infringement Actions > Claim Interpretation > General Overview
HN8 The general rule is that unless the literal language or physical constraints of the process claim dictate otherwise, the steps of the claim have no required order of performance.

Civil Procedure > Trials > Jury Trials > Province of Court & Jury
HN9 It is within the province of the jury to determine the credibility of a witness and the weight to be given his testimony; the jury is not required to accept testimony as true, even if it is uncontradicted.

Civil Procedure > Trials > Jury Trials > Province of Court & Jury

Civil Procedure > Appeals > Standards of Review > Substantial Evidence > Sufficiency of Evidence

HN10 ⚡ A court must not substitute its choice for that of the jury.

Patent Law > Infringement Actions > Doctrine of Equivalents > General Overview

HN11 ⚡ Under the doctrine of equivalents, if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape.

Patent Law > Infringement Actions > Doctrine of Equivalents > General Overview

HN12 ⚡ Finding infringement under the doctrine of equivalents despite a difference in the location of the bonus payout table does not allow the doctrine such broad play as to effectively eliminate that element in its entirety. Nor does it conflict with the definitional and public-notice functions of the statutory claiming requirement.

Patent Law > Infringement Actions > Doctrine of Equivalents > General Overview

HN13 ⚡ It is important to ensure that the doctrine of equivalents, even as to an individual element, is not given such broad play as to effectively eliminate that element entirely.

Civil Procedure > Trials > Judgment as Matter of Law > General Overview

HN14 ⚡ Conflicting evidence is insufficient to support judgment as a matter of law. In analyzing a motion for judgment as a matter of law, the trial court must consider all the evidence in a light most favorable to the non-mover, must draw reasonable inferences favorable to the non-mover, must not determine the credibility of witnesses, and must not substitute its choice for that of the jury between conflicting elements in the evidence. The court will not substitute its judgment for that of the jury.

Patent Law > Inequitable Conduct > Burdens of Proof

Patent Law > Inequitable Conduct > Effect, Materiality & Scienter > Elements

HN15 ⚡ A defendant asserting an inequitable conduct defense must demonstrate by clear and convincing evidence that the applicant or his attorney failed to disclose material information to the U.S. Patent and Trademark Office (PTO), and that the applicant or his attorney did so with intent to deceive the PTO.

Civil Procedure > Judgments > Relief From Judgment > Motions for New Trials

HN16 ⚡ A new trial is not necessary to prevent a miscarriage of justice.

Civil Procedure > Remedies > Judgment Interest > General Overview

Patent Law > Infringement Actions > Infringing Acts > Use

Patent Law > Remedies > Collateral Assessments > Prejudgment Interest

HN17 ⚡ 35 U.S.C.S. § 284 provides that damages for patent infringement include a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

Civil Procedure > Remedies > Judgment Interest > Prejudgment Interest

Patent Law > Remedies > Collateral Assessments > Prejudgment Interest

Patent Law > Remedies > Damages > General Overview

HN18 ⚡ Under 35 U.S.C.S. § 284, interest shall be fixed by the court. The statute leaves the court some discretion in awarding prejudgment interest.

Patent Law > Remedies > Damages > General Overview

Patent Law > Remedies > Equitable Relief > Accountings

HN19 [↓](#)Accountings appear to be standard practice after judgment in patent actions.

Civil Procedure > Judgments > Entry of Judgments > Stays of Proceedings > General Overview

Patent Law > Remedies > Damages > General Overview

Patent Law > Remedies > Equitable Relief > Accountings

HN20 [↓](#)See Fed. R. Civ. P. 62(a).

Civil Procedure > Remedies > Equitable Accountings > General Overview

Patent Law > Remedies > Damages > General Overview

HN21 [↓](#)An accounting of profits for the purpose of recovering lost profits is an equitable remedy.

Civil Procedure > Trials > Jury Trials > Jury Instructions > General Overview

Patent Law > Remedies > Damages > General Overview

HN22 [↓](#)Reasonable royalty damages are not simply lost profits.

Patent Law > Remedies > Damages > General Overview

Patent Law > Remedies > Equitable Relief > Accountings

HN23 [↓](#)35 U.S.C.S. § 284 does not specifically provide for an accounting as a remedy separate from damages. It states only that the patent owner is entitled to damages adequate to compensate for the infringement.

Patent Law > Remedies > Damages > General Overview

HN24 [↓](#)The damages awarded the patent holder must be adequate to compensate for the infringement, 35 U.S.C.S. § 284, which means full compensation for any damages the patent owner suffered as a result of the infringement.

Patent Law > Infringement Actions > Exclusive Rights > Manufacture, Sale & Use

Patent Law > Ownership > Patents as Property

Patent Law > Remedies > Equitable Relief > Injunctions

HN25 [↓](#)Infringement having been established, it is contrary to the laws of property, of which the patent law partakes, to deny the patentee's rights to exclude others from use of his property. 35 U.S.C.S. § 261. It is the general rule that an injunction will issue when infringement has been adjudged, absent a sound reason for denying it.

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Adam R. Segal, Schreck Brignone & Godfrey, Las Vegas, NV, for Mikohn Gaming Corporation.

Jerry A. Riedinger, Michael D. Broaddus and Katrina R. Kelly, Perkins Coie LLP, Seattle, WA, for Acres Gaming, Inc.

Eric R. Olsen, Gordon & Silver, Ltd., Las Vegas, NV, for Acres Gaming, Inc.

JUDGES: Evan J. Wallach, Judge.

OPINION BY: Evan J. Wallach

OPINION

I

INTRODUCTION

The court has before it Mikohn Gaming Corporation's Renewed Motion for Judgment as a Matter of Law and Motion for New Trial (# 512) ("Mikohn's Motion"), Acres Gaming Inc.'s Motion to Amend Judgment **[*2]** and for an Award of Prejudgment Interest (# 514) ("Acres's Motion for Prejudgment Interest"), Acres Gaming Inc.'s Motion to Amend Judgment and for an Accounting of Sales (# 514) ("Acres's Motion for an Accounting of Sales"), and Acres Gaming's Motion for Entry of a Permanent Injunction Regarding Mikohn's MoneyTime System (# 513) ("Acres's Motion for a Permanent Injunction"). For the reasons discussed below, Mikohn's Motion is denied, and Acres's Motions for Prejudgment Interest, an Accounting of Sales and a Permanent Injunction are granted.

II

BACKGROUND

Several prior opinions have been issued in these cases. Familiarity with those prior opinions is presumed.

United States Patent Number **5,655,961** (" '961 patent") was issued on August 12, 1997, and United States Patent Number 5,836,817 (" '817 patent") was issued on November 17, 1998, to inventors John F. Acres, Alec Ginsburg, and David Wiebenson. Acres Gaming, Inc. ("Acres") is the assignee. Both patents relate to Acres's system of networked gaming devices designed to provide various promotional bonuses. The abstracts in the patents are identical:

A system for monitoring and configuring gaming devices interconnected **[*3]** over a high-speed network is disclosed. The system can support a file server, one or more floor controllers, one or more pit terminals, and other terminals all interconnected over the network. Each gaming device includes an electronic module which allows the gaming device to communicate with a floor controller over a current loop network. The electronic module includes a player tracking module and a data communication node. The player tracking module includes a card reader for detecting a player tracking card inserted therein which identifies the player. The data communication node communicates with both the floor controller and the gaming device. The data communication node communicates with the gaming device over a serial interface through which the data communication node transmits reconfiguration commands. The gaming device reconfigures its payout schedule responsive to the reconfiguration commands to provide a variety of promotional bonuses such as multiple jackpot bonuses, mystery jackpot bonuses, progressive jackpot bonuses, or player specific bonuses.

At the conclusion of the trial in this case, the jury found that Mikohn infringed upon both patents and awarded \$ 1,500,000 **[*4]** in damages to Acres. Special Verdict Form, (# 506) (March 27, 2001). The verdict was entered as the judgment of this court. Judgment in a Civil Case (# 507) (March 29, 2001).

At the close of Acres's case in chief and at the end of trial, Mikohn moved for judgment as a

matter of law that it did not infringe upon the patents. Transcript of Trial, March 14-27, 2001 ("Tr.") at 730:22-24; Tr. at 1649:20-24. The motions were denied. Tr. at 743:11-12; Tr. at 1652:22 - 1653:3. Mikohn renews its motion here.

III

JURISDICTION AND STANDARD OF REVIEW

This consolidated case was brought under 35 U.S.C. § 271 (1994), Infringement of patent. This court has jurisdiction pursuant to 28 U.S.C. § 1338(a), which provides:

HN2 "The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents . . . Such jurisdiction shall be exclusive of the courts of the states in patent. . . .

28 U.S.C. § 1338(a) (1994).

A motion for judgment as a matter of law is governed by Fed. R. Civ. P. at 50, which states:

HN2 "If during a trial by jury a party has been fully **[*5]** heard on an issue and there is no legally sufficient evidentiary basis for a reasonable jury to find for that party on that issue, the court may determine the issue against that party and may grant a motion for judgment as a matter of law against that party with respect to a claim or defense that cannot under the controlling law be maintained or defeated without a favorable finding on that issue.

Fed. R. Civ. P. 50(a)(1). **HN3** "Where, as here, a party has made a motion for judgment as a matter of law at the close of evidence, and that motion was denied and the case sent to the jury, the moving party may renew its motion after verdict. See Fed. R. Civ. P. 50(b).

HN4 "In order to determine whether a legally sufficient basis [for the jury to find for Acres] in fact exists, 'the trial court must consider all the evidence in a light most favorable to the non-mover, must draw reasonable inferences favorable to the non-mover, must not determine the credibility of witnesses, and must not substitute its choice for that of the jury.'" *Odetics, Inc. v. Storage Technology Corp.*, 185 F.3d 1259, 1269 (Fed. Cir. 1999) (quoting *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 893, 221 U.S.P.Q. 669, 672 (Fed. Cir. 1984)). **[*6]**

HN5 "A motion for a new trial falls under Fed. R. Civ. P. 59, which provides "[a] new trial may be granted to all or any of the parties and on all or part of the issues (1) in an action in which there has been a trial by jury, for any of the reasons for which new trials have heretofore been granted in actions at law in the courts of the United States . . ." Fed. R. Civ. P. 59(a). The standard set by case law is that a "verdict may be set aside and new trial granted, when the verdict is contrary to the clear weight of the evidence, or whenever in the exercise of a sound discretion the trial judge thinks this action necessary to prevent a miscarriage of justice." *Moist Cold Refrigerator Co. v. Lou Johnson Co.*, 249 F.2d 246, 251 (9th Cir. 1957) (quotations omitted); accord *Pacific Employers Ins. Co. v. P.B. Hoidale Co., Inc.*, 804 F. Supp 137, 141 (D. Kan. 1992).

IV

ANALYSIS

A

Mikohn's Renewed Motion for Judgment as a Matter of Law and Motion for New Trial is Denied

Mikohn renews its Rule 50(b) Motion "on the grounds that Mikohn does not infringe the '817 and '961 patents as a matter of law" and presents supporting argument on several specific [*7] claim limitations. Mikohn's Motion at 2, 5-24. Mikohn also moves for a new trial pursuant to Rule 59 arguing that "the verdict was against the weight of the evidence, the verdict was excessive and this Court rendered judgment without due consideration of Mikohn's affirmative defense of inequitable conduct." Id. at 2.

1. The Jury's Verdict of Infringement Is Supported by Evidence Adduced at Trial

Mikohn lists several claim limitations upon which it argues Acres failed to prove Mikohn infringes. Sufficient evidence was presented at trial to support the jury's verdict as to each of these claim limitations. The court will address each of Mikohn's contentions in turn and will cite to evidence in the record which supports the jury's verdict. "The Court notes specifically, however, that ^{H96} in ruling upon this motion, it relies upon the entire record in this case, and not simply upon the few examples of testimony or exhibits it here tenders." Braun Inc. v. Dynamics Corp. of Am., 775 F. Supp 33, 35 (D. Conn. 1991), rev'd in part (on other grounds) 975 F.2d 815 (Fed. Cir. 1992).

a. Sufficient Evidence was Presented at Trial to Support the Jury's [*8] Finding that the MoneyTime System Performs the Step of "Selecting a Plurality of the Gaming Devices"

Mikohn claims that "Acres failed to prove that the MoneyTime system performed that step of 'selecting a plurality of the gaming devices' as recited in each asserted claim of the '817 patent." Mikohn's Motion at 5. It argues that Acres's expert Dr. Bertram admitted that his construction of the claim limitation "rendered the limitation . . . superfluous". Id. at 6. Therefore, it claims, his construction is "completely at odds with a proper construction of the claim language . . . [and] Acres failed to establish this limitation is met by the MoneyTime system." Id. at 7. The relevant portion of Dr. Bertram's testimony is as follows:

Mr. Shapiro: And you indicated that interconnected/wiring gaming machines or slot machines to a host computer performs the step of selecting a plurality of the gaming devices. Is that correct?

Dr. Bertram: That's correct.

Mr. Shapiro: So whenever you interconnect gaming devices to a host computer, don't you select a plurality or don't you -- aren't you going to be putting those together? I mean, isn't that going to be any time your [sic] [*9] on the network, don't you have to interconnect a group of machines to the host computer?

Dr. Bertram: It sounds pretty general but I would agree.

Mr. Shapiro: And whoever decides to build the system has to determine what gaming devices to wire into the system. Is that right?

Dr. Bertram: That's true.

Mr. Shapiro: So would you agree with me that based on your statement that connecting gaming machines to a network, to create a network to a host computer, really renders this element or this limitation, selecting a plurality of

the gaming devices, completely superfluous, doesn't? It [sic] Because any time that you connect a set of gaming devices to a host computer, you're going to have to pick out what you're going to interconnect in there and connect it?

Dr. Bertram: Well, I didn't write the claim. I mean, it's descriptive of what it's doing. It's a method.

Mr. Shapiro: So you agree, then, in how you're stating this claim is or how you're applying it to the Money Time system renders this element, this limitation of selecting a plurality of the gaming devices, superfluous? Because you are always going to have that when you create a computer network of gaming devices; isn't that **[*10]** true?

Dr. Bertram: I would agree with that.

Tr. at p. 392:23 - 394:3.

However, Dr. Bertram also testified that his interpretation of the claim language was that it means "selecting more than one machine to participate in whatever -- whatever it is you're trying to accomplish", Tr. at 459:7-8, and that he "never thought it was superfluous", id. at 459:21.

Specific evidence regarding the MoneyTime system and how it operates was presented by other experts. Mikohn's expert, Mr. Olsen, testified that the Superlink software, which manages the MoneyTime system, is capable of managing several different controllers, some of which may be MoneyTime controllers, but some of which may also be progressive or mystery controllers. Tr. 975:4-8, 21-25. He stated that Superlink has "configuration and setup functions and it has reporting functions." Id. at 1083:2-3.

Mr. Olsen testified about a screen in the Superlink software referred to as the "Machine ID" screen. This screen was shown to the jury as part of the demonstration of the MoneyTime system. It contains a list of all gaming devices connected to the controller. Next to each device is a check box referred to by Mr. Olsen as **[*11]** the "active box". Mr. Olsen stated that "the active box needs to be checked . . . to correspond to each one of the machines that should be connected to the . . . Money Time controller." Id. at 704:25 - 705:3. When specifically asked, he agreed that it would be an "improper set-up for the system" if the active box was not checked. Id. at 705:4-6.

Acres's expert Dr. Kelly also testified as to the Machine ID screen, and he discussed the operation of the software relating to it. He testified:

This is one of the screens that's used to configure the system. And you'll see here that there's actually listed 32 machines. This corresponds to 32 gaming machines that are on one link of -- of this system. And there's a name associated with each one of these 32 machines.

And, also, there's a check box right there (indicating). Now if that check box is marked so if you move your mouse over and you clicked at that location, then that would mean that this machine is selected. But if you go over and you click this box to clear that "X" mark then that would mean that this machine is not selected. Now, so you have 32 here on the screen and the user would select some of these and -- **[*12]** and unselect, deselect, others.

Now, what that does inside the software is it prepares a message. And then when the user presses the Send Status button over here (indicating) that message is packaged up and it's sent off to the main computer that controls the other

gaming devices called a DCU.

Now, I should point out that this feature of ending this message can be enabled in the software or it can be disabled. And there's a special flag in there. If that flag is set to true, then the message would be enabled; it would be sent. If the message -- if that flag is set to false, then the message would be constructed, but it wouldn't actually be sent.

Now, the software that -- that was provided to the by Mikohn, that flag is set to false.

* * *

Mr. Broadus: If the flag were set to true, would selecting and deselecting gaming devices on the machine ID screen be effective to enable or disable the gaming devices from the Money Time system?

Dr. Kelly: Yes, I believe so. That appears to be the purpose of the screen.

Id. at 521:7 - 523:1.

A jury could reasonably infer from this expert testimony that from the Machine ID screen, the operator can "select[] a plurality of the [*13] gaming devices." ^{HN7} The standard applied to infringement is a preponderance of the evidence. See *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1123 (Fed. Cir. 1985). Preponderance of the evidence "means the greater weight of evidence, evidence which is more convincing than the evidence which is offered in opposition to it." *Hale v. Dep't of Transp.*, Fed. Aviation Admin., 772 F.2d 882, 885 (Fed. Cir. 1985). Mikohn has not cited evidence that greatly outweighs this expert testimony or which demonstrates that a reasonable jury could not find that the MoneyTime system performs this step. The evidence presented at trial was legally sufficient for the jury to find under the preponderance of the evidence standard that the Mikohn MoneyTime system performs the function of "selecting a plurality of the gaming devices."

b. The Jury Heard Sufficient Evidence to Support its Finding That the MoneyTime System Performs the Steps of "Issuing a Command over the Network Including Data Establishing Criteria to Cause a Bonus to Be Paid from the Pool via One of Said Selected Gaming Devices Upon the Occurrence of a Predetermined Event" and "Providing Data Establishing [*14] Criteria to Cause a Bonus to Be Paid From the Pool via One of Said Selected Gaming Devices Upon the Occurrence of a Predetermined Event"

Mikohn argues that:

[The] MoneyTime system does not perform the steps of "issuing a command over the network including data establishing criteria to cause a bonus to be paid from the pool via one of said selected gaming devices upon the occurrence of a predetermined event" and "storing the command in a memory connected to a controller associated with only one of the gaming devices" as recited in claims 1 and 21 of the '817 patent. It also does not perform the steps of "providing data establishing criteria to cause a bonus to be paid from the pool via one of said selected gaming devices upon the occurrence of a predetermined event" and "storing the data in a memory connected to a controller associated with only one of the gaming devices" as recited in claims 24 and 29 of the '817 patent.

Mikohn's Motion at 7-8 (emphasis in original).

Mikohn presents no argument as to the claim limitations "storing the command in a memory connected to a controller associated with only one of the gaming devices" and "storing [*15] the data in a memory connected to a controller associated with only one of the gaming devices". Therefore, the court will confine its analysis to the two remaining limitations, both of which contain the phrase "data establishing criteria" and one of which uses the term "command".

This court held "data establishing criteria" to mean information that sets up "one or more standards, rules or tests to determine whether a bonus is paid." Court's Opinion of July 27, 2000 at 7; see Report and Recommendation of May 25, 2000 (Findings of Fact & Conclusions of Law Re: Claim Construction) ("Magistrate Judge's Report") at P 74. It held that the term "command" as used in the patent claims is a "reconfiguration command", Magistrate Judge's Report at P 73, and that a "reconfiguration command" is "a command that rearranges the previous configuration of the gaming device so that the gaming device pays out extra money it would not have paid in its previous configuration", id. at P 71.

Expert testimony supports the jury's finding that the MoneyTime system performs the functions described in these claim limitations. Dr. Kelly's testimony is the most descriptive. He testified that MoneyTime's [*16] "Enter Mystery Pay Mode" command is the command issued over the network that includes data establishing criteria to cause a bonus to be paid from the pool. Tr. at 524:1-9. In describing how the mystery pay command operates, Dr. Kelly testified that it sets the mystery pay bit which is "the rule that says when that bit is set this gaming device is to be the one to actually pay a bonus." Id. at 524:10-24. Dr. Kelly also testified that the mystery pay command that sets the mystery pay bit is a reconfiguration command "because it causes the gaming device to make a payment that it wouldn't have made in its previous configuration." Id. at 525:2-8.

Mikohn's expert Mr. Olsen, who designed the MoneyTime system and was the director of engineering for Mikohn when it was built, id. at 692:15-20, stated that Dr. Kelly's reports and explanations of how the "code sections operated" were "accurate", id. at 825:10-15. While Mr. Olsen stated that he did not "always agree with [Dr. Kelly's] conclusions", he specifically testified that he agreed with Dr. Kelly's description of the mystery pay protocol. Id. at 924:25 - 925:6.

Mikohn contends that the mystery pay bit "is not itself [*17] information that establishes a rule." Mikohn's Motion at 8. Instead, since the gaming device is preprogrammed to pay or not pay a bonus depending on what information is contained in the mystery pay bit, the mystery pay bit itself is "nothing more than the answer to the rule." Id. at 9 (footnotes omitted). Mikohn presented this theory to the jury in its closing statement. Tr. at 1767:21 - 1769:4. It was for the jury to evaluate the evidence and draw inferences from it. *Odetics, Inc.*, 185 F.3d at 1269. The jury did so and found that the MoneyTime system does perform the function of sending a command including data establishing criteria. Sufficient evidence was presented for the jury to reasonably conclude that the MoneyTime system's mystery pay command containing the mystery pay bit satisfies the claim limitations "issuing a command over the network including data establishing criteria to cause a bonus to be paid from the pool via one of said selected gaming devices upon the occurrence of a predetermined event" and "providing data establishing criteria to cause a bonus to be paid from the pool via one of said selected gaming devices upon the occurrence of a predetermined [*18] event".

c. Sufficient Evidence was Presented at Trial to Support the Jury's Finding that the MoneyTime System Performs the Step of "Transmitting Data Indicative of Gaming Device Activity from the Gaming Device to the Controller"

Mikohn asserts that the following limitations of claim 1 of the '817 patent must be performed in order:

1. A method of operating gaming devices interconnected by a computer network to a host computer comprising:

...

issuing a command over a network including data establishing criteria to cause a bonus to be paid from the pool via one of said selected gaming devices upon the occurrence of a predetermined event; storing the command in a memory connected to a controller associated with only one of the gaming devices; transmitting data indicative of gaming device activity from the gaming device to the controller; transmitting a pay command from the controller to the gaming device upon the occurrence of the predetermined event; . . .

'817 Patent, col. 38, ll. 27-45; see Mikohn's Motion at 9-11. Mikohn contends that this claim "requires that the controller associated with the gaming device track gaming device activity between [*19] the immediately preceding and immediately following steps in the process." Mikohn's Motion at 9. To support its claim that the steps must be performed in the order in which they appear in the patent claim, Mikohn quotes a portion of the prosecution history of the '817 patent. The portion emphasized by Mikohn is the following statement made by Acres;

None of the prior art of record discloses a system in which a machine is placed into a bonus mode by transmitting a command over a network to a controller associated with a gaming device and thereafter paying the bonus via the gaming device responsive to a second command from the controller. This facilitates selecting groups of devices over a network for participation in one or more bonus promotions without requiring network communication for each transaction at the gaming device.

Mikohn's Motion at 10-11 (emphasis added in Motion) (quoting Prosecution History of '817 Patent, Paper No. 10, pp. 6-7). Mikohn presents no argument as to how this portion of the prosecution history supports its contention.

HNS "The general rule is that unless the literal language or physical constraints of the process claim dictate otherwise, [*20] the steps of the claim have no required order of performance." *Deputy Orthopaedics v. Androphy*, 2000 U.S. Dist. LEXIS 661, 53 U.S.P.Q.2d 1941, 1957 (N.D. Ill. 2000) (citations omitted); see *Vaupel Textilemaschinen Kg V. Meccanica Euro Italia S.p.A.*, 944 F.2d 870, 880 (Fed. Cir. 1991) ("There is no specific language, nor any intimation whatsoever in Marowsky's claim 1 that the cutting step takes place *before* the take-off roll or breast plate.").

Nothing in the claim language indicates that these steps must be performed in a certain order. There are no chronological terms such as "before", "after", "next" or "then." In addition, there is no indication that physical constraints require the steps to be performed in a certain order. See *Deputy*, 53 U.S.P.Q.2d at 1958 (stating that although "claim 1 lacks any express terms that grammatically require the flexion gap to be determined before the resection of the distal femur", physical constraints required a specific order.).

The prosecution history cited by Mikohn does not require a conclusion that the steps must be performed in the order written. It supports a contention that the command [*21] including data establishing criteria must be issued over the network and stored in a memory connected to a controller prior to the transmission of a pay command and payment of the bonus. However, that is not Mikohn's contention here. The cited prosecution history does not

reference transmission of "data indicative of gaming device activity," and it does not support Mikohn's claim that this must occur between the command including data establishing criteria and the pay command.

This is not a case like *Depuy*, where the court found that the literal language of the claim did not require a specific order of steps, but the prosecution history and physical constraints made it clear that a specific order was required. ¹ *Depuy*, 53 U.S.P.Q.2d at 1957-58. In *Depuy* the patented method was physically impossible to perform unless a specific order was followed. The prosecution history only made that physical impossibility clear. See *id.* The statements made by Acres in the prosecution history do not clearly state that the limitations must be performed in a certain order, and there has been no allegation that a specific order is required by physical constraints. The prosecution [***22**] history therefore does not support inserting an order requirement where none exists in the literal claim language.

FOOTNOTES

¹ In that case the patent was titled "Triplanar knee resection method." *Depuy*, 53 U.S.P.Q.2d at 1943. The claims of the patent "generally relate to a method for cutting the bones that form the knee in a triplanar fashion in order to shape the patient's tibia and femur for a prosthesis." *Id.* The other patent at issue was a set of instruments to be used by a surgeon in performing this method. As to the prosecution history, the court noted that

plaintiff in the Amendment represented to the examiner that the plain language of claim 1 requires that:

- 1) the flexion gap must be determined in order for the slot to be spaced correctly; and
- 2) the slot must be spaced correctly in order to resect the distal femur.

Id. at 1958. Therefore in *Depuy* it was clear that the slot must exist before the step of resecting can occur, and that accordingly the steps must be performed in order.

[***23**] Even under Mikohn's proposed construction, the evidence presented by Acres is sufficient for the jury to find infringement. Mikohn claims that the smart interface board of the MoneyTime system "does not track gaming device activity between what [sic] sending 'the polling command' and the 'pay command'". Mikohn's Motion at 9. However, evidence was presented that tends to indicate that the MoneyTime system's "Mystery Pay Ready Response" contains data indicating gaming device activity and that it occurs between storing the command including data establishing criteria in a memory and transmitting the pay command to the gaming device. Dr. Kelly testified as follows:

Mr. Broadus: Now, Dr. Kelly, in the claim language, "transmitting data indicative of gaming device activity from the gaming device to the controller," what, in your opinion, is the gaming device activity that's being transmitted?

Dr. Kelly: Well, what I identified was one of these messages here . . . this Mystery Pay Ready. Response (indicating) is data indicating the -- as it says

there, "data indicating gaming device activity."

Mr. Broadbudd: I see. Is that data transmitted to be an indication of gaming device [*24] activity? Is that data transmitted after the mystery pay command has been stored in the SIB controller?

Dr. Kelly: Yes, it is.

Mr. Broadbudd: And is the data indicative of gaming device activity transmitted before the mystery pay command is transmitted from the controller to the gaming device?

Dr. Kelly: Yes, it is. Right in that sequence as -- as I showed you there.

Mr. Broadbudd: So in sequence of time, those steps are performed sequentially?

Dr. Kelly: That is correct.

Tr. 528:10 - 529:6.

This testimony supports a finding of infringement even under Mikohn's proposed construction. Mikohn points to no contradictory evidence in the record.

The steps of claim 1 of the '817 patent need not be performed in a specific order. Even if such a requirement did exist, the evidence presented at trial is sufficient to support the jury's finding of infringement.

d. Sufficient Evidence was Presented at Trial to Support the Jury's Finding that the MoneyTime System Contains a "Bonus Payout Table"

The Magistrate Judge construed "bonus payout table" to mean a table "that associates specific bonus payouts with specific winning combinations on a gaming device." Magistrate Judge's [*25] Report at P 46. ² Mikohn contends that Acres failed to prove Mikohn infringes upon the '961 patent because the MoneyTime system does not contain a "bonus payout table" as that term is used in claim 1. Mikohn's Motion at 12-15.

FOOTNOTES

² The jury was instructed that this was the meaning of "bonus payout table." Agreed Jury Instructions at 15.

In support of its argument, Mikohn quotes testimony of Dr. Bertram, Acres's expert, in which he discussed the MoneyTime system's weighted pay table. Mikohn's counsel stated, and Dr. Bertram agreed, that "the way [that table] would work then is once the system determines that a particular gaming device is to be paid, then it references this table, the weighted pay table, and there's a 50.4 percent chance of a \$ 5 award, a 25 percent chance of getting a \$ 10 award, a 12.5 percent chance of getting a \$ 25 award, on and on". Tr. 378:1-7. Dr. Bertram then responded to Mikohn's counsel's question "is this 50.4 percent a winning combination of any sort?", by stating "No." Id. at [*26] 378:11-12. Mikohn concludes that Dr. Bertram admitted that MoneyTime's weighted pay table is not a bonus payout table. Mikohn's Motion at 15.

However, the jury heard Dr. Bertram specifically testify that the weighted pay table is a bonus payout table.

Mr. Shapiro: [referring to an illustration of the MoneyTime system's weighted pay table] And I think as I understood your testimony, you said that's a bonus payout table. Is that correct?

Dr. Bertram: That's quoting directly from the Mikohn specification brochures but it certainly looks like a pay table to me.

Mr. Shapiro: I didn't ask if it was a pay table, sir, but is it a bonus payout table? You were relating it to, I think, a specific claim, in the '961 patent.

Dr. Bertram: Well, I think it is a bonus payout table.

Tr. at 374:23 - 375:5 (emphasis added).

The jury also heard testimony from Mikohn's expert Mr. Olsen, who stated that where in the MoneyTime system the term "bonus pay table" is used, he "prefer[s] the terminology 'weighted pay-table.'" Id. at 858:11-13. He also testified as follows:

Mr. Riedinger: Now, there is a bonus payout table in the MoneyTime system; isn't there?

Mr. Olsen: **[*27]** Well, it's been called a "bonus pay table." And I've also characterized it as a weighted pay table.

Id. at 951:10-13. This expert testimony supports an inference that the MoneyTime system's weighted pay table is a bonus payout table.

Mikohn also argues that "as admitted by Dr. Bertram, even the MoneyTime controller's determination to award a bonus is not based on a 'winning combination on a gaming device.'" Mikohn's Motion at 15 (citations omitted). Mikohn apparently relies on the Magistrate Judge's statement that "the definition of a 'payout table' as a table that relates payout to game outcome is repeatedly and consistently used in relevant literature", Magistrate Judge's Report at P 40, when it argues that "Acres . . . does not dispute that the MoneyTime controller's determination to award a bonus is not based on a 'winning combination on a gaming device'", Reply Memorandum of Mikohn Gaming Corporation in Support of Its Renewed Motion for Judgment as a Matter of Law and Motion for New Trial ("Mikohn's Reply") at 13, and cites Dr. Bertram's testimony with a parenthetical quote reading, "The bonus awards are not related to the outcome of the game", Mikohn's Motion at **[*28]** 15 (quoting Tr. at 327:14 - 328:3).

However, the Magistrate Judge did not hold that a bonus payout table associates game outcome with bonus payouts, but rather that it associates winning combinations to bonus payouts. The Magistrate Judge did not define winning combinations as game outcome, nor did he state that game outcome was necessarily specific characters on a slot machine reel in a specific order. Nowhere in the prior opinions of this court has the term "winning combinations" as used by the Magistrate Judge been defined.

At trial, Acres argued that a "winning combination on a gaming device" can be a series of events that lead to payment of a bonus, such as the player becoming eligible, the player's gaming device being selected and a bonus award amount being chosen from the bonus payout table. See Tr. at 327:14-24 (Dr. Bertram). Dr. Bertram's expert testimony supports this interpretation. See id. at 465:22 - 466:1 ("I don't see any reference to a winning combination being a set of symbols on the base game. And I interpret that to mean in this case the combination of events that have to occur that correspond to the winning bonus amount that is awarded to the machine. **[*29]** ").

Mikohn presents no evidence that contradicts Acres's argument and Dr. Bertram's

interpretation. The jury was not given an instruction on the meaning of "winning combinations", and it is the province of the jury to weigh the evidence presented at trial. *U.S. Philips Corp. v. Windmere Corp.*, 861 F.2d 695, 703-04 (Fed. Cir. 1988) ("The evaluation of all the evidence . . . and the inferences to be drawn from the evidence, was for the jury to determine."); see *Amsted Indus. Inc. v. Buckeye Steel Castings Co.*, 24 F.3d 178, 183 (Fed. Cir. 1994) ^{HNS} ("It is within the province of the jury to determine the credibility of a witness and the weight to be given his testimony; the jury is not required to accept testimony as true, even if it is uncontradicted."). ^{HN10} The court must not "substitute its choice for that of the jury." *Odetics, Inc.*, 185 F.3d at 1269 (quoting *Perkin-Elmer Corp.*, 732 F.2d at 893, 221 U.S.P.Q. at 672) (citations omitted). The evidence heard by the jury is sufficient to support its finding that the MoneyTime system contains a "bonus payout table" as that term has been construed in this case.

e

Sufficient [*30] Evidence was Presented at Trial to Support the Jury's Finding that the Bonus Payout Table in the MoneyTime System is "in the Gaming Device"

Mikohn argues that as a matter of law the MoneyTime system does not infringe upon claim 1 of the '961 patent because MoneyTime does not include the step of "activating a bonus payout table in a gaming device". Mikohn's Motion at 15-16. As stated above, the jury could reasonably find that the MoneyTime system's weighted pay table is a bonus payout table. Mikohn contends that the weighted pay table does not reside in the gaming device, and that therefore MoneyTime cannot infringe either literally or under the doctrine of equivalents.

Mikohn relies on Dr. Bertram's testimony that MoneyTime's weighted pay table is located on the controller, and not in the individual gaming devices. *Tr.* at 379:17 - 380:8; Mikohn's Motion at 15. However, Dr. Bertram also testified that the bonus payout table is located in the MoneyTime controller, but that "when it comes time . . . to pay a bonus to a particular machine, . . . it will randomly select an amount from the table and, uh, then it will take that part of the pay table and copy it to the gaming machine. [*31] " *Tr.* at 325:1-6. Mikohn does not now dispute this testimony and did not do so at trial. Therefore it was reasonable for the jury to conclude that the MoneyTime system does indeed copy a portion of its weighted pay table into the individual gaming devices when they are to pay bonuses which results in the bonus payout table residing in the gaming device. This supports a finding of literal infringement.

Dr. Bertram also testified that locating the bonus payout table in the controller was not substantially different from locating it in the gaming device. In fact, he said, "from a system point of view, there's no different [sic] at all." *Id.* at 325:12-13. In response to the question, "Does the payout table in the [controller] perform substantially the same function as having a bonus payout table in the gaming device?" he answered, "It would be exactly the same function. There would be no difference." *Id.* at 325:20-24. This testimony supports a finding of infringement under the doctrine of equivalents. See *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, 339 U.S. 605, 608, 94 L. Ed. 1097, 70 S. Ct. 854 (1950) (^{HN11} "If two devices do the same work in substantially [*32] the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape.") (citations and quotations omitted).

Mikohn argues that Dr. Bertram's testimony cannot support a finding of infringement under the doctrine of equivalents because such a finding would eliminate a claim limitation entirely. Mikohn's Motion at 22. It cites a string of cases in support of its contention and argues that since the MoneyTime system has only two basic elements, the host computer and gaming devices, a finding of infringement under the doctrine of equivalents would "render the limitation 'in a gaming device' completely meaningless." *Id.* at 23.

The authorities Mikohn cites in support of this argument are distinguishable. For example, Mikohn relies on a parenthetical quote from *Phonometrics, Inc. v. Northern Telecom*, 133 F.3d 1459 (Fed. Cir. 1998), which states, "we conclude there can be no equivalent infringement, for one of the functions claims in the '463 patent is completely absent from the accused devices". Mikohn's Motion at 22 (quoting *Phonometrics*, 133 F.3d at 1467). The patent at issue in *Phonometrics* [*33] was a computer device designed to track length and cost of long distance telephone calls. *Phonometrics*, 133 F.3d at 1463. The claim at issue required that

if the call is still in progress when the initial call interval has expired, the "incremental charge data" is transferred to the call cost register means and displayed there "substantially instantaneously." Additional incremental charges are transferred to the call cost register means "substantially instantaneously" upon the passage of additional call intervals. This process of transferring successive interval costs continues throughout the duration of the call.

Id. at 1465. The patentholder conceded that the allegedly infringing devices were not capable of providing cost information during the call. Based upon this element being completely missing from the allegedly infringing devices, the court "concluded there can be no equivalent infringement, for one of the functions claimed in the '463 patent is completely absent from the accused devices." Id. at 1467 (citations omitted).

That is not this case. The location of the bonus payout table is not a function of the [*34] patented device. ^{HN12} Finding infringement under the doctrine of equivalents despite a difference in the location of the bonus payout table does not "allow[] [the doctrine] such broad play as to effectively eliminate that element in its entirety." *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29, 137 L. Ed. 2d 146, 117 S. Ct. 1040 (1997). Nor does it "conflict[] with the definitional and public-notice functions of the statutory claiming requirement." Id.

The other cases cited by Mikohn are similarly inapposite. In *Pennwalt*,³ the expert upon whose testimony the patentholder relied in pursuing its claim under the doctrine of equivalents stated in his report that the accused devices were "functionally equivalent" to the "invention." *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 936 (Fed. Cir. 1987). However, he also stated that "the new designs could be totally equivalent to those they replaced, although the components and methods used differed significantly." Id. (emphasis added). In addition, at trial he testified that "the accused devices performed 'some' of the same type of operations but 'in a different way' [*35] from the claimed invention." Id. at 937. Clearly such testimony does not support a finding that the devices "work in substantially the same way, and accomplish substantially the same result". See *Graver Tank*, 339 U.S. at 608. However, that is not the case here, as illustrated by the testimony of Dr. Bertram quoted above.

FOOTNOTES

³ Mikohn cites to this case with no parenthetical. It is cited to support Mikohn's statement that "the doctrine of equivalents cannot be given such broad play that a limitation is eliminated entirely." Mikohn's Motion at 22.

In a parenthetical, Mikohn quotes *Warner-Jenkinson* in which the Supreme Court stated that ^{HN13} "it is important to ensure that the doctrine [of equivalents], even as to an individual element, is not given such broad play as to effectively eliminate that element entirely." Mikohn's Motion at 22 (quoting *Warner-Jenkinson*, 520 U.S. at 29). *Warner-Jenkinson* dealt

with a petitioner who argued that the doctrine of equivalents **[*36]** "did not survive the 1952 revision of the Patent Act". Warner-Jenkinson, 520 U.S. at 25. The Supreme Court's statements quoted by Mikohn were made in setting the law, but not in application. ⁴ The statement does not give specific guidance applicable here, and as the court stated above, the holding that the MoneyTime system infringes on Acres's patents despite the bonus payout table being located on the controller rather than in a gaming device does not effectively eliminate any element of the claims.

FOOTNOTES

⁴ A more complete picture of the Court's discussion can be achieved by a more complete quote:

We do, however, share the concern of the dissenters below that the doctrine of equivalents, as it has come to be applied since *Graver Tank*, has taken on a life of its own, unbounded by the patent claims. There can be no denying that the doctrine of equivalents, when applied broadly, conflicts with the definitional and public-notice functions of the statutory claiming requirement . . . Each element contained in a patent claim is deemed material to defining the scope of the patented invention, and thus the doctrine of equivalents must be applied to individual elements of the claim, not to the invention as a whole. It is important to ensure that the application of the doctrine, even as to an individual element, is not allowed such broad play as to effectively eliminate that element in its entirety. So long as the doctrine of equivalents does not encroach beyond the limits just described, or beyond related limits to be discussed *infra* . . . we are confident that the doctrine will not vitiate the central functions of the patent claims themselves.

Warner-Jenkinson, 520 U.S. at 29 (emphasis added).

[*37] Finally, Mikohn quotes *DeMarini Sports v. Worth, Inc.*, 239 F.3d 1314 (Fed. Cir. 2001) for the proposition that "the question of insubstantiality of the differences is inapplicable if a claim limitation is totally missing from the accused device." Mikohn's Motion at 22 (quoting *DeMarini*, 239 F.3d at 1332). In *DeMarini*, the device at issue was a softball bat. *DeMarini*, 239 F.3d at 1318. The court found that the accused device did not infringe under the doctrine of equivalents because

the claims, as properly construed, require an insert contained within a bat frame comprised of a handle portion, a tapered portion, and an impact portion. The EST bat does not have such a configuration, instead having an exterior shell in which the insert that is positioned within the shell has a handle and extends beyond the shell.

Id. at 1333. The court stated that this difference between the devices "involved a clear difference between the structure of the alleged infringing product and the invention as it has been defined by the limitations of the claims, as drafted." *Id.* at 1335. Again, that is **[*38]** not the case here. The location of the bonus payout table is not an important structural aspect of the patented system. Upholding a finding of infringement under the doctrine of equivalents would not eviscerate the purpose of the doctrine. Furthermore, the court does not need to rely on the doctrine in this case, as a finding of infringement under the theory of literal infringement is supported by the evidence.

The authorities cited by Mikohn warning against applying the doctrine of equivalents too broadly are inapplicable to the facts of this case. The evidence produced at trial is sufficient to support the jury's verdict under both literal infringement and the doctrine of equivalents.

f. Sufficient Evidence was Presented at Trial to Support the Jury's Finding that the MoneyTime System Performs the Function of "Paying the Gaming Device in Accordance with Both Payout Tables After Each Game for So Long as the Bonus Payout Table is Activated"

Mikohn's final claim is that the MoneyTime system does not perform the function of "paying the gaming device in accordance with both payout tables after each game so long as the bonus payout table remains activated" as required by claim [*39] 1 of the '961 patent. Mikohn's Motion at 16; '961 Pat. at col. 38, ll. 14-16. It argues that "the operations recited by Claim 1 are completely different than the operations of the MoneyTime system" because "the weighted pay table in the network controller of the MoneyTime system is not referenced by any of the gaming devices" nor is it "referenced 'after each game'". Id. (emphasis in original).

Trial testimony supports the jury's finding that the MoneyTime system does perform this function. Dr. Bertram testified that after each game the gaming device will pay in accordance with its standard payout table and will pay a bonus if appropriate. He said:

The machine plays like a normal slot machine so it a [sic -- its] normal pay table is in use. It can pay from the normal pay table. And at the end of the game, if it has been selected to be a bonus winner, it will then pay the amount that has been randomly selected from the bonus payout table and pay that amount. So both pay tables are in use.

Tr. at 328:6-11; see also id. at 389:1-5 ("The gaming device . . . doesn't know whether it's going to receive the bonus amount until the game is over. And then it looks [*40] to see if it's supposed to pay a bonus amount."); id. at 386:3-7 ("At the end of the regular game on the machine, it accesses its normal pay table and pays that amount, whether it's zero or whether it's a non-zero value. And then at the end of that regular game it will find out if it's supposed to pay the bonus amount.")

Mikohn cites other excerpts of Dr. Bertram's testimony to support its position. However, ^{HN14} conflicting evidence is insufficient to support judgment as a matter of law. In analyzing a motion for judgment as a matter of law, "the trial court must consider all the evidence in a light most favorable to the non-mover, must draw reasonable inferences favorable to the non-mover, must not determine the credibility of witnesses, and must not substitute its choice for that of the jury between conflicting elements in the evidence." Perkin-Elmer Corp., 732 F.2d at 893, 221 U.S.P.Q. at 672 (citations omitted); see also Odetics, Inc., 185 F.3d at 1269 (applying Perkin-Elmer Corp. to a motion for judgment as a matter of law). The court will not substitute its judgment for that of the jury. The testimony of Dr. Bertram is sufficient to support [*41] the jury's finding that the MoneyTime system performs the function of "paying the gaming device in accordance with both payout tables after each game so long as the bonus payout table remains activated".

2. Mikohn Has Failed to Establish That it Is Entitled to a New Trial

Mikohn also requests a new trial. It states that "the verdict was against the weight of the evidence, the verdict was excessive and this Court rendered judgment without due consideration of Mikohn's affirmative defense of inequitable conduct." Mikohn's Motion at 2.

The verdict of infringement is not against the clear weight of the evidence. See Moist Cold

Refrigerator Co., 249 F.2d at 251 (A "verdict may be set aside and new trial granted, when the verdict is contrary to the clear weight of the evidence . . ."). Mikohn does not present separate argument as to why the verdict is against the clear weight of the evidence; it merely references its arguments presented in support of its Motion for Judgment as a Matter of Law. Mikohn's Motion at 25 ("As demonstrated above, the great weight of the evidence demonstrated that Mikohn does not infringe . . ."). As the court has concluded, evidence sufficient **[*42]** to support the jury's verdict was presented as to each of the individual claim limitations attacked by Mikohn. The verdict was not against the clear weight of that evidence.

Mikohn claims in its introduction to its Motion that one ground upon which the court should grant a new trial is that the verdict was excessive. Id. at 2. However, Mikohn presents no argument or evidence on this claim. Therefore the court will not address it. ⁵

FOOTNOTES

⁵ See Nevada Local Rule 7-2(d) ("The failure of a moving party to file points and authorities in support of the motion shall constitute a consent to the denial of the motion.").

Mikohn also claims that "this Court rendered judgment against Mikohn without due consideration of its iniquitable conduct defense." Id. at 26. After the close of evidence and outside the presence of the jury, the court heard the testimony of John Acres on the matter of iniquitable conduct. At the conclusion of his testimony, the court stated that it would "permit [the] parties to brief this **[*43]** thing and submit it to the court." Tr. 1913:19-20. After several days of trial during which the parties were preparing motions in the evenings to be submitted and argued in the mornings, the court stated that it would "like to give [the parties] the leisure of doing briefing in something less than overnight fashion." Id. 1913:23-25. Therefore, it said, "If the jury comes in tomorrow, I'll hear oral argument over the telephone, if necessary. Take the night off." Id. 1914:4-5.

The court explained what was required of the parties in their briefs. "I will want briefs that specifically -- and this is a reason to wait, too -- specifically tie the legal arguments to evidence, both testimony and documentary evidence you provide. So use the daily from this testimony of Mr. Acres as well." Id. 1915:6-9. The fact that briefs were required to be filed and the content requirements of those briefs were clear.

No briefs on iniquitable conduct were submitted by either party following trial. Mikohn bears the burden of proving iniquitable conduct, as it is its defense. Mentor H/S, Inc. v. Medical Device Alliance, Inc., 244 F.3d 1365, 1377 (Fed. Cir. 2001) ("^{HN15} A defendant **[*44]** asserting an iniquitable conduct defense must demonstrate by clear and convincing evidence that the applicant or his attorney failed to disclose material information to the PTO, and that the applicant or his attorney did so with intent to deceive the PTO."). Mikohn, therefore, bears the burden of submitting the first brief. Failure to submit briefs as ordered by the court constitutes a waiver of the defense and the party's right to argument on the defense. See Local Rule 7-2(d) ("The failure of a moving party to file points and authorities in support of the motion shall constitute a consent to the denial of the motion."); see also Hartford Mining Co. v. Home Lumber & Coal Co., 61 Nev. 1, 107 P.2d 128, 129 (Nev. 1940) (failure to file briefs constitutes waiver of right to oral argument).

Mikohn's Motion for a New Trial is denied. ⁶

FOOTNOTES

⁶ *HN16* ↗ A new trial is not "necessary to prevent a miscarriage of justice." See *Moist Cold Refrigerator Co.*, 249 F.2d at 251. Mikohn has not argued the point and the court sees no such necessity.

[*45] B. Acres's Motion for Prejudgment Interest is Granted

Acres moves "pursuant to Federal Rule of Civil Procedure 59(e), for an Order amending the Judgment against [Mikohn] to include prejudgment interest from June 1999 to March 2001." Acres's Motion for Prejudgment Interest at 2. Mikohn opposes the Motion on the grounds that Acres waived its right to prejudgment interest and that the rate requested is excessive. Mikohn Gaming Corporation's Opposition to Motion for Award of Prejudgment Interest ("Mikohn's Opposition to Acres's Motion for Prejudgment Interest") at 2. For the reasons set forth below, Acres's Motion for Prejudgment Interest is granted.

1. Acres Did Not Waive its Right to Prejudgment Interest Because Interest Is Provided for in 35 U.S.C. § 284 and Is Necessary to Fully Compensate Acres for the Infringement

Mikohn argues that "Acres waived any claim for prejudgment interest in the pre-trial order." *Id.* However, interest is provided for by statute. *HN17* ↗ 35 U.S.C. § 284 provides that damages for patent infringement include "a reasonable royalty for the use made of the invention by the infringer, together with [*46] interest and costs as fixed by the court". 35 U.S.C. § 284 (1994) (emphasis added).

In addition, the Supreme Court has spoken directly to this issue. In *General Motors Corp. v. Devex Corp.*, 461 U.S. 648, 76 L. Ed. 2d 211, 103 S. Ct. 2058 (1983), the Court said:

The standard governing the award of prejudgment interest under § 284 should be consistent with Congress' overriding purpose of affording patent owners complete compensation. In light of that purpose, we conclude that prejudgment interest should ordinarily be awarded. In the typical case an award of prejudgment interest is necessary to ensure that the patent owner is placed in as good a position as he would have been in had the infringer entered into as reasonable royalty agreement. . . .

. . .

We do not construe § 284 as requiring the award of prejudgment interest whenever infringement is found. *HN18* ↗ That provision states that interest shall be "fixed by the court," and in our view it leaves the court some discretion in awarding prejudgment interest. For example, it may be appropriate to limit prejudgment interest, or perhaps even deny it altogether, where the patent owner has [*47] been responsible for undue delay in prosecuting the lawsuit. There may be other circumstances in which it may be appropriate not to award prejudgment interest. We need not delineate those circumstances in this case. We hold only that prejudgment interest should be awarded under § 284 absent some justification for withholding such an award.

General Motors Corp. v. Devex Corp., 461 U.S. 648, 655-657, 76 L. Ed. 2d 211, 103 S. Ct. 2058 (1983) (emphasis added) (footnotes omitted).

In this case there have been no accusations that Acres has been responsible for delaying the action, and Mikohn has failed to provide any other justification for withholding prejudgment

interest. The only authorities Mikohn cites in support of its waiver argument are not on point and are not binding.

Mikohn cites two cases in which the plaintiff had moved for an accounting ⁷ and one non-patent prejudgment interest case ⁸ that was not governed by 35 U.S.C. § 284. None of those authorities discuss awarding prejudgment interest in a patent case where the damages statute provides for interest and where the Supreme Court has stated that interest should ordinarily **[*48]** be awarded absent a justification for withholding it. Based upon 35 U.S.C. § 284 and Devex, Acres's Motion for Prejudgment Interest is granted.

FOOTNOTES

⁷ Braintree Labs., Inc. v. Nephro-Tech, Inc., 81 F. Supp. 2d 1122, 1140 (D. Kan. 2000) and Elvis Presley Enters., Inc. v. Capece, 141 F.3d 188 (5th Cir. 1998).

⁸ Lindy Invs., LP v. Shakertown Corp., 209 F.3d 802 (5th Cir. 2000).

2. Acres's Requested Rate of Interest is Not Excessive

Acres argues that the rate of prejudgment interest should be "the rate Mikohn would have been charged to borrow money; calculated as the prime rate plus 150 basis points." Acres's Motion for Prejudgment Interest at 4. Mikohn argues that this rate is excessive and that a more reasonable rate would be based on 3-month U.S. Treasury Bill rates. Mikohn's Opposition to Acres's Motion for Prejudgment Interest at 2. Both arguments are based on the parties' respective experts and their reports.

The parties **[*49]** cite prejudgment interest cases that all agree that the rate of interest imposed is discretionary. Of the Federal Circuit patent cases cited, the most helpful is Bio-Rad Labs., Inc. v. Nicolet Instruction Corp., 807 F.2d 964 (Fed. Cir. 1986), in which the court said that the

rate of prejudgment interest and whether it should be compounded or un-compounded are matters left largely to the discretion of the district court. In exercising that discretion, however, the district court must be guided by the purpose of prejudgment interest, which is "to ensure that the patent owner is placed in as good a position as he would have been had the infringer entered into a reasonable royalty agreement."

Bio-Rad Labs., Inc. v. Nicolet Instruction Corp., 807 F.2d 964, 969 (Fed. Cir. 1986) (quoting Devex, 461 U.S. at 655) (citations omitted). See also Allen Archery, Inc. v. Browning Manuf. Co., 898 F.2d 787, 791 (Fed. Cir. 1990) ("The rationale of Devex is that 'in the typical case an award of prejudgment interest is necessary to ensure that the patent owner is placed in as good a position as he would have been had **[*50]** the infringer entered into a reasonable royalty agreement.' 461 U.S. at 655, 103 S. Ct. at 2062. It would be inconsistent with that rationale to require that, in order to award prejudgment interest, the district court first would have to consider and determine what use the patentee would have made of the royalty payments it should have received."); Laitram Corp. v. NEC Corp., 115 F.3d 947, 955 (Fed. Cir. 1997) ("As to the choice of prejudgment interest rate, the district court, in exercises of its discretion, awarded prejudgment interest and set the rate at the U.S. Treasury bill rate, compounded annually. The court held that this rate would 'adequately compensate plaintiff for the lost use of its royalties,' Slip opinion at 11. The district court found that there was no evidence that Laitram borrowed money at a higher rate, what that rate was, or that there was a causal connection between any borrowing and the loss of the use of the money awarded as a result of NEC's infringement. Nor has Laitram shown clear error in any of those

findings. We hold therefore that there was no abuse of discretion in the district court's choice of prejudgment interest rate. [*51] "); *Studiengesellschaft Kohle v. Dart Indus., Inc.*, 862 F.2d 1564, 1579-80 (Fed. Cir. 1988) (rejecting argument that plaintiff must show it is entitled to rate higher than commercial rate and stating that the case upon which defendant relied "did not establish any 'rule' requiring what Dart calls an 'affirmative demonstration,' i.e., proof of borrowing at or above prime, for a plaintiff to be entitled to an award of prejudgment interest at the prime rate. Nor do we intend to establish any rule that prejudgment interest at the prime rate should be awarded as a matter of course in every case. Simply put, the question of the rate at which such an award should be made is a matter left to the sound discretion of the trier of fact . . .").

In sum, the rate of prejudgment interest appears to be discretionary, and the court is to be guided by the principle that the award should place Acres in as good a position as it would have been in had the infringement not taken place. Therefore, in keeping with the policy stated in *Bio-Rad Lab.*, and following Mikohn's uncontested evidence of the average Treasury Bill rate for August 1997 through June 1999, Mikohn shall pay prejudgment [*52] interest at the rate of 4.78% compounded annually.

C. Acres's Motion for An Accounting of Sales is Granted

Acres moves "pursuant to Federal Rule of Civil Procedure 59(e), for an Order allowing amendment of the Judgment and for an accounting of [Mikohn's] sales from July 1999 forward, on the grounds that the damages for patent infringement awarded to Acres do not include reasonable royalty on Mikohn's Moneytime revenues obtained from infringing Acres' patents after June 1999." Acres's Motion for an Accounting of Sales at 1-2. Mikohn opposes the Motion on the grounds that Acres waived its right to an accounting and that any accounting would be speculative. Mikohn Gaming Corporation's Opposition to Motion for Accounting ("Mikohn's Opposition to Acres's Motion for an Accounting of Sales") at 2. For the reasons set forth below, Acres's Motion for an Accounting of Sales is granted.

1. Accounting is a Standard Practice in Patent Cases

The parties have not cited to, nor has the court located, any cases discussing the policy behind granting an accounting after judgment in patent actions. However, ^{HN19} accountings appear to be standard practice, based upon the authorities presented. [*53] See *Padco, Inc. v. Newell Cos., Inc.*, 1988 U.S. Dist. LEXIS 17384, 1988 WL 187504, *2 (E.D. Wis. 1988) (plaintiff "is entitled to an accounting from defendants . . . for an award of defendants' profits from sales of infringing products from March 31, 1987 to the date of injunction . . ."); *Whelan Assoc., Inc. v. Jaslow Dental Lab., Inc.*, 609 F. Supp. 1325, 1327 (E.D. Penn. 1985) ("Plaintiff's motion seek a further accounting for the . . . licenses sold after the last day of the trial The plaintiff is entitled to such an accounting This additional accounting is proper if my prior determination as to liability is correct."); *Technology for Energy Corp. v. Computational Sys., Inc.*, 1992 WL 535791, *36 (E.D. Tenn. 1992) ("The jury's verdict included damages through November 30, 1991. The judgment . . . will be amended to direct an accounting for infringement damages . . . for the period December 1, 1991, through the date of entry of an injunction prohibiting further infringement of the patent"). The court finds no reason to depart from this practice.

Furthermore, Federal Rule of Civil Procedure 62(a) makes clear that Congress contemplated [*54] accountings in patent actions. That rule provides that ^{HN20} "a judgment or order directing an accounting in an action for infringement of letters patent" shall not be stayed pending appeal. Fed. R. Civ. P. 62(a). Although the substance of the rule is not relevant to this Motion, Congress's provision regarding accounting in patent actions evidences its intent that accountings will at times be ordered. Given that evidence of intent and the apparently standard practice of ordering accountings, the court finds it proper to

order an accounting in this case.

2. Acres Did Not Waive Its Right To An Accounting Because In the Pre-Trial Order It Stated That One Issue Was The Amount of Damages Owed Acres By Mikohn For Infringement of its Patents

The Pretrial Order states that one of the issues for trial was the "amount of damages, attorneys' fees and costs" Acres is entitled to as a result of Mikohn's infringement. Pretrial Order at 4, ll. 17-18. Mikohn argues that Acres waived its claim to an accounting by failing to request it in the pretrial order. Mikohn's Opposition to Acres's Motion for an Accounting at 2. The fact that Acres did not separately state that it was seeking an accounting [*55] is of no consequence.

HN21 An accounting of profits for the purpose of recovering lost profits is an equitable remedy, and if Acres sought this remedy it needed to request it in the Complaint. See *Reebok Int'l, Ltd. v. Marnatech Enters., Inc.*, 970 F.2d 552, 561 (9th Cir. 1992) (stating asset freeze is "an equitable provisional remedy designed to secure the availability of Reebok's equitable right to an accounting of Betech's profits" where plaintiff sought lost profits under Lanham Act); Fed. R. Civ. P. 16(c) (Pretrial order "control[s] the subsequent course of the action"). What Acres seeks here, however, is evidence from which to calculate the reasonable royalty damages it did seek in its Complaint and in the Pretrial Order.

HN22 Reasonable royalty damages are not simply lost profits. As the jury instructions stated, a reasonable royalty is "the royalty that would have resulted from a hypothetical negotiation between Acres and a company on the position of Mikohn taking place at the time that the infringement began" and can be based upon any of thirteen factors, including the "established profitability of the product made under the patent", but not the infringer's profits. [*56] Agreed Jury Instructions at 68-70; see *Georgia-Pacific Corp. v. United States Plywood Corp.*, 318 F. Supp 1116 (S.D.N.Y. 1970). Therefore, the accounting Acres seeks is not for the purpose of disgorgement of profits, but is evidence of a reasonable royalty for the purpose of calculating the damages Acres sought when it filed suit against Mikohn, which are damages for the entire period of infringement.

Since Mikohn provided Acres and both parties' experts with data current through June 1999 from which to calculate a reasonable royalty, the experts' testimony as to a reasonable royalty up to that date was presented at trial. The jury was instructed that its damage award should include only a reasonable royalty through June 1999, consisted with the evidence presented. See Agreed Jury Instructions at 67 ("the amount of damages that Mikohn must pay Acres' for infringing Acres' patent may not be less than a reasonable royalty"); Tr. at 1930:18 - 1930:25 (jury asked if Acres's expert's damages calculations would be brought forward from June 1999 and the court instructed the jury that the court would decide that issue). Acres seeks only to extend that damage award to cover [*57] the full period of infringement. It does not seek a separate remedy of an accounting for recovery of lost profits. Therefore, its failure to specifically state in its complaint that it sought an accounting is irrelevant.

Mikohn's waiver argument on this Motion is identical to its waiver argument in opposition to Acres's Motion for Prejudgment Interest. It states that "Acres waived any claim for prejudgment interest [sic an accounting] in the pre-trial order." Mikohn's Opposition to Acres's Motion for an Accounting at 2. It then presents a string cite of three cases and does not present argument as to how those cases apply here. The cases Mikohn cites are not on point and are not binding.

In *Braintree Lab., Inc. v. Nephro-Tech., Inc.*, the District of Kansas denied a motion for an accounting because the plaintiff had not included a request for an accounting in its complaint

or in the pretrial order. *Braintree Labs., Inc. v. Nephro-Tech, Inc.*, 81 F. Supp. 2d 1122, 1140 (D.Kan. 2000). The jury had awarded the plaintiff lost profits as opposed to a reasonable royalty. See id. at 1139 ("This case is unlike the situation in which the fact-finder has [***58**] awarded damages based on a reasonable royalty. . . . It is not just a matter of extrapolating damages from the jury's lost profits award . . ."). The court stated that it "considers a request for an accounting to be a significant claim for relief and not a mere clerical exercise which would routinely and readily follow from a verdict in plaintiff's favor." Id. at 1140. However, the plaintiff was not seeking to extend a reasonable royalty damage award to the present date but rather to supplement a lost profit award by obtaining "an order from this court directing defendants to disgorge the amount of profits on the basis of the percentage of damages awarded by the jury to plaintiff." Id.

The Braintree court acknowledged that its case differed from a reasonable royalty case when it stated that

This case is unlike the situation in which the fact-finder has awarded damages based on a reasonable royalty. If the damages awarded were based on a reasonable royalty in this case, the court could, after an accounting, simply reference the reasonable royalty percentage decided upon by the jury and apply that to any sales revealed by the accounting.

[***59**] Id.

Here Acres moved the court for an accounting because the jury's award "does not include reasonable royalty on Mikohn's MoneyTime revenues obtained from infringing Acres' parents after June 1999." Acres's Motion for an Accounting at 2. In order to fulfill the mandate of 35 U.S.C. § 284 that the damage award shall not be "less than a reasonable royalty for the use made of the invention by the infringer", it is necessary for Acres to be provided with information to calculate a reasonable royalty for the entire period of infringement.

In addition, in denying the plaintiff's motion, the Braintree court relied more heavily on the fact that it would be impossible to tell how much of the defendant's profits came from infringing sales than it did on the fact that the claim was not in the complaint or the pretrial order. See *Braintree*, 81 F. Supp. 2d at 1140. Mikohn does not contend that this would be the case here.

Furthermore, the District Court in Braintree based its holding on a 10th Circuit case that stated that "the pretrial order supersedes the pleadings and controls the subsequent course of litigation". Id. (quoting *Hullman v. Board of Trustees of Pratt Community College*, 950 F.2d 665, 667 (10th Cir. 1991)). [***60**] *Hullman* is a civil rights case in which a college dean challenged his termination. The statement cited in Braintree was made in regard to a claim that the plaintiff advanced for the first time in response to defendant's motion for summary judgment. *Hullman*, 950 F.2d at 666. The plaintiff had filed suit against the college alleging his termination was in retaliation for his protest over a reassignment which he considered to be a demotion. Id. Then, in response to defendant's motion for summary judgment, he argued that his termination was in retaliation for his criticism of college's financial policies and practices. Id. That is not this case. Acres's claim for damages was advanced from the beginning of this case. At no time was its claim for damages divided into two periods, one pre-June 1999 and one post-June 1999, nor was there any question that Acres sought damages for the entire period of infringement.

Mikohn also cites to *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188 (5th Cir. 1998). That is a trademark case in which the court denied the plaintiff's claim for an accounting and for attorneys' fees, stating that the claims [***61**] were not "properly preserved and are therefore waived." *Elvis Presley Enters.*, 141 F.3d at 205. This case was governed by the Lanham Act, which applies only to trademark cases. The statute providing for damages under

the Lanham Act is 15 U.S.C. § 1117. The court stated:

In the Joint Pre-Trial Order signed by the parties' counsel, EPE's [Elvis Presley Enterprises] demand for an accounting of profits is not mentioned, but the Joint Pre-Trial Order does mention EPE's demands for injunctive relief, damages, and attorneys' fees under the Lanham Act, 15 U.S.C. § 1117(a). Section 1117(a) also provides for the remedy of an accounting of profits and lists it separately from damages. Therefore, EPE's listing of injunctive relief, damages, and attorneys' fees under the Lanham Act in the Joint Pre-Trial Order does not act to preserve its claim for an accounting of profits, and the issue therefore was waived.

Elvis Presley Enters., 141 F.3d at 206 (emphasis added).

The Lanham Act does not apply in this case. The damages statute applicable here is 35 U.S.C. § 284, and unlike **[*62]** 15 U.S.C. § 1117, ^{HN23} it does not specifically provide for an accounting as a remedy separate from damages. It states only that the patent owner is entitled to "damages adequate to compensate for the infringement". 35 U.S.C. § 284 (1994). Elvis Presley Enters. does not support Mikohn's claim that Acres's preservation of its "damages" claim does not include preservation of its request for an accounting.

Finally, Mikohn cites to *Lindy Invs., LP v. Shakertown Corp.*, 209 F.3d 802 (5th Cir. 2000). The cited statement is in regard to prejudgment interest, is completely inapplicable to Acres's Motion for an Accounting, and is a footnote in which the court cites *Elvis Presley Enterprises* for the proposition that the plaintiff's claim for prejudgment interest was not properly before the court because it was not in the pretrial order. *Lindy Invs.* is a contract case not governed by 35 U.S.C. § 284. It is inapplicable.

None of the authorities cited by Mikohn are binding on this court, and none stand for the proposition that in a case governed by 35 U.S.C. § 284 in which damages **[*63]** are to be ascertained by a reasonable royalty, a claim for "damages" in the pretrial order does not include a claim for an accounting.

In contrast, binding authority exists that states that ^{HN24} the damages awarded the patent holder must be "adequate to compensate" for the infringement, 35 U.S.C. § 284, which means "full compensation for any damages the patent owner suffered as a result of the infringement", *Grain Processing Corp. v. American Maize-Products Co.*, 185 F.3d 1341, 1349 (Fed. Cir. 1999) (internal punctuation omitted) (quoting *Devox*, 461 U.S. at 654).

Damages suffered as a result of infringement include those for the entire period of infringement. The fact that the damages experts employed by both sides were provided with information covering Mikohn's sales only through June 1999 does not reduce the period for which Mikohn must compensate Acres. To deny the Motion for an Accounting would be to allow Mikohn to evade its obligation to pay damages for the remainder of the period of infringement and would contradict the patent law's purpose of compensating patent holders for the damage suffered due to infringement.

3. An Accounting Need Not Be Speculative

[*64] Mikohn argues that "the accounting requested by Acres would be wholly speculative." Mikohn's Opposition to Acres's Motion for an Accounting at 2. In support it cites *Braintree*. As stated above, the court in *Braintree* found that it would be impossible to tell how much of the defendant's profits came from infringing sales. See *Braintree*, 81 F. Supp. 2d at 1140. Mikohn does not make that argument about its own sales. Since the MoneyTime system has been found to infringe on Acres's patents, all sales of the MoneyTime system are infringing sales.

Mikohn focuses its argument more on what royalty rate would be applied to award damages based upon the accounting. See Mikohn's Opposition to Acres's Motion for an Accounting at 3. Acres argues that the "evidence of damages presented to the jury was based on a reasonable royalty rate[] of 28%, with slot machines, and 42%, without slot machines", and it was instructed that "the amount of damages must be not less than a reasonable royalty". Acres Gaming, Inc.'s Reply Re: Motion to Amend Judgment and for an Accounting of Sales at 4 (emphasis in original). Since the jury [*65] awarded more than Acres's expert calculated as a reasonable royalty under those rates, Acres argues, "the jury must be presumed to have done its duty and applied at least the reasonable royalty offered by" its expert. Id. at 5. Therefore, it concludes, "the minimum royalty rate proposed by Acres of twenty-eight percent would provide a floor for damages." Id. Mikohn claims that "there is no basis to apply Acres's expert's conclusion as to a reasonable royalty rate". Mikohn's Opposition to Acres's Motion for An Accounting at 3.

The jury awarded more than the royalties calculated by Acres's expert. Consistent with its instructions, it awarded not less than a reasonable royalty. No speculation is required to see that the jury exceeded the rates proposed by Acres's expert. It is therefore well within the ambit of reasonableness to apply those royalty rates in calculating additional damages owed for the period of June 1999 through the end of the period of infringement.

D

Acres's Motion for a Permanent Injunction and Mikohn's Request to Stay the Injunction are Granted

Acres moves to permanently enjoin Mikohn "from continuing to make, use, sell or offer for sale its MoneyTime [*66] system." Acres's Motion for a Permanent Injunction at 4. As the Federal Circuit has stated:

HN25—Infringement having been established, it is contrary to the laws of property, of which the patent law partakes, to deny the patentee's rights to exclude others from use of his property. 35 U.S.C. § 261. . . . It is the general rule that an injunction will issue when infringement has been adjudged, absent a sound reason for denying it.

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1246-47 (Fed. Cir. 1989) (citations omitted).

Mikohn has cited no legal authority or factual reasons for denying the injunction. In order to preserve Acres's patent rights and preclude further infringement of the patents at issue, the permanent injunction is granted.

Mikohn argues that "in the event a permanent injunction is issued, based on the strong merits of Mikohn's motion for a judgment as a matter of law, such an injunction should be stayed pursuant to Rule 62(d) of the Federal Rules of Civil Procedure". Mikohn Gaming Corporation's Opposition to Motion for Permanent Injunction at 2.

As the court has denied Mikohn's Motion for Judgment as a Matter of [*67] Law, it is not persuaded by Mikohn's written argument that the Motion is strong on its merits. However, based on arguments made at oral argument, the injunction shall be stayed.

At oral argument, Acres requested additional security in the event that the injunction is stayed. The court asked if Acres had reason to believe it would be unable to collect further damages from Mikohn. Acres said that Mikohn had raised red flags in its SEC filings and was

seeking additional financing. In arguing against additional security, Mikohn stated that in securing a large damage award, Acres argued to the jury that Mikohn was a large and profitable company.

The court is persuaded by Mikohn's argument as it pertains to both security in the event of a stay and the stay itself. It would be inequitable for Acres to obtain a large damage award at trial by arguing that Mikohn is a large and profitable company, and then to obtain additional security from Mikohn by way of a claim that a judgment against it may become uncollectable. Mikohn has posted a court-ordered bond in the amount of \$ 1,500,000, the amount of the jury's verdict. Certificate of Deposit of Supersedeas and Cost on Appeal Bond (# 540). In [*68] light of Mikohn's apparent size and profitability, this should provide Acres with sufficient security for the verdict and for any additional damages it may suffer during the course of the stay of the injunction. Should Acres be entitled to compensation for any additional damages suffered during the pendency of the stay, it will likely be able to collect those damages from Mikohn.

In addition, Mikohn represented to the court at oral argument that the MoneyTime system is no longer in place in many casinos and that it is no longer a major product for Mikohn. Thus, any damages sustained by Acres over the course of the stay are likely to be minimal. Therefore, Acres's Motion for a Permanent Injunction is granted, and the injunction shall be stayed pending resolution of any appeal taken in this case.

V

CONCLUSION

For the reasons set forth above, Mikohn Gaming Corporation's Renewed Motion for Judgment as a Matter of Law and Motion for New Trial (# 512) is denied and Acres Gaming Inc.'s Motion to Amend Judgment and for an Award of Prejudgment Interest (# 514), Acres Gaming Inc.'s Motion to Amend Judgment and for an Accounting of Sales (# 514) and Acres Gaming's Motion for Entry of [*69] a Permanent Injunction Regarding Mikohn's MoneyTime System (# 513) are granted. The rate of prejudgment interest is set at 4.78 % compounded annually, and the permanent injunction is stayed pending resolution of any appeals taken in this case.

Evann J. Wallach, Judge

Date: August 1, 2001

New York, New York

ORDER

The court having reviewed the pleadings and papers on file herein, having heard oral argument, and good cause appearing, it is hereby

ORDERED that Mikohn Gaming Corporation's Renewed Motion for Judgment as a Matter of Law and Motion for New Trial (# 512) is denied; and it is further

ORDERED that Acres Gaming Inc.'s Motion to Amend Judgment and for an Award of Prejudgment Interest (# 514) is granted; and it is further

ORDERED that the rate of prejudgment interest is 4.78 % compounded annually; and it is further

ORDERED that Acres Gaming Inc.'s Motion to Amend Judgment and for an Accounting of Sales (# 514) is granted; and it is further

ORDERED that Acres Gaming's Motion for Entry of a Permanent Injunction Regarding Mikohn's MoneyTime System (# 513) is granted; and it is further

ORDERED that the permanent injunction is stayed pending resolution of any appeals [*70] taken in this case.

Evan J. Wallach, Judge

Dated: August 1, 2001

New York, New York






Source: [Legal > / . . . / > Patent Cases from Federal Courts and Administrative Materials](#)

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1998 U.S. Dist. LEXIS 20983, *; 48 U.S.P.Q.2D (BNA) 1383

MIKOHN GAMING CORP., a Nevada corporation, Plaintiff, vs. ACRES GAMING, INC., a Nevada corporation, Defendant.

CV-S-98-00738-HDM (RLH)

UNITED STATES DISTRICT COURT FOR THE DISTRICT OF NEVADA

1998 U.S. Dist. LEXIS 20983; 48 U.S.P.Q.2D (BNA) 1383

July 7, 1998, Decided
July 9, 1998, Filed; July 10, 1998, Entered

DISPOSITION: [*1] Acres' motion to dismiss for lack of subject matter jurisdiction (# 6) denied. Defendant Mikohn Gaming Corporation's motion to transfer and consolidate this case with Mikohn Gaming v. Acres Gaming, CV-S-97-1383-HDM (LRL) and Acres Gaming v. Mikohn Gaming, CV-S-98-00794-PMP (LRL) (# 8) granted.

CASE SUMMARY:

PROCEDURAL POSTURE: Plaintiff sought declaratory relief that it was not infringing defendant corporation's patent. Pursuant to Fed. R. Civ. P. 12(b)(1), defendant corporation filed a motion to dismiss the action for lack of subject matter jurisdiction on the grounds that there was no case or controversy.

OVERVIEW: In a related action, plaintiff filed suit against the corporation for declaratory judgment that plaintiff's slot machine system did not infringe the corporation's '961 patent. The corporation sent letters to plaintiff's current and prospective customers concerning the patent. The court enjoined the corporation from stating to plaintiff's customers that the plaintiff's system infringed the corporation's '961 patent and granted the corporation leave to file a counterclaim against plaintiff for infringement. Subsequently, the U.S. Patent Office issued to the corporation an additional patent, '183, which had the same disclosure as the '961 patent. Plaintiff then filed suit challenging the validity of the '183 patent. The court held that it had subject matter to consider the issue only if there were a case or controversy. The court concluded that the letters sent to plaintiff's current and prospective customers combined with the parties' course of dealing created an objectively reasonable apprehension that the corporation intended to enforce the subsequent patent by means of an infringement suit.

OUTCOME: The court denied the corporation's motion to dismiss. However, the court consolidated the case with the prior case.

CORE TERMS: patent, declaratory judgment, patent infringement, infringement, disclosure, apprehension, infringe, subject matter jurisdiction, customers, filed suit, course of dealing, counterclaim, declaratory, manufacture, declaration, infringing, infringed, enclosed, machine, intends, slot

LEXISNEXIS(R) HEADNOTES

Civil Procedure > Declaratory Judgment Actions > General Overview

Constitutional Law > The Judiciary > Case or Controversy > Advisory Opinions
Patent Law > Remedies > Declaratory Relief

HN1 The court has subject matter jurisdiction under the Declaratory Judgment Act, 28 U.S.C.S. § 2201, and the U.S. Const. art. III, § 2 only if a case or controversy existed between the parties at the time the complaint was filed. A party may not "obtain a declaratory judgment merely because it would like an advisory opinion on whether it would be liable for patent infringement if it were to initiate some merely contemplated activity. The conflict must be "real and immediate." Whether there is an actual case or controversy is a question of law to be decided by the court.

Patent Law > Inequitable Conduct > General Overview

Patent Law > Infringement Actions > Burdens of Proof

Patent Law > Infringement Actions > Defenses > Patent Invalidity > General Overview

HN2 A party seeking a declaration of patent invalidity or non-infringement must prove that: (1) the defendant has engaged in conduct creating a reasonable apprehension on the declaratory plaintiff's part that it will face an infringement suit if it engages in the activity in question; and (2) the declaratory plaintiff has actually produced or has actually prepared to produce the potentially infringing device.

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For Plaintiff: DONG JAMES CHUNG, GEORGE M. BORKOWSKI, BRENT RABOWSKY, Los Angeles, CA.

JUDGES: Howard D. McKibben, UNITED STATES DISTRICT JUDGE.

OPINION BY: Howard D. McKibben

OPINION

ORDER

Pursuant to Fed.R.Civ.P. 12(b)(1), defendant Acres Gaming, Inc. has moved to dismiss for lack of subject matter jurisdiction.

In a related action ¹, Mikohn filed suit against Acres Gaming Inc. for declaratory judgment that Mikohn's slot machine bonusing system, the MoneyTime System, did not infringe Acres' U.S. Patent No. **5,655,961** (" '961 patent"). In that case, Acres sent letters to Mikohn's current and prospective customers, which stated, in pertinent part,:

Enclosed is [***2**] a copy of U.S. Patent No. **5,655,961** for a Method for Operating Networked Gaming Devices, assigned to Acres Gaming.

....

It appears that the MoneyTime slot machines infringe at least some of the claims

of the enclosed patent, although this cannot be determined conclusively without a better understanding of the structure and operation of the MoneyTime system. There are a number of pending US applications owned by Acres Gaming which have the same disclosure as the '961 patent.

...

You should be aware that when these patents issue, Acres Gaming intends to use its patents to stop manufacture and sales of such systems.

FOOTNOTES

¹ Case No. CV-S-97-1383-HDM (LRL)

On January 13, 1998, the court enjoined Acres from stating to Mikohn's customers that the MoneyTime System infringed on Acres '961 patent or other pending patent applications submitted by Acres to the United States Patent Offices. The court recently granted Acres' motion to file a counterclaim against Mikohn for infringement of the '961 patent. **[*3]**

On April 21, 1998, the U.S. Patent Office issued Patent No. 5,741,183 ("183") to Acres, which has the same disclosure as the '961 patent. Mikohn filed this action for declaratory judgment that the '183 patent was invalid and not infringed by the MoneyTime System.

On May 19, 1998, the U.S. Patent Office issued to Acres Patent No. 5,752,882 ("882 Patent"), which also has the same disclosure as the '961 patent. Acres immediately filed suit for patent infringement against Mikohn. ²

FOOTNOTES

² Case NO. CV-S-98-0794-PMP

DISCUSSION

Acres has moved to dismiss the instant action for declaratory judgment on the grounds that there is no case or controversy. ^{HN1} This court has subject matter jurisdiction under the Declaratory Judgment Act, 28 U.S.C. § 2201, and Article III, § 2 only if a case or controversy existed between the parties at the time the complaint was filed. A party may not "obtain a declaratory judgment merely because it would like an advisory opinion on whether it would be liable for patent infringement if **[*4]** it were to initiate some merely contemplated activity." *Arrowhead Industrial Water, Inc. v. Ecochem, Inc.*, 846 F.2d 731, 736, (Fed.Cir. 1988). The conflict must be "real and immediate." *Id.* at 735. Whether there is an actual case or controversy is a question of law to be decided by the court. *Super Sack Mfg. Corp. v. Chase Packaging Corp.*, 57 F.3d 1054, 1058 (Fed. Cir. 1995).

^{HN2} A party seeking a declaration of patent invalidity or non-infringement must prove that: (1) the defendant has engaged in conduct creating a reasonable apprehension on the declaratory plaintiff's part that it will face an infringement suit if it engages in the activity in question; and (2) the declaratory plaintiff has actually produced or has actually prepared to produce the potentially infringing device. *GAF Building Materials Corp. v. Elk Corp.*, 90 F.3d 479, 481 (Fed.Cir. 1996).

Acres contends Mikohn had no reasonable apprehension of being sued for infringement of the '183 patent because the letters did not specifically reference that patent. Acres further represents that it "has no reason to believe that Mikohn is *currently* infringing the '183 patent."

The court concludes, however, that **[*5]** the letters sent to Mikohn's current and prospective customers combined with the parties course of dealing created an objectively reasonable apprehension on the part of Mikohn that the defendants intended to enforce their '183 patent by means of an infringement suit. The letters specifically referenced pending patent applications which have the same disclosure as the '961 patent. The letter explicitly stated that "when these patents issue, Acres Gaming intends to use its patents to stop manufacture and sale of [the MoneyTime System]." Thus, when the United States Patent Office issued the '183 patent, which has the same disclosure as the '961 patent, it was reasonable for Mikohn to believe that Acres would likely file a patent infringement suit.

Moreover, this is the second action filed by Mikohn which seeks a declaration that its MoneyTime System does not infringe Acres' patents. In the first suit, Acres did not immediately file a counterclaim for patent infringement. It was only after the parties participated in a period of discovery that Acres concluded the MoneyTime System does indeed infringe the '961 patent. Thus, Acres representation that it does not currently believe there **[*6]** is infringement of the '183 patent is irrelevant. The parties' course of dealing throughout the first suit created a reasonable apprehension that Acres would eventually file a claim for patent infringement of the '183 patent.

Accordingly, Acres' motion to dismiss for lack of subject matter jurisdiction (# 6) is denied.

It is so ORDERED.

Dated this 7th day of July, 1998.

Howard D. McKibben

UNITED STATES DISTRICT JUDGE

ORDER

The defendant Mikohn Gaming Corporation's motion to transfer and consolidate this case with Mikohn Gaming v. Acres Gaming, CV-S-97-1383-HDM (LRL) and Acres Gaming v. Mikohn Gaming, CV-S-98-00794-PMP (LRL) (# 8) is granted. Hereinafter, pleadings and motions shall bear only the title and designation by number of CV-S-97-1383-HDM (LRL) with the words "(Base File)" written below the case number and shall be filed only in the base file.

It is so ORDERED.

Dated this 7th day of July, 1998.

Howard D. McKibben

UNITED STATES DISTRICT JUDGE

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<u>Mikohn Gaming Corporation v. Acres Gaming, Inc</u>	US-DIS-NVD	2:97cv1383	Docket	Apr 12 2010 2:12PM
(<u>Int v. Bally Gaming International Inc et al</u>)	US-DIS-DED	1:06cv282	Docket	Apr 12 2010 2:11PM

US District Court Civil Docket**U.S. District - Delaware
(Wilmington)****1:06cv282****Igt v. Bally Gaming International Inc et al****This case was retrieved from the court on Monday, April 12, 2010**

Date Filed: 04/28/2006	Class Code: CLOSED
Assigned To: Judge Sue L Robinson	Closed: Yes
Referred To:	Statute: 35:271
Nature of suit: Patent (830)	Jury Demand: Plaintiff
Cause: Patent Infringement	Demand Amount: \$0
Lead Docket: None	NOS Description: Patent
Other Docket: None	
Jurisdiction: Federal Question	

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Bally Technologies Inc A Nevada Corporation
Counter Claimant

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Date	#	Proceeding Text
04/28/2006	1	COMPLAINT filed with Jury Demand against Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc. - Magistrate Consent Notice to Pltf. (Filing fee \$ 350, receipt number 143250.) - filed by International Game Technology. (Attachments: # 1 Exhibit 1 part 1# 2 Exhibit 1 part 2# 3 Exhibit 2 part 1# 4 Exhibit 2 part 2# 5 Exhibit 3 part 1# 6 Exhibit 3 part 2# 7 Exhibit 4 part 1# 8 Exhibit 4 part 2# 9 Exhibit 5 part 1# 10 Exhibit 5 part 2# 11 Exhibit 6 part 1# 12 Exhibit 6 part 2# 13 Exhibit 7# 14 Exhibit 8 part 1# 15 Exhibit 8 part 2# 16 Exhibit 9# 17 Civil Cover Sheet # 18 Acknowledgement of Consent Form)(mwm,) (Entered: 05/01/2006)
04/28/2006	--	Summons Issued as to Bally Gaming International Inc. on 4/28/2006; Bally Technologies Inc. on 4/28/2006; Bally Gaming Inc. on 4/28/2006. (mwm,) (Entered: 05/01/2006)
04/28/2006	2	Notice of Availability of a U.S. Magistrate Judge to Exercise Jurisdiction (mwm,) (Entered: 05/01/2006)
05/01/2006	3	Report to the Commissioner of Patents and Trademarks for Patent Number(s) RE38,812; RE37,885; 6,832,958; 6,319,125; 6,244,958; please see patent report for additional patents. (mwm,) (Entered: 05/01/2006)
05/03/2006	4	Return of Service Executed by International Game Technology. Bally Gaming International Inc. served on 5/1/2006, answer due 5/22/2006. (Wade, William) (Entered: 05/03/2006)
05/03/2006	5	Return of Service Executed by International Game Technology. Bally Gaming Inc. served on 5/1/2006, answer due 5/22/2006. (Wade, William) (Entered: 05/03/2006)

- 05/08/2006 6 AMENDED COMPLAINT against all defendants- filed by International Game Technology. (Attachments: # 1 Exhibit Ex. 1, Part 1# 2 Exhibit Ex. 1, Part 2# 3 Exhibit Ex. 2, Part 1# 4 Exhibit Ex. 2, Part 2# 5 Exhibit Ex. 3, Part 1# 6 Exhibit Ex. 3, Part 2# 7 Exhibit Ex. 4, Part 1# 8 Exhibit Ex. 4, Part 2# 9 Exhibit Ex. 5, Part 1# 10 Exhibit Ex. 5, Part 2# 11 Exhibit Ex. 6, Part 1# 12 Exhibit Ex. 6, Part 2# 13 Exhibit Ex. 7# 14 Exhibit Ex. 8, Part 1# 15 Exhibit Ex. 8, Part 2# 16 Exhibit Ex. 9)(Wade, William) (Entered: 05/08/2006)
- 05/09/2006 7 MOTION to Expedite Motion for Expedited Discovery - filed by IGT. (Gaza, Anne) Modified on 5/10/2006 (dab,). (Entered: 05/09/2006)
- 05/09/2006 8 OPENING BRIEF in Support re 7 MOTION to Expedite Motion for Expedited Discovery Opening Brief In Support Of Plaintiff IGT's Motion For Expedited Discovery filed by IGT.Answering Brief/Response due date per Local Rules is 5/23/2006. (Attachments: # 1 Exhibit # 2 Exhibit # 3 Exhibit # 4 Exhibit # 5 Exhibit # 6 Exhibit)(Gaza, Anne) (Entered: 05/09/2006)
- 05/09/2006 9 Letter to Dr. Peter T. Dalleo from William J. Wade representing IGT regarding Enclosing Motion for Expedited Discovery and Opening Brief in Support thereof. (Attachments: # 1 Supplement # 2 Supplement # 3 Supplement # 4 Supplement # 5 Supplement # 6 Supplement # 7 Supplement # 8 Supplement)(Gaza, Anne) Modified on 5/10/2006 (dab,). (Entered: 05/09/2006)
- 05/10/2006 10 Disclosure Statement pursuant to Rule 7.1 filed by IGT identifying International Game Technology as Corporate Parent. (King, Matthew) (Entered: 05/10/2006)
- 05/10/2006 -- CORRECTING ENTRY: Per telephone conversation with atty for Plaintiff and Amended Complaint, Case Caption and Plaintiff's name changed from International Game Technology to IGT. In addition, deleted IGT as Defendant. (error in docketing) (dab,) (Entered: 05/10/2006)
- 05/10/2006 -- CORRECTING ENTRY: Filer corrected in DI #7 and DI #9 (dab,) (Entered: 05/10/2006)
- 05/10/2006 -- Case assigned to Judge Kent A. Jordan. Please include the initials of the Judge (KAJ) after the case number on all documents filed. (rjb,) (Entered: 05/10/2006)
- 05/11/2006 11 NOTICE of Appearance by Jack B. Blumenfeld on behalf of all defendants (Blumenfeld, Jack) (Entered: 05/11/2006)
- 05/11/2006 12 MOTION for Pro Hac Vice Appearance of Attorney Charles K. Verhoeven and Amy H. Candido - filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 05/11/2006)
- 05/12/2006 13 Letter to The Honorable Kent A. Jordan from Jack B. Blumenfeld regarding IGT's motion for expedited discovery. (Blumenfeld, Jack) (Entered: 05/12/2006)
- 05/12/2006 14 MOTION for Pro Hac Vice Appearance of Attorney Brett Williamson and Charles A. Thomasian of O'Melveny & Myers LLP - filed by IGT. (Gaza, Anne) (Entered: 05/12/2006)
- 05/12/2006 -- Minute Entry for proceedings held before Judge Kent A. Jordan : Telephone Conference held on 5/12/2006. (Court Reporter B. Gaffigan.) (rwc,) (Entered: 05/15/2006)
- 05/15/2006 15 STENO NOTES for 5/12/06 filed by Court Reporter: B. Gaffigan. (Notes on file in Clerk's Office) (rwc,) (Entered: 05/15/2006)
- 05/15/2006 16 ORDER - denying 7 Motion to Expedite . Signed by Judge Kent A. Jordan on 5/15/06. (rwc,) (Entered: 05/15/2006)
- 05/15/2006 17 Return of Service Executed by IGT. Bally Gaming International Inc. served on 5/9/2006, answer due 5/30/2006; Bally Gaming Inc. served on 5/9/2006, answer due 5/30/2006. (Wade, William) (Entered: 05/15/2006)
- 05/15/2006 18 NOTICE of Lodging of Return of Service of Motion for Expedited Discovery, Opening Brief in support thereof, and Rule 7.1 Disclosure Statement on Defendants Bally Gaming International, Inc. and Bally Gaming, Inc. by IGT (D.I. #7) (Wade, William) (Entered: 05/15/2006)
- 05/15/2006 19 TRANSCRIPT of teleconference held on 5/12/06 before Judge Jordan. Court Reporter: B. Gaffigan. (Transcript on file in Clerk's Office) (rwc,) (Entered: 05/15/2006)
- 05/15/2006 20 MOTION for Pro Hac Vice Appearance of Attorney David P. Enzminger of O'Melveny & Myers LLP - filed by IGT. (Gaza, Anne) (Entered: 05/15/2006)
- 05/17/2006 21 MOTION for Pro Hac Vice Appearance of Attorney Edward J. DeFranco - filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 05/17/2006)
- 05/17/2006 -- SO ORDERED, re 14 MOTION for Pro Hac Vice Appearance of Attorney Brett Williamson and Charles A. Thomasian of O'Melveny & Myers LLP filed by IGT. Signed by Judge Kent A. Jordan on 5/17/06. (rwc,) (Entered: 05/17/2006)
- 05/17/2006 -- SO ORDERED, re 12 MOTION for Pro Hac Vice Appearance of Attorney Charles K. Verhoeven and Amy H. Candido filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc. Signed by Judge Kent A. Jordan on 5/17/06. (rwc,) (Entered: 05/17/2006)
- 05/22/2006 -- SO ORDERED, re 20 MOTION for Pro Hac Vice Appearance of Attorney David P. Enzminger of O'Melveny & Myers LLP filed by IGT & 21 MOTION for Pro Hac Vice Appearance of Attorney Edward J. DeFranco filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc. Signed by Judge Kent A. Jordan on 5/22/06. (rwc,) (Entered: 05/22/2006)

- 05/22/2006 22 STIPULATION TO EXTEND TIME to answer complaint to June 21, 2006 - filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 05/22/2006)
- 05/22/2006 -- SO ORDERED, re 22 STIPULATION TO EXTEND TIME to answer complaint to June 21, 2006 . Signed by Judge Kent A. Jordan on 5/22/06. (rwc,) (Entered: 05/22/2006)
- 05/25/2006 23 Letter to The Honorable Kent A. Jordan from Jack B. Blumenfeld regarding proposed scheduling order. (Attachments: # 1 Exhibits A-B)(Blumenfeld, Jack) Additional attachment(s) added on 5/26/2006 (rwc,). (Entered: 05/25/2006)
- 05/26/2006 -- CORRECTING ENTRY: Docket Clerk Replaced Cover Letter - Re: DI#23 with corrected version at the request of filer. (rwc,) (Entered: 05/26/2006)
- 05/26/2006 24 NOTICE OF SERVICE of Plaintiff IGT's First Set of Requests for Production of Documents and Things to Defendants by IGT.(Wade, William) (Entered: 05/26/2006)
- 06/01/2006 25 MOTION to Transfer Case to District Court of Nevada - filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 06/01/2006)
- 06/01/2006 26 OPENING BRIEF in Support re 25 MOTION to Transfer Case to District Court of Nevada filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. Answering Brief/Response due date per Local Rules is 6/15/2006. (Louden, Karen) . Modified on 6/2/2006 (rwc,). (Entered: 06/01/2006)
- 06/01/2006 27 DECLARATION re 25 MOTION to Transfer Case to District Court of Nevada, 26 Opening Brief in Support, Declaration of Mark A. Lipparelli by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 06/01/2006)
- 06/01/2006 28 DECLARATION re 26 Opening Brief in Support,, 25 MOTION to Transfer Case to District Court of Nevada Declaration of Amy H. Candido by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibits 1-2# 2 Exhibits 3-7)(Louden, Karen) (Entered: 06/01/2006)
- 06/02/2006 -- CORRECTING ENTRY: Replaced DI# 26 with corrected version at the request of filer because exhibits had been inadvertently omitted. (rwc,) (Entered: 06/02/2006)
- 06/02/2006 29 Certificate Pursuant to Rule 7.1.1 - filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc., Re: 25 MOTION to Transfer Case to District Court of Nevada . (Louden, Karen) Modified on 6/2/2006 (rwc,). (Entered: 06/02/2006)
- 06/08/2006 30 NOTICE OF SERVICE of (1) Bally's First Set Of Requests To IGT For Production Of Documents And Things (Nos. 1-84); (2) Bally's First Set Of Interrogatories To IGT (Nos. 1-11) by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc..(Louden, Karen) (Entered: 06/08/2006)
- 06/13/2006 31 ORDER, Scheduling Teleconference set for 7/6/2006 03:00 PM before Honorable Kent A. Jordan. Signed by Judge Kent A. Jordan on 6/13/06. (rwc,) (Entered: 06/13/2006)
- 06/15/2006 32 STIPULATION TO EXTEND TIME within which Plaintiff IGT must file its Answering Brief in Opposition to Defendants' Motion to Transfer to Thursday, June 22, 2006 - filed by IGT. (Gaza, Anne) (Entered: 06/15/2006)
- 06/15/2006 -- SO ORDERED, re 32 STIPULATION TO EXTEND TIME - Reset Briefing Schedule: re 25 MOTION to Transfer Case to District Court of Nevada. Answering Brief due 6/22/2006. Signed by Judge Kent A. Jordan on 6/15/06. (rwc,) (Entered: 06/15/2006)
- 06/16/2006 33 STIPULATION TO EXTEND TIME to respond to the Amended Complaint to June 28, 2006 - filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 06/16/2006)
- 06/19/2006 -- SO ORDERED, re 33 STIPULATION TO EXTEND TIME to respond to the Amended Complaint to June 28, 2006 - Set/Reset Answer Deadlines: Bally Gaming International Inc. answer due 6/28/2006; Bally Technologies Inc. answer due 6/28/2006; Bally Gaming Inc. answer due 6/28/2006. Signed by Judge Kent A. Jordan on 6/19/06. (rwc,) (Entered: 06/19/2006)
- 06/22/2006 34 ANSWERING BRIEF in Opposition re 25 MOTION to Transfer Case to District Court of Nevada filed by IGT.Reply Brief due date per Local Rules is 6/29/2006. (King, Matthew) (Entered: 06/22/2006)
- 06/22/2006 35 DECLARATION re 34 Answering Brief in Opposition, 25 MOTION to Transfer Case to District Court of Nevada of Charles A. Thomasian in Support of IGT's Opposition of Bally's Motion to Transfer by IGT. (Attachments: # 1 Exhibit A - F# 2 Exhibit G - L# 3 Exhibit M - O# 4 Exhibit P# 5 Exhibit Q)(King, Matthew) (Entered: 06/22/2006)
- 06/22/2006 36 DECLARATION re 25 MOTION to Transfer Case to District Court of Nevada, 34 Answering Brief in Opposition of Michael Ordville in Support of IGT's Opposition to Bally's Motion to Transfer by IGT. (King, Matthew) (Entered: 06/22/2006)
- 06/28/2006 -- CORRECTING ENTRY: Modified DI# 35 Declaration Exhibit description - changed to numeric per request of filer. (rwc,) (Entered: 06/28/2006)

- 06/28/2006 37 STIPULATION TO EXTEND TIME for defendants to respond to Amended Complaint and to file reply brief in support of their motion to transfer to June 30, 2006 - filed by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Smith, Rodger) (Entered: 06/28/2006)
- 06/29/2006 38 NOTICE OF SERVICE of Bally's Responses And Objections To IGT's First Set Of Requests For Production Of Documents And Things by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc..(Blumenfeld, Jack) (Entered: 06/29/2006)
- 06/29/2006 -- CORRECTING ENTRY: DI# 39 was deleted - (duplicate entry of DI# 38). (nwc,) (Entered: 06/29/2006)
- 06/30/2006 39 REPLY BRIEF re 25 MOTION to Transfer Case to District Court of Nevada filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Smith, Rodger) (Entered: 06/30/2006)
- 06/30/2006 40 ANSWER to Amended Complaint for Patent Infringement, Affirmative Defenses and COUNTERCLAIM against IGT by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibit 1-4)(Smith, Rodger) (Entered: 06/30/2006)
- 07/03/2006 -- SO ORDERED, re 37 STIPULATION TO EXTEND TIME for defendants to respond to Amended Complaint and to file reply brief in support of their motion to transfer to June 30, 2006. Signed by Judge Kent A. Jordan on 7/3/06. (nwc,) (Entered: 07/03/2006)
- 07/05/2006 41 REPLY BRIEF re 25 MOTION to Transfer Case to District Court of Nevada Defendants' Amended Reply Brief In Support Of Their Motion To Transfer filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc., Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 07/05/2006)
- 07/06/2006 42 STENO NOTES for 7/6/06 filed by Court Reporter: B. Gaffigan. (Notes on file in Clerk's Office) (nwc,) (Entered: 07/06/2006)
- 07/06/2006 -- Minute Entry for proceedings held before Judge Kent A. Jordan : Scheduling Teleconference held on 7/6/2006. (Court Reporter B. Gaffigan.) (nwc,) (Entered: 07/07/2006)
- 07/07/2006 43 TRANSCRIPT of teleconference held on 7/6/06 before Judge Jordan. Court Reporter: B. Gaffigan. (Transcript on file in Clerk's Office) (nwc,) (Entered: 07/07/2006)
- 07/10/2006 44 Letter to Hon. Kent A. Jordan from Karen Jacobs Louden regarding submitting proposed Scheduling Order. (Attachments: # 1 Text of Proposed Order proposed scheduling order) (Louden, Karen) (Entered: 07/10/2006)
- 07/11/2006 45 SCHEDULING ORDER: Case referred to the Magistrate Judge for the purpose of exploring ADR. Joinder of Parties due by 10/20/2006. Amended Pleadings due by 2/16/2007. Discovery due by 6/22/2007. Status Conference set for 4/18/2007 04:30 PM before Honorable Kent A. Jordan. Status Report due by 4/11/2007. Tutorial on the technology due by 11/2/2006. Dispositive Motions due by 8/17/2007. Claims Construction due by 7/13/2007. Markman Hearing set for 9/7/2007 09:30 AM in Courtroom 6A before Honorable Kent A. Jordan. Final Pretrial Conference set for 1/17/2008 04:30 PM before Honorable Kent A. Jordan. Proposed Pretrial Order due by 12/21/2007. Jury Trial (10-days) set for 2/25/2008 09:30 AM in Courtroom 6A before Honorable Kent A. Jordan. Signed by Judge Kent A. Jordan on 7/11/06. (Attachments: # 1 PTO form)(nwc,) (Entered: 07/11/2006)
- 07/11/2006 46 TRIAL MANAGEMENT ORDER - Signed by Judge Kent A. Jordan on 7/11/06. (nwc,) (Entered: 07/11/2006)
- 07/12/2006 47 NOTICE OF SERVICE of Plaintiff IGT's Objections and Responses to Bally's First Set of Requests for Production of Documents and Things (Nos. 1-84) by IGT.(Gaza, Anne) (Entered: 07/12/2006)
- 07/13/2006 48 NOTICE OF SERVICE of IGT's Responses to Bally's First Set of Interrogatories (Nos. 1-11) re 30 Notice of Service, by IGT. Related document: 30 Notice of Service, filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.,(Gaza, Anne) (Entered: 07/13/2006)
- 07/14/2006 49 ORDER Setting Hearing on Motion 25 to Transfer Case to District Court of Nevada: Motion Hearing set for 8/22/2006 02:00 PM in Courtroom 6A before Honorable Kent A. Jordan. Signed by Judge Kent A. Jordan on 7/14/06. (nwc,) (Entered: 07/14/2006)
- 07/18/2006 50 NOTICE OF SERVICE of Plaintiff IGT's Initial Disclosures Pursuant to Fed.R.Civ.P.26(a)(1) by IGT.(Gaza, Anne) (Entered: 07/18/2006)
- 07/19/2006 51 NOTICE OF SERVICE of Bally's Rule 26 Initial Disclosures by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc..(Louden, Karen) (Entered: 07/19/2006)
- 07/19/2006 52 STIPULATION TO EXTEND TIME within which plaintiff IGT must move, answer or otherwise respond to the Counterclaims to Monday, July 24, 2006 - filed by IGT. (Gaza, Anne) (Entered: 07/19/2006)
- 07/20/2006 -- SO ORDERED, re 52 STIPULATION TO EXTEND TIME within which plaintiff IGT must move, answer or otherwise respond to the Counterclaims to Monday, July 24, 2006. Signed by Judge Kent A. Jordan on 7/20/06. (nwc,) (Entered: 07/20/2006)

- 07/24/2006 53 MOTION to Dismiss Based upon IGT's Motion to Dismiss Defendants' Counterclaim Counts X, XI and XII - filed by IGT. (Attachments: # 1 Text of Proposed Order)(Gaza, Anne) (Entered: 07/24/2006)
- 07/24/2006 54 OPENING BRIEF in Support re 53 MOTION to Dismiss Based upon IGT's Motion to Dismiss Defendants' Counterclaim Counts X, XI and XII filed by IGT. Answering Brief/Response due date per Local Rules is 8/7/2006. (Attachments: # 1 Exhibit A)(Gaza, Anne) (Entered: 07/24/2006)
- 07/24/2006 55 MOTION IGT's Request for Judicial Notice in Support of its Motion to Dismiss Defendants' Counterclaim Counts X, XI and XII re 53 MOTION to Dismiss Based upon IGT's Motion to Dismiss Defendants' Counterclaim Counts X, XI and XII - filed by IGT. (Attachments: # 1 Exhibit A & B)(Gaza, Anne) (Entered: 07/24/2006)
- 07/24/2006 56 ANSWER to Counterclaim [Plaintiff IGT's Reply to Bally's Counterclaims] by IGT.(Gaza, Anne) (Entered: 07/24/2006)
- 07/25/2006 57 STIPULATION and [Proposed] Protective Order by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibits A and B)(Louden, Karen) (Entered: 07/25/2006)
- 07/27/2006 58 SO ORDERED, re 57 Stipulation filed by IGT., Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc. Signed by Judge Kent A. Jordan on 7/27/06. (rwc,) (Entered: 07/27/2006)
- 07/28/2006 59 MOTION for Extension of Time to file Defendants' Answering Brief in Opposition to IGT's Motion to Dismiss Defendants' Counterclaim Counts X, XI and XII - filed by IGT, Bally Gaming International Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 07/28/2006)
- 08/03/2006 60 MOTION for Extension of Time to file and serve answering brief and reply brief - filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc., Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 08/03/2006)
- 08/10/2006 -- SO ORDERED, re 60 MOTION for Extension of Time - re 53 MOTION to Dismiss - Answering Brief due 8/18/2006. Reply Brief due 9/1/2006. Signed by Judge Kent A. Jordan on Joseph J. Rhoades. (rwc,) (Entered: 08/10/2006)
- 08/18/2006 61 NOTICE of Request for Judicial Notice in Opposition by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc. re 53 MOTION to Dismiss Based upon IGT's Motion to Dismiss Defendants' Counterclaim Counts X, XI and XII (Attachments: # 1 Exhibits 1-2)(Louden, Karen) (Entered: 08/18/2006)
- 08/18/2006 62 ANSWERING BRIEF in Opposition re 53 MOTION to Dismiss Based upon IGT's Motion to Dismiss Defendants' Counterclaim Counts X, XI and XII filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. Reply Brief due date per Local Rules is 8/25/2006. (Louden, Karen) (Entered: 08/18/2006)
- 08/22/2006 63 STENO NOTES for 8/22/06 filed by Court Reporter: B. Gaffigan. (Notes on file in Clerk's Office) (rwc,) (Entered: 08/22/2006)
- 08/22/2006 64 ORDER - denying 25 Motion to Transfer Case . Signed by Judge Kent A. Jordan on 8/22/06. (rwc,) (Entered: 08/22/2006)
- 08/22/2006 -- Minute Entry for proceedings held before Judge Kent A. Jordan : Motion Hearing held on 8/22/2006 re 25 MOTION to Transfer Case to District Court of Nevada.(Court Reporter B. Gaffigan.) (rwc,) (Entered: 08/22/2006)
- 08/24/2006 65 Order Setting Teleconference: Telephone Conference set for 9/12/2006 09:30 AM before Honorable Mary Pat Thyngne to discuss ADR. Signed by Judge Mary Pat Thyngne on 8/23/2006. (cab,) (Entered: 08/24/2006)
- 08/24/2006 66 TRANSCRIPT of Motion Hearing held on 8/22/06 before Judge Jordan, Court Reporter: B. Gaffigan. (Transcript on file in Clerk's Office) (rwc,) (Entered: 08/24/2006)
- 08/28/2006 67 ORDER The teleconference scheduled for September 12, 2006 at 9:30 AM has been rescheduled to October 5, 2006 at 3:30 PM with Judge Thyngne to discuss ADR. Signed by Judge Mary Pat Thyngne on 8/28/2006. (cab,) (Entered: 08/28/2006)
- 09/01/2006 68 REPLY BRIEF re 53 MOTION to Dismiss Based upon IGT's Motion to Dismiss Defendants' Counterclaim Counts X, XI and XII filed by IGT, IGT. (Attachments: # 1 Brief - Part 2)(Gaza, Anne) (Entered: 09/01/2006)
- 09/01/2006 69 MOTION Judicial Notice re 68 Reply Brief (REQUEST FOR JUDICIAL NOTICE IN SUPPORT OF IGT'S REPLY IN SUPPORT OF ITS MOTION TO DISMISS DEFENDANTS' COUNTERCLAIM COUNTS X, XI AND XII) - filed by IGT, IGT. (Attachments: # 1 Exhibit 1 - Part 1# 2 Exhibit 1 - Part 2# 3 Exhibit 1 - Part 3# 4 Exhibit 1 - Part 4# 5 Exhibit 2-4)(Gaza, Anne) (Entered: 09/01/2006)
- 09/06/2006 70 REQUEST for Oral Argument by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc., Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc. re 53 MOTION to Dismiss Based upon IGT's Motion to Dismiss Defendants' Counterclaim Counts X, XI and XII. (Louden, Karen) (Entered: 09/06/2006)

- 10/05/2006 71 MOTION for Pro Hac Vice Appearance of Attorney David P. Dalke of O'Melveny & Myers LLP - filed by IGT. (Gaza, Anne) (Entered: 10/05/2006)
- 10/11/2006 72 ORDER - that the tutorial hearing presently set for November 2, 2006 at 10:00 a.m. is hereby rescheduled to November 2, 2006 at 11:00 a.m. in Courtroom 6A, 6th Floor, J. Caleb Boggs Federal Building, Wilmington, Delaware. Signed by Judge Kent A. Jordan on 10/11/06. (rwc,) (Entered: 10/11/2006)
- 10/11/2006 73 ORDER Setting Mediation Conferences: Mediation Conference set for 5/16/2007 09:00 AM in Courtroom 6C before Honorable Mary Pat Thyng. Signed by Judge Mary Pat Thyng on 10/11/2006. (cab,) (Entered: 10/11/2006)
- 10/12/2006 -- SO ORDERED, re 71 MOTION for Pro Hac Vice Appearance of Attorney David P. Dalke of O'Melveny & Myers LLP filed by IGT. Signed by Judge Kent A. Jordan on 10/12/06. (rwc,) (Entered: 10/12/2006)
- 10/31/2006 74 Letter to the Honorable Kent A. Jordan from Jack B. Blumenfeld regarding technical tutorial. (Blumenfeld, Jack) (Entered: 10/31/2006)
- 10/31/2006 75 MOTION for Preliminary Injunction [Plaintiff IGT's Motion for a Preliminary Injunction] - filed by IGT. (Gaza, Anne) (Entered: 10/31/2006)
- 10/31/2006 76 EXHIBIT re 75 MOTION for Preliminary Injunction [Plaintiff IGT's Motion for a Preliminary Injunction] PROPOSED ORDER TEXT by IGT. (Gaza, Anne) (Entered: 10/31/2006)
- 10/31/2006 77 SEALED MEMORANDUM in Support re 75 MOTION for Preliminary Injunction [Plaintiff IGT's Motion for a Preliminary Injunction] filed by IGT. Answering Brief/Response due date per Local Rules is 11/15/2006. (Gaza, Anne) (Entered: 10/31/2006)
- 10/31/2006 78 SEALED DECLARATION re 75 MOTION for Preliminary Injunction [Plaintiff IGT's Motion for a Preliminary Injunction] [Declaration of Reed M. Alewel in Support of IGT's Motion for a Preliminary Injunction] by IGT. (Gaza, Anne) (Entered: 10/31/2006)
- 10/31/2006 79 SEALED DECLARATION re 75 MOTION for Preliminary Injunction [Plaintiff IGT's Motion for a Preliminary Injunction] [Declaration of David P. Dalke in Support of IGT's Motion for a Preliminary Injunction] by IGT. (Gaza, Anne) (Entered: 10/31/2006)
- 10/31/2006 80 SEALED DECLARATION re 75 MOTION for Preliminary Injunction [Plaintiff IGT's Motion for a Preliminary Injunction] [Declaration of Bart A. Lewin in Support of IGT's Motion for a Preliminary Injunction] by IGT. (Gaza, Anne) (Entered: 10/31/2006)
- 10/31/2006 81 NOTICE of Request for Judicial Notice in Support of IGT's Motion for a Preliminary Injunction by IGT re 75 MOTION for Preliminary Injunction [Plaintiff IGT's Motion for a Preliminary Injunction] (Attachments: # 1 Exhibit 1 Part 1# 2 Errata 1 Part 2# 3 Exhibit 1 Part 3# 4 Exhibit 1 Part 4# 5 Errata 1 Part 5# 6 Exhibit 1 Part 6# 7 Exhibit 2 and 3)(Gaza, Anne) (Entered: 10/31/2006)
- 10/31/2006 82 Letter to The Honorable Kent A. Jordan from William J. Wade regarding Motion for Preliminary Injunction and Tutorial. (Wade, William) (Entered: 10/31/2006)
- 11/02/2006 83 STENO NOTES for 11/2/06 filed by Court Reporter: B. Gaffigan. (Notes on file in Clerk's Office) (rwc,) (Entered: 11/02/2006)
- 11/02/2006 84 NOTICE of Lodging by IGT (Attachments: # 1 Description of cd-rom)(Gaza, Anne) (Entered: 11/02/2006)
- 11/02/2006 -- Minute Entry for proceedings held before Judge Kent A. Jordan : Technology Tutorial Hearing held on 11/2/2006. (Court Reporter B. Gaffigan.) (rwc,) (Entered: 11/02/2006)
- 11/02/2006 85 Technology Tutorial cd-rom. Original material(s) on file in Clerk's Office. Notice filed by Anne Shea Gaza on behalf of IGT (rwc,) Modified on 2/13/2008 (rwc,). (Entered: 11/03/2006)
- 11/07/2006 86 REDACTED VERSION of 77 MEMORANDUM in Support of Plaintiff's Motion for a Preliminary Injunction by IGT. (Gaza, Anne) (Entered: 11/07/2006)
- 11/07/2006 87 REDACTED VERSION of 79 Declaration of David P. Dalke in Support of IGT's Motion for a Preliminary Injunction by IGT. (Attachments: # 1 Exhibit Exhibits 1 through 9# 2 Exhibit Exhibits 10 through 20)(Gaza, Anne) (Entered: 11/07/2006)
- 11/07/2006 88 REDACTED VERSION of 78 Declaration of Reed M. Alewel in Support of IGT's Motion for a Preliminary Injunction by IGT. (Attachments: # 1 Exhibit Exhibits 1 through 3)(Gaza, Anne) (Entered: 11/07/2006)
- 11/07/2006 89 REDACTED VERSION of 80 Declaration of Bart A. Lewin in Support of Plaintiff IGT's Motion for a Preliminary Injunction by IGT. (Attachments: # 1 Exhibit Exhibits A, B, C# 2 Exhibit Exhibits D, E, F, G, H, I# 3 Exhibit Exhibits J, K, L# 4 Exhibit Exhibits M,N,O,P# 5 Exhibit Exhibit Q# 6 Exhibit Exhibits R,S,T,U,V,W,X# 7 Exhibit Exs. Y, Z# 8 Exhibit Exs. AA-EE)(Gaza, Anne) (Entered: 11/07/2006)
- 11/09/2006 90 TRANSCRIPT of Tutorial Hearing held on 11/2/06 before Judge Jordan. Court Reporter: B. Gaffigan. (Transcript on file in Clerk's Office) (rwc) (Entered: 11/09/2006)
- 11/15/2006 91 Letter to The Honorable Kent A. Jordan from Jack B. Blumenfeld regarding request for telephonic scheduling conference. (Blumenfeld, Jack) (Entered: 11/15/2006)

- 11/16/2006 92 Letter to The Honorable Kent A. Jordan from William J. Wade in response to 91 letter, re: briefing schedule for Motion 75 for Preliminary Injunction. (Gaza, Anne) Modified on 11/16/2006 (nwc,). (Entered: 11/16/2006)
- 11/16/2006 -- CORRECTING ENTRY: Text entry for DI# 92 corrected at the request of filer. (nwc) (Entered: 11/16/2006)
- 11/17/2006 93 NOTICE to Take Deposition of Bart A. Lewin on December 5, 2006 by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc..(Blumenfeld, Jack) (Entered: 11/17/2006)
- 11/17/2006 94 NOTICE to Take Deposition of Richard E. Rowe on December 6, 2006 by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc..(Blumenfeld, Jack) (Entered: 11/17/2006)
- 11/17/2006 95 NOTICE to Take Deposition of Alec Ginsberg on December 7, 2006 by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc..(Blumenfeld, Jack) (Entered: 11/17/2006)
- 11/17/2006 96 NOTICE to Take Deposition of Reed M. Alewel on December 8, 2006 by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc..(Blumenfeld, Jack) (Entered: 11/17/2006)
- 11/21/2006 97 ORDER - Discovery Teleconference set for 11/28/2006 02:00 PM before Honorable Kent A. Jordan. Signed by Judge Kent A. Jordan on 11/21/06. (nwc) (Entered: 11/21/2006)
- 11/21/2006 98 NOTICE to Take Deposition of IGT on December 12, 2006 by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibit A)(Blumenfeld, Jack) (Entered: 11/21/2006)
- 11/28/2006 99 STENO NOTES for 11/28/06 filed by Court Reporter: B. Gaffigan. (Notes on file in Clerk's Office) (nwc) (Entered: 11/28/2006)
- 11/28/2006 100 ORDER - Set Briefing Schedule: re 75 MOTION for Preliminary Injunction: Answering Brief due 2/15/07; Reply Brief due 3/9/07 - Motion Hearing set for 3/23/2007 01:30 PM before Honorable Kent A. Jordan. Signed by Judge Kent A. Jordan on 11/28/06. (nwc) (Entered: 11/28/2006)
- 11/28/2006 -- Minute Entry for proceedings held before Judge Kent A. Jordan : Telephone Conference held on 11/28/2006. (Court Reporter B. Gaffigan.) (nwc) (Entered: 11/28/2006)
- 11/29/2006 101 TRANSCRIPT of teleconference held on 11/28/06 before Judge Jordan. Court Reporter: B. Gaffigan. (Transcript on file in Clerk's Office) (nwc) (Entered: 11/29/2006)
- 12/01/2006 102 NOTICE OF SERVICE of Plaintiff IGT's First Set of Interrogatories to Defendants (Nos. 1-3) by IGT.(Gaza, Anne) (Entered: 12/01/2006)
- 12/05/2006 103 NOTICE to Take Deposition of Defendants Pursuant to F.R.C.P. (30)(b)(6) on January 15, 2007 at 9:00 a.m. by IGT.(Gaza, Anne) (Entered: 12/05/2006)
- 12/15/2006 104 [1:06-cv-282-***]: Please note that, in accordance with the attached standing order, this case has been designated as one to be assigned to the judge who fills the vacancy left by the elevation of Judge Kent A. Jordan to the United States Court of Appeals for the Third Circuit. Pending assignment, the case has been referred to Magistrate Judge Mary Pat Thyng for all pretrial proceedings, pursuant to 28 U.S.C. section 636(b). Please include ***, in place of the Judge's initials, after the case number on all documents filed. (nwc) (Entered: 12/15/2006)
- 02/05/2007 105 NOTICE OF SERVICE of Plaintiff IGT's Responses and Objections to Bally Rule 30(B)(6) Deposition Notice re 98 Notice to Take Deposition by IGT. Related document: 98 Notice to Take Deposition filed by Bally Gaming Inc., Bally Gaming International Inc., Bally Technologies Inc..(Wade, William) (Entered: 02/05/2007)
- 02/05/2007 106 Order Setting Teleconference: Oral argument scheduled before Judge Thyng on 3/23/2007 at 1:30 p.m. and the status teleconference scheduled for 4/18/2007 at 4:30 p.m. are canceled. A status Telephone Conference has been scheduled for 2/21/2007 at 2:30 PM before Honorable Mary Pat Thyng. Signed by Judge Mary Pat Thyng on 2/5/2007. (cak) (Entered: 02/05/2007)
- 02/15/2007 107 Letter to The Honorable Mary Pat Thyng from Jack B. Blumenfeld regarding Revised Scheduling Order. (Attachments: # 1 Text of Proposed Order Revised Scheduling Order) (Blumenfeld, Jack) (Entered: 02/15/2007)
- 02/21/2007 108 Order Setting Teleconference: Telephone Conference set for 2/28/2007 02:00 PM before Honorable Mary Pat Thyng. Signed by Judge Mary Pat Thyng on 2/21/2007. (cak) (Entered: 02/21/2007)
- 02/21/2007 109 STENO NOTES for 2/21/07 filed by Court Reporter: B. Gaffigan. (Notes on file in Clerk's Office) (nwc) (Entered: 02/22/2007)
- 02/21/2007 -- Minute Entry for proceedings held before Judge Mary Pat Thyng : Status Teleconference held on 2/21/2007. (Court Reporter B. Gaffigan.) (nwc) (Entered: 02/22/2007)
- 02/28/2007 110 STENO NOTES for 2/28/07 filed by Court Reporter: B. Gaffigan. (Notes on file in Clerk's Office) (nwc) (Entered: 02/28/2007)

- 02/28/2007 111 REVISED SCHEDULING ORDER: Joinder of Parties due by 3/16/2007. Discovery due by 1/11/2008. Dispositive Motions due by 2/8/2008. Signed by Judge Mary Pat Thyngne on 2/28/07. (rwc) (Entered: 03/01/2007)
- 02/28/2007 -- Minute Entry for proceedings held before Judge Mary Pat Thyngne : Status Teleconference held on 2/28/2007. (Court Reporter B. Gaffigan.) (rwc) (Entered: 03/01/2007)
- 03/05/2007 112 TRANSCRIPT of teleconference held on 2/28/07 before Judge Thyngne. Court Reporter: B. Gaffigan. (Transcript on file in Clerk's Office) (rwc) (Entered: 03/05/2007)
- 03/05/2007 113 NOTICE OF SERVICE of Plaintiff IGT's Responses and Objections to Bally's Second Set of Interrogatories to IGT (No. 12) by IGT.(Gaza, Anne) (Entered: 03/05/2007)
- 03/22/2007 114 NOTICE OF SERVICE of Bally's Responses and Objections to IGT's Rule 30(b)(6) Notice by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc..(Blumenfeld, Jack) (Entered: 03/22/2007)
- 04/02/2007 -- Case reassigned to Judge Sue L. Robinson. Please include the initials of the Judge (SLR) after the case number on all documents filed. (rjb) (Entered: 04/02/2007)
- 05/03/2007 115 ORDER The mediation scheduled for 5/16/2007 at 9:00 AM with Judge Thyngne is canceled. Signed by Judge Mary Pat Thyngne on 5/3/2007. (cak) (Entered: 05/03/2007)
- 05/15/2007 116 NOTICE OF SERVICE of Bally's Objections And Responses To IGT's First Set Of Interrogatories To Defendants (Nos. 1-3) by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc..(Louden, Karen) (Entered: 05/15/2007)
- 05/16/2007 -- Set Deadlines/Hearings: Telephone Conference set for 6/7/2007 11:00 AM before Honorable Sue L. Robinson. (rd) (Entered: 05/16/2007)
- 06/04/2007 -- Set Deadlines/Hearings: Telephone Conference set for 6/6/2007 11:00 AM before Honorable Sue L. Robinson. (rd) (Entered: 06/04/2007)
- 06/06/2007 -- Minute Entry for proceedings held before Judge Sue L. Robinson : Telephone Conference held on 6/6/2007. (Court Reporter V. Gunning.) (rd) (Entered: 06/06/2007)
- 06/07/2007 117 TRANSCRIPT of Telephone Conference held on 6/6/07 before Judge Robinson. Court Reporter: V. Gunning. (Transcript on file in Clerk's Office) (fmt) (Entered: 06/07/2007)
- 06/07/2007 118 ORDER, Setting Hearings/Discovery/Scheduling Conference set for 6/21/2007 10:00 AM in Courtroom 6B before Honorable Sue L. Robinson. Signed by Judge Sue L. Robinson on 6/7/07. (rd) (Entered: 06/07/2007)
- 06/12/2007 119 MOTION for Pro Hac Vice Appearance of Attorney Jennifer A. Kash - filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.(Blumenfeld, Jack) Modified on 6/20/2007 (rwc,). (Entered: 06/12/2007)
- 06/15/2007 120 NOTICE OF SERVICE of Plaintiff IGT's Supplemental Response to Bally's Interrogatory No. 9 from Bally's First Set of Interrogatories to IGT (Nos. 1-11) re 30 Notice of Service, by IGT. Related document: 30 Notice of Service, filed by Bally Gaming Inc., Bally Gaming International Inc., Bally Technologies Inc..(Gaza, Anne) (Entered: 06/15/2007)
- 06/21/2007 121 MOTION for Pro Hac Vice Appearance of Attorney Alexander Rudis - filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Blumenfeld, Jack) (Entered: 06/21/2007)
- 06/21/2007 -- SO ORDERED, re 119 MOTION for Pro Hac Vice Appearance of Attorney Jennifer A. Kash filed by Bally Gaming Inc., Bally Gaming International Inc., Bally Technologies Inc. Signed by Judge Sue L. Robinson on 6/20/07. (rd) (Entered: 06/21/2007)
- 06/21/2007 -- Minute Entry for proceedings held before Judge Sue L. Robinson : withdrawing 53 Motion to Dismiss ; finding as moot 55 Motion ; finding as moot 69 Motion ; withdrawing 75 Motion for Preliminary Injunction; Discovery Conference held on 6/21/2007; Counsel to submit a revised scheduling order. (Court Reporter V. Gunning.) (rd) (Entered: 06/22/2007)
- 06/27/2007 122 TRANSCRIPT of Discovery Conference held on 6/21/07 before Judge Robinson. Court Reporter: V. Gunning. (Transcript on file in Clerk's Office) (fmt) (Entered: 06/27/2007)
- 06/28/2007 -- SO ORDERED, re 121 MOTION for Pro Hac Vice Appearance of Attorney Alexander Rudis filed by Bally Gaming Inc., Bally Gaming International Inc., Bally Technologies Inc. Signed by Judge Sue L. Robinson on 6/27/07. (rd) (Entered: 06/28/2007)
- 07/10/2007 123 STIPULATION and Amended Protective Order by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibit A-B)(Gaza, Anne) (Entered: 07/10/2007)
- 07/12/2007 -- SO ORDERED, re 123 Stipulation and Amended Protective Order filed by Bally Gaming Inc., Bally Gaming International Inc., Bally Technologies Inc., IGT. Signed by Judge Sue L. Robinson on 7/11/07. (rd) (Entered: 07/12/2007)
- 07/23/2007 124 Letter to Hon. Sue L. Robinson from Karen Jacobs Louden regarding Amended Scheduling Order. (Attachments: # 1 Text of Proposed Order Amended Scheduling Order)(Louden, Karen) (Entered: 07/23/2007)

- 07/26/2007 125 AMENDED SCHEDULING ORDER: Case referred to the Magistrate Judge for the purpose of exploring ADR. Joinder of Parties due by 12/14/2007. Amended Pleadings due by 12/14/2007. Discovery due by 4/14/2008. Discovery Conference set for 9/19/2007 05:00 PM in Courtroom 6B before Honorable Sue L. Robinson. Dispositive Motions due by 6/6/2008. Answering Brief due 6/30/2008. Reply Brief due 7/15/2008. Oral Argument set for 8/15/2008 09:30 AM in Courtroom 6B before Honorable Sue L. Robinson. Joint Claim Construction Statement with separately docketed claim chart due 5/23/08. Claim Construction Opening Brief due by 6/6/2008. Simultaneous response briefs due 6/30/08. Pretrial Conference set for 10/23/2008 04:30 PM in Courtroom 6B before Honorable Sue L. Robinson. Jury Trial set for 11/3/2008 09:30 AM in Courtroom 6B before Honorable Sue L. Robinson. Signed by Judge Sue L. Robinson on 7/25/07. (rid) (Entered: 07/26/2007)
- 08/16/2007 126 NOTICE OF SERVICE of Bally's First Supplemental Responses to IGT's First Set of Interrogatories to Defendants (Nos. 1-3) by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc..(Blumenfeld, Jack) (Entered: 08/16/2007)
- 08/21/2007 127 NOTICE OF SERVICE of Plaintiff IGT's Second Supplemental Response to Bally's Interrogatory Nos. 2 and 10 from Bally's First Set of Interrogatories to IGT (Nos. 1 - 11) re 30 Notice of Service, by IGT. Related document: 30 Notice of Service, filed by Bally Gaming Inc., Bally Gaming International Inc., Bally Technologies Inc..(Gaza, Anne) (Entered: 08/21/2007)
- 10/17/2007 128 NOTICE OF SERVICE of Plaintiff IGT's Third Supplemental Response to Bally's Interrogatory No. 9 from Bally's First Set of Interrogatories to IGT (Nos. 1-11) re 30 Notice of Service, by IGT. Related document: 30 Notice of Service, filed by Bally Gaming Inc., Bally Gaming International Inc., Bally Technologies Inc..(Gaza, Anne) (Entered: 10/17/2007)
- 11/05/2007 129 NOTICE to Take Deposition of Bally Gaming International, Inc., Bally Technologies, Inc. and Bally Gaming, Inc. on December 7, 2007 by IGT. (Attachments: # 1 Exhibit A)(Gaza, Anne) (Entered: 11/05/2007)
- 11/08/2007 130 NOTICE OF SERVICE of IGT's Second Supplemental Response to Bally's Interrogatory No. 6 from Bally's First Set of Interrogatories to IGT (Nos. 1-11) re 30 Notice of Service, 48 Notice of Service, by IGT. Related document: 30 Notice of Service, filed by Bally Gaming Inc., Bally Gaming International Inc., Bally Technologies Inc., 48 Notice of Service, filed by IGT.(Gaza, Anne) (Entered: 11/08/2007)
- 11/19/2007 131 NOTICE to Take Deposition of Michael Shelby on November 30, 2007 by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc..(Blumenfeld, Jack) (Entered: 11/19/2007)
- 11/19/2007 132 NOTICE to Take Deposition of Larry Pitman on November 30, 2007 by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc..(Blumenfeld, Jack) (Entered: 11/19/2007)
- 11/19/2007 133 NOTICE to Take Deposition of Plaintiff IGT on November 29, 2007 by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc..(Blumenfeld, Jack) (Entered: 11/19/2007)
- 11/21/2007 134 NOTICE of Withdrawal of Charles Thomasian As One Of The Attorneys Of Record for Plaintiff IGT by IGT re 1 Complaint,, 6 Amended Complaint,, (Gaza, Anne) (Entered: 11/21/2007)
- 12/14/2007 135 NOTICE to Take Deposition of Wayne Walkwitz on January 14, 2008 by IGT.(Wade, William) (Entered: 12/14/2007)
- 12/14/2007 136 NOTICE to Take Deposition of Bryan Kelly on January 14, 2008 by IGT.(Wade, William) (Entered: 12/14/2007)
- 12/14/2007 137 NOTICE to Take Deposition of Carmen DiMichele on January 9, 2008 by IGT.(Wade, William) (Entered: 12/14/2007)
- 12/14/2007 138 NOTICE to Take Deposition of Dennis Lockard on January 11, 2008 by IGT.(Wade, William) (Entered: 12/14/2007)
- 12/14/2007 139 NOTICE to Take Deposition of Derik Mooberry on January 7, 2008 by IGT.(Wade, William) (Entered: 12/14/2007)
- 12/14/2007 140 NOTICE to Take Deposition of Frank Silvestro on January 8, 2008 by IGT.(Wade, William) (Entered: 12/14/2007)
- 12/14/2007 141 NOTICE to Take Deposition of Gennady Soliterman on January 10, 2008 by IGT.(Wade, William) (Entered: 12/14/2007)
- 12/14/2007 142 NOTICE to Take Deposition of James Slattery on January 10, 2008 by IGT.(Wade, William) (Entered: 12/14/2007)
- 12/14/2007 143 NOTICE to Take Deposition of Jeff Allen on January 15, 2008 by IGT.(Wade, William) (Entered: 12/14/2007)
- 12/14/2007 144 NOTICE to Take Deposition of Kunal Mishra on January 9, 2008 by IGT.(Wade, William) (Entered: 12/14/2007)
- 12/14/2007 145 NOTICE to Take Deposition of Ronald Gallaway on January 7, 2008 by IGT.(Wade, William) (Entered: 12/14/2007)

12/14/2007 146 NOTICE to Take Deposition of Tom Reilly on January 8, 2008 by IGT.(Wade, William) (Entered: 12/14/2007)

12/14/2007 147 NOTICE to Take Deposition of Walt Eisele on January 11, 2008 by IGT.(Wade, William) (Entered: 12/14/2007)

01/02/2008 148 MOTION for Pro Hac Vice Appearance of Attorney James Paul Jenal - filed by IGT. (Gaza, Anne) (Entered: 01/02/2008)

01/04/2008 149 NOTICE to Take Deposition of Bally Gaming International, Inc., Bally Technologies, Inc. and Bally Gaming, Inc. on January 22, 2008 by IGT.(Gaza, Anne) (Entered: 01/04/2008)

01/04/2008 150 NOTICE OF SERVICE of Plaintiff IGT's Second Set of Requests for Production of Documents and Things to Defendants (Nos. 41-60) and Plaintiff IGT's First Set of Interrogatories to Defendants (Nos. 4-7) by IGT.(Gaza, Anne) (Entered: 01/04/2008)

01/08/2008 -- SO ORDERED, re 148 MOTION for Pro Hac Vice Appearance of Attorney James Paul Jenal filed by IGT. Signed by Judge Sue L. Robinson on 1/8/08. (dab) (Entered: 01/08/2008)

02/20/2008 151 Joint STIPULATION to Revise Scheduling Order Entered July 26, 2007 re 125 Scheduling Order,,, by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc. (Blumenfeld, Jack) (Entered: 02/20/2008)

02/20/2008 152 Joint STIPULATION to Dismiss Claims Related to Certain Patents Pleaded in This Case by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc. (Blumenfeld, Jack) (Entered: 02/20/2008)

02/22/2008 153 NOTICE to Take Deposition of John F. Acres on March 26, 2008 by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.(Blumenfeld, Jack) (Entered: 02/22/2008)

02/22/2008 154 NOTICE of Subpoena of John F. Acres by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc. (Blumenfeld, Jack) (Entered: 02/22/2008)

02/25/2008 -- SO ORDERED, re 152 Stipulation filed by Bally Gaming Inc., Bally Gaming International Inc., Bally Technologies Inc., IGT. Signed by Judge Sue L. Robinson on 2/25/2008. (nfn) (Entered: 02/25/2008)

02/25/2008 155 NOTICE OF SERVICE of (1) Bally's Second Set Of Requests To IGT For Production Of Documents And Things (Nos. 85-114); (2) Bally's Third Set Of Interrogatories (Nos. 13-18); (3) Bally's Responses To IGT's Second Set Of Interrogatories (Nos. 4-7); and (4) Bally's Responses To IGT's Second Set Of Requests For Production Of Documents To Defendants (Nos. 41-60) by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.(Louden, Karen) (Entered: 02/25/2008)

02/26/2008 -- SO ORDERED, re 151 Stipulation Setting Scheduling Order Deadlines (Discovery due by 6/6/2008., Claim Construction Opening Brief due by 6/20/2008., Response briefs due by 7/18/2008. Dispositive Motions due by 6/20/2008., Answering Brief due 7/18/2008., Reply Brief due 8/1/2008.) See D.I. 151 for further details. Signed by Judge Sue L. Robinson on 2/25/08. (fmt) (Entered: 02/26/2008)

02/26/2008 156 Report to the Commissioner of Patents and Trademarks for Patent/Trademark Number(s) US 6,319,125; US 6,565,434 B1; US 6,244,958 B1; US 6,620,046 B2; US 6,832,958 B2; (Attachments: # 1 Stipulation (D.I. 152)) (fmt) (Entered: 02/26/2008)

03/10/2008 157 NOTICE of Subpoenas to Desert Palace, Inc. and Lyle Bell by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc. (Attachments: # 1 Tabs 1-2)(Louden, Karen) (Entered: 03/10/2008)

03/13/2008 158 NOTICE OF SERVICE of Plaintiff IGT's Supplemental Disclosures Pursuant to Fed. R. Civ. P. 26(e)(1) by IGT.(Wade, William) (Entered: 03/13/2008)

03/26/2008 159 NOTICE OF SERVICE of Plaintiff IGT's Responses and Objections to Bally's Second Set of Requests for Production of Documents and Things to Defendants (Nos. 85-114) and Plaintiff IGT's First Responses and Objections to Bally's Third Set of Interrogatories to IGT (Nos. 13-18) re 155 Notice of Service, by IGT. Related document: 155 Notice of Service, filed by Bally Gaming Inc., Bally Gaming International Inc., Bally Technologies Inc..(Gaza, Anne) (Entered: 03/26/2008)

04/14/2008 160 STIPULATION revising Scheduling Order re 151 Stipulation, 125 Scheduling Order,,, by IGT. (Gaza, Anne) (Entered: 04/14/2008)

04/16/2008 161 NOTICE OF SERVICE of Bally's Supplemental Rule 26 Disclosure Statement by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc..(Louden, Karen) (Entered: 04/16/2008)

04/17/2008 -- SO ORDERED- re 160 Stipulation Amending Scheduling Order Deadlines; Discovery due by 4/18/2008.,Expert discovery due 6/18/2008.,Expert Reports due 4/30/2008., Rebuttal Expert Reports due 5/28/2008., Motions in limine due 6/30/2008.,Dispositive Motions due by 6/30/2008., Answering Briefs due 7/21/2008., Reply Briefs due 8/1/2008.,Claim Construction due 5/28/2008., Claims Construction Opening Briefs due by 6/30/2008., Response briefs due 7/21/2008. (See order for details) Signed by Judge Sue L. Robinson on 04/17/08. (lid) (Entered: 04/17/2008)

05/12/2008 162 NOTICE OF SERVICE of Expert Report of Dr. John P. J. Kelly by IGT.(Gaza, Anne) (Entered: 05/12/2008)

05/12/2008 163 NOTICE OF SERVICE of Expert Report of Bart A. Lewin by IGT.(Gaza, Anne) (Entered: 05/12/2008)

05/12/2008 164 NOTICE OF SERVICE of Expert Report Of Dwight Crevelt by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc..(Louden, Karen) (Entered: 05/12/2008)

05/16/2008 165 STIPULATION to remove all claims, defenses and counterclaims related to certain patents pleaded in this action by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Blumenfeld, Jack) (Entered: 05/16/2008)

05/20/2008 -- SO ORDERED, re 165 Stipulation dismissing all claims with prejudice, defenses, and counterclaims related to U.S. Patent NO. 6,607,441. Signed by Judge Sue L. Robinson on 05/20/2008. (lid) (Entered: 05/20/2008)

05/20/2008 166 Report to the Commissioner of Patents and Trademarks for Patent/Trademark Number(s) US 6,607,441 B1; (lid) (Entered: 05/21/2008)

05/28/2008 167 CLAIM Construction Chart by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 05/28/2008)

06/02/2008 -- Set/Reset Scheduling Order Deadlines: Pretrial Conference set for 4/29/2009 04:30 PM in Courtroom 6B before Judge Sue L. Robinson. Oral Argument set for 1/16/2009 01:30 PM in Courtroom 6B before Judge Sue L. Robinson. Two Week Jury Trial set for 5/26/2009 09:30 AM in Courtroom 6B before Judge Sue L. Robinson. (nmf) Modified on 6/2/2008 (nmf). (Entered: 06/02/2008)

06/02/2008 -- Set/Reset Hearings: Pretrial Conference set for 4/29/2009 04:30 PM in Courtroom 6B before Judge Sue L. Robinson. (nmf) (Entered: 06/02/2008)

06/02/2008 -- CORRECTING ENTRY: The text scheduling the pretrial conference was modified to reflect that it will be taking place on 4/29/2009. (nmf) (Entered: 06/02/2008)

06/16/2008 168 MOTION for Extension of Time to extend dates of Amended Scheduling Order - filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 06/16/2008)

06/19/2008 -- SO ORDERED- re 168 MOTION to Amended Scheduling Order deadlines; Claim Construction opening briefs due by 9/26/2008. Expert discovery due 08/01/2008., Rebuttal Expert Reports due 06/18/2008., DAUBERT MOTIONS due 09/26/2008., Dispositive Motions due by 9/26/2008., Answering Brief due 10/28/2008., Reply Brief due 11/19/2008.) Signed by Judge Sue L. Robinson on 06/18/2008. (lid) (Entered: 06/19/2008)

06/19/2008 169 NOTICE OF SERVICE of Expert Reports of Neil Spencer and David G. Schwartz, Ph.D. by IGT.(Gaza, Anne) (Entered: 06/19/2008)

06/19/2008 170 NOTICE OF SERVICE of Rebuttal Expert Report Of Dwight Crevelt by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc..(Louden, Karen) (Entered: 06/19/2008)

06/20/2008 -- CORRECTING ENTRY: Per request of counsel text of SO ORDER on 6/19/2008 changed to reflect the language used to describe Motions in limine to Daubert Motions. For further clarification of dates specified in Stipulation please refer to Stipulation D.I. 168. (lid) Modified on 6/20/2008 (lid). (Entered: 06/20/2008)

07/03/2008 171 CLAIM Construction Chart by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 07/03/2008)

07/15/2008 172 Joint STIPULATION to File Bally's Amended Answer, Affirmative Defenses and Counterclaims by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibit A)(Louden, Karen) (Entered: 07/15/2008)

07/17/2008 -- SO ORDERED- re 172 Stipulation to File Bally's Amended Answer, Affirmative Defenses and Counterclaims. Signed by Judge Sue L. Robinson on 07/17/2008. (lid) (Entered: 07/17/2008)

07/17/2008 173 AMENDED ANSWER to Complaint with COUNTERCLAIM Bally's Amended Answer, Affirmative Defenses, and Counterclaims against Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc. by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) Modified on 7/17/2008 (lid). (Entered: 07/17/2008)

07/17/2008 -- CORRECTING ENTRY: Pursuant to request of counsel text of Amended Answer(D.I. 173) has been modified. (lid) (Entered: 07/17/2008)

07/31/2008 174 ANSWER to 173 Amended Answer to Complaint, Counterclaim,, Plaintiff IGT's Reply to Bally's Counterclaims As Set Forth In Bally's Amended Answer, Affirmative Defenses, and Counterclaims by IGT.(Gaza, Anne) (Entered: 07/31/2008)

09/16/2008 175 Joint STIPULATION And Order Amending Scheduling Order by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 09/16/2008)

- 09/18/2008 -- SO ORDERED- re 175 Stipulation Amending Scheduling Order.ORDER- Setting Scheduling Order Deadlines (Claims Construction Opening Brief due by 10/14/2008., Expert Discovery due by 9/23/2008., Dispositive Motions due by 10/14/2008., Answering Brief due 11/11/2008., Reply Brief due 12/5/2008., Daubert Motions due by 10/14/2008.). Signed by Judge Sue L. Robinson on 09/18/2008. (lid) (Entered: 09/18/2008)
- 10/07/2008 176 STIPULATION TO EXTEND TIME to amend Amended Scheduling Order to see stipulation for details - filed by Bally Gaming International Inc.(a Delaware corporation), Bally Technologies Inc.(a Nevada corporation), Bally Gaming Inc.(a Nevada corporation). (Louden, Karen) (Entered: 10/07/2008)
- 10/08/2008 -- SO ORDERED- re 176 STIPULATION TO Amend Scheduling Order. ORDER- Setting Scheduling Order Deadlines (Claims Construction Opening Brief due by 10/21/2008., Dispositive Motions due by 10/21/2008., Answering Brief due 11/18/2008., Reply Brief due 12/12/2008., Daubert Motions due by 10/21/2008.) (SEE STIPULATION FOR FURTHER DETAILS). Signed by Judge Sue L. Robinson on 10/8/2008. (lid) (Entered: 10/08/2008)
- 10/20/2008 177 Joint STIPULATION TO EXTEND TIME to file Daubert motions, and opening summary judgment and claim construction briefs to October 23, 2008 - filed by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 10/20/2008)
- 10/23/2008 -- SO ORDERED- re 177 Joint STIPULATION TO EXTEND TIME. ORDER- Setting Scheduling Order Deadlines (Claims Construction Opening Brief due by 10/23/2008., Dispositive Motions due by 10/23/2008., Motions in Limine due by 10/23/2008.). Signed by Judge Sue L. Robinson on 10/23/2008. (lid) (Entered: 10/23/2008)
- 10/23/2008 178 MOTION for Summary Judgment No. 1: Infringement - filed by IGT. (Attachments: # 1 Text of Proposed Order)(Wade, William) (Entered: 10/23/2008)
- 10/23/2008 179 SEALED OPENING BRIEF in Support re 178 MOTION for Summary Judgment No. 1: Infringement filed by IGT. Answering Brief/Response due date per Local Rules is 11/10/2008. (Wade, William) (Entered: 10/23/2008)
- 10/23/2008 180 MOTION for Summary Judgment No. 2: Validity of U.S. Patent Numbers RE37,885 and RE38,812 - filed by IGT. (Attachments: # 1 Text of Proposed Order)(Wade, William) (Entered: 10/23/2008)
- 10/23/2008 181 SEALED OPENING BRIEF in Support re 180 MOTION for Summary Judgment No. 2: Validity of U.S. Patent Numbers RE37,885 and RE38,812 filed by IGT. Answering Brief/Response due date per Local Rules is 11/10/2008. (Wade, William) (Entered: 10/23/2008)
- 10/23/2008 182 MOTION for Summary Judgment No. 3: No Licensing Defense - filed by IGT. (Attachments: # 1 Text of Proposed Order)(Wade, William) (Entered: 10/23/2008)
- 10/23/2008 183 SEALED OPENING BRIEF in Support re 182 MOTION for Summary Judgment No. 3: No Licensing Defense filed by IGT. Answering Brief/Response due date per Local Rules is 11/10/2008. (Wade, William) (Entered: 10/23/2008)
- 10/23/2008 184 SEALED CLAIM CONSTRUCTION OPENING BRIEF filed by IGT. (Wade, William) (Entered: 10/23/2008)
- 10/23/2008 185 SEALED DECLARATION re 180 MOTION for Summary Judgment No. 2: Validity of U.S. Patent Numbers RE37,885 and RE38,812 , 182 MOTION for Summary Judgment No. 3: No Licensing Defense , 184 Claim Construction Opening Brief, 178 MOTION for Summary Judgment No. 1: Infringement (DECLARATION OF NEIL SPENCER IN SUPPORT OF IGT'S MOTIONS FOR SUMMARY JUDGMENT AND OPENING CLAIM CONSTRUCTION BRIEF) by IGT. (Wade, William) (Entered: 10/23/2008)
- 10/23/2008 186 SEALED DECLARATION re 178 MOTION for Summary Judgment No. 1: Infringement (DECLARATION OF BART A. LEWIN IN SUPPORT OF IGT'S MOTION FOR SUMMARY JUDGMENT NO. 1: INFRINGEMENT) by IGT. (Wade, William) (Entered: 10/23/2008)
- 10/23/2008 187 SEALED DECLARATION re 178 MOTION for Summary Judgment No. 1: Infringement (DECLARATION OF DR. JOHN P. J. KELLY IN SUPPORT OF IGT'S MOTION FOR SUMMARY JUDGMENT NO. 1: INFRINGEMENT) by IGT. (Wade, William) (Entered: 10/23/2008)
- 10/23/2008 188 SEALED DECLARATION re 180 MOTION for Summary Judgment No. 2: Validity of U.S. Patent Numbers RE37,885 and RE38,812 , 182 MOTION for Summary Judgment No. 3: No Licensing Defense , 184 Claim Construction Opening Brief, 178 MOTION for Summary Judgment No. 1: Infringement (DECLARATION OF DAVID P. DALKE IN SUPPORT OF IGT'S MOTIONS FOR SUMMARY JUDGMENT (NOS. 1 - 3) AND OPENING CLAIM CONSTRUCTION BRIEF) by IGT. (Wade, William) (Entered: 10/23/2008)
- 10/23/2008 189 SEALED OPENING BRIEF in Support re 182 MOTION for Summary Judgment No. 3: No Licensing Defense PLAINTIFF IGT'S CORRECTED MEMORANDUM IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT NO. 3: NO LICENSE DEFENSE filed by IGT. Answering Brief/Response due date per Local Rules is 11/10/2008. (Gaza, Anne) (Entered: 10/23/2008)
- 10/23/2008 190 CLAIM CONSTRUCTION OPENING BRIEF filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Blumenfeld, Jack) (lid). (Additional attachment(s) added on 12/30/2008: # 1 amended claim construction) (lid). (Entered: 10/23/2008)

- 10/23/2008 191 MOTION for Summary Judgment of Noninfringement - filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Blumenfeld, Jack) (Entered: 10/23/2008)
- 10/23/2008 192 SEALED OPENING BRIEF in Support re 191 MOTION for Summary Judgment of Noninfringement filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. Answering Brief/Response due date per Local Rules is 11/10/2008. (Blumenfeld, Jack) (Entered: 10/23/2008)
- 10/23/2008 193 MOTION for Summary Judgment of Invalidity of U.S. Patent No. 6,431,983 - filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Blumenfeld, Jack) (Entered: 10/23/2008)
- 10/23/2008 194 SEALED OPENING BRIEF in Support re 193 MOTION for Summary Judgment of Invalidity of U.S. Patent No. 6,431,983 filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. Answering Brief/Response due date per Local Rules is 11/10/2008. (Blumenfeld, Jack) (Entered: 10/23/2008)
- 10/23/2008 195 SEALED DECLARATION re 190 Claim Construction Opening Brief, 191 MOTION for Summary Judgment of Noninfringement , 193.MOTION for Summary Judgment of Invalidity of U.S. Patent No. 6,431,983 of Alexander Rudis by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibits 1 through 25)(Blumenfeld, Jack) (Entered: 10/23/2008)
- 10/23/2008 196 SEALED DECLARATION re 190 Claim Construction Opening Brief, 191 MOTION for Summary Judgment of Noninfringement , 193 MOTION for Summary Judgment of Invalidity of U.S. Patent No. 6,431,983 of Dwight Crevelt by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibits 1 through 4)(Blumenfeld, Jack) (Entered: 10/23/2008)
- 10/30/2008 197 REDACTED VERSION of 184 Claim Construction Opening Brief by IGT. (Gaza, Anne) (Entered: 10/30/2008)
- 10/30/2008 198 REDACTED VERSION of 181 Opening Brief in Support OF ITS MOTION FOR SUMMARY JUDGMENT NO. 2: VALIDITY OF U.S. PATENT NUMBERS RE37,885 AND RE38,812 by IGT. (Gaza, Anne) (Entered: 10/30/2008)
- 10/30/2008 199 REDACTED VERSION of 179 Opening Brief in Support OF ITS MOTION FOR SUMMARY JUDGMENT NO. 1: INFRINGEMENT by IGT. (Gaza, Anne) (Entered: 10/30/2008)
- 10/30/2008 200 REDACTED VERSION of 189 Opening Brief in Support, PLAINTIFF IGT'S CORRECTED MEMORANDUM IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT NO. 3: NO LICENSE DEFENSE by IGT. (Gaza, Anne) (Entered: 10/30/2008)
- 10/30/2008 201 REDACTED VERSION of 186 Declaration OF BART A. LEWIN by IGT. (Gaza, Anne) (Entered: 10/30/2008)
- 10/30/2008 202 REDACTED VERSION of 185 Declaration, OF NEIL SPENCER by IGT. (Attachments: # 1 Exhibit A)(Gaza, Anne) (Entered: 10/30/2008)
- 10/30/2008 203 REDACTED VERSION of 187 Declaration OF DR. JOHN P. J. KELLY by IGT. (Attachments: # 1 Exhibit A, # 2 Exhibit B, # 3 Exhibit C, # 4 Exhibit D, # 5 Exhibit E, # 6 Exhibit F, # 7 Exhibit G)(Gaza, Anne) (Entered: 10/30/2008)
- 10/30/2008 204 REDACTED VERSION of 188 Declaration, OF DAVID P. DALKE by IGT. (Attachments: # 1 Exhibit 1, # 2 Exhibit 2, # 3 Exhibit 3, # 4 Exhibit 4, # 5 Exhibit 5, # 6 Exhibit 6, # 7 Exhibit 7, # 8 Exhibit 8 - 9, # 9 Exhibit 10, # 10 Exhibit 11 -25, # 11 Exhibit 26, # 12 Exhibit 27 -40, # 13 Exhibit 41, # 14 Exhibit 42, # 15 Exhibit 43 - 58, # 16 Exhibit 59, # 17 Exhibit 60, # 18 Exhibit 61, # 19 Exhibit 62, # 20 Exhibit 63 - 66, # 21 Exhibit 67, # 22 Exhibit 68 - 71, # 23 Exhibit 72, # 24 Exhibit 73, # 25 Exhibit 74, # 26 Exhibit 75 - Part 1, # 27 Exhibit 75 - Part 2, # 28 Exhibit 75 - Part 3, # 29 Exhibit 75 - Part 4, # 30 Exhibit 76, # 31 Exhibit 77, # 32 Exhibit 78, # 33 Exhibit 79, # 34 Exhibit 80, # 35 Exhibit 81, # 36 Exhibit 82, # 37 Exhibit 83)(Gaza, Anne) (Entered: 10/30/2008)
- 10/30/2008 205 REDACTED VERSION of 192 Opening Brief in Support, of Motion for Summary Judgment of Noninfringement by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 10/30/2008)
- 10/30/2008 206 REDACTED VERSION of 194 Opening Brief in Support, of Motion for Summary Judgment of Invalidity of '983 Patent by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 10/30/2008)
- 10/30/2008 207 REDACTED VERSION of 196 Declaration, of Dwight Crevelt by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibits 1-4)(Louden, Karen) (Entered: 10/30/2008)
- 10/30/2008 208 REDACTED VERSION of 195 Declaration, of Alexander Rudis by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibits 1-3, # 2 Exhibit 4, # 3 Exhibit 5, # 4 Exhibit 6, # 5 Exhibits 7-10, # 6 Exhibits 11-12, # 7 Exhibits 13-14, # 8 Exhibits 15-25)(Louden, Karen) (Entered: 10/30/2008)
- 11/14/2008 209 STIPULATION regarding removal of defenses relating to certain patents pleaded in this action by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 11/14/2008)

- 11/14/2008 210 STIPULATION TO EXTEND TIME to file answering summary judgment and claim construction briefs and to file reply summary judgment briefs to November 25, 2008 and December 16, 2008, respectively - filed by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 11/14/2008)
- 11/18/2008 -- SO ORDERED- re 209 Stipulation regarding removal of defenses relating to certain patents. Signed by Judge Sue L. Robinson on 11/18/2008. (lid) (Entered: 11/18/2008)
- 11/18/2008 211 SO ORDERED- re 210 STIPULATION TO EXTEND TIME. ORDER, Setting Scheduling Order Deadlines (Claims Construction Opening Brief due by 11/25/2008., Dispositive Motion Answering Brief due 11/25/2008., Dispositive Motion Reply Brief due 12/16/2008.)(ANY FURTHER EXTENSIONS SHALL RESULT IN LOSS OF THE SCHEDULED TRIAL DATE.). Signed by Judge Sue L. Robinson on 11/18/2008. (lid) (Entered: 11/18/2008)
- 11/25/2008 212 SEALED CLAIM CONSTRUCTION ANSWERING BRIEF re 190 Claim Construction Opening Brief filed by IGT. (Wade, William) (Entered: 11/25/2008)
- 11/25/2008 213 SEALED ANSWERING BRIEF in Opposition re 191 MOTION for Summary Judgment of Noninfringement filed by IGT.Reply Brief due date per Local Rules is 12/8/2008. (Wade, William) (Entered: 11/25/2008)
- 11/25/2008 214 SEALED ANSWERING BRIEF in Opposition re 193 MOTION for Summary Judgment of Invalidity of U.S. Patent No. 6,431,983 filed by IGT.Reply Brief due date per Local Rules is 12/8/2008. (Wade, William) (Entered: 11/25/2008)
- 11/25/2008 215 SEALED DECLARATION re 214 Answering Brief in Opposition, 213 Answering Brief in Opposition (DECLARATION OF DAVID G. SCHWARTZ, PH.D. IN SUPPORT OF IGT'S MOTIONS FOR SUMMARY JUDGMENT) by IGT. (Wade, William) (Entered: 11/25/2008)
- 11/25/2008 216 SEALED DECLARATION re 212 Claim Construction Answering Brief, 214 Answering Brief in Opposition, 213 Answering Brief in Opposition (SUPPLEMENTAL DECLARATION OF DAVID P. DALKE IN SUPPORT OF IGT'S OPPOSITIONS TO BALLY'S MOTIONS FOR SUMMARY JUDGMENT AND ANSWERING CLAIM CONSTRUCTION BRIEF) by IGT. (Wade, William) (Entered: 11/25/2008)
- 11/25/2008 217 CLAIM CONSTRUCTION ANSWERING BRIEF re 184 Claim Construction Opening Brief filed by Bally Gaming International Inc., Bally Gaming Inc.. (Louden, Karen) (Additional attachment(s) added on 12/30/2008: # 1 amended claim construction) (lid). (Entered: 11/25/2008)
- 11/25/2008 218 SEALED ANSWERING BRIEF in Opposition re 178 MOTION for Summary Judgment No. 1: Infringement filed by Bally Gaming International Inc., Bally Gaming Inc..Reply Brief due date per Local Rules is 12/8/2008. (Louden, Karen) (Entered: 11/25/2008)
- 11/25/2008 219 MOTION for Summary Judgment of Invalidity of the Asserted Claims in U.S. Patents RE37,885 and RE38,812 - filed by Bally Gaming International Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 11/25/2008)
- 11/25/2008 220 BRIEF (Combined Opening and Answering) SEALED re 219 MOTION for Summary Judgment of Invalidity of the Asserted Claims in U.S. Patents RE37,885 and RE38,812 , 180 MOTION for Summary Judgment No. 2: Validity of U.S. Patent Numbers RE37,885 and RE38,812 filed by Bally Gaming International Inc., Bally Gaming Inc..Answering Brief/Response due date per Local Rules is 12/15/2008. Reply Brief due date per Local Rules is 12/8/2008. (Louden, Karen) (Entered: 11/25/2008)
- 11/25/2008 221 MOTION for Summary Judgment that Bally has a Valid License Defense to the '983 Patent - filed by Bally Gaming International Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 11/25/2008)
- 11/25/2008 222 BRIEF (Combined Opening and Answering) SEALED re 221 MOTION for Summary Judgment that Bally has a Valid License Defense to the '983 Patent , 182 MOTION for Summary Judgment No. 3: No Licensing Defense filed by Bally Gaming International Inc., Bally Gaming Inc..Answering Brief/Response due date per Local Rules is 12/15/2008. Reply Brief due date per Local Rules is 12/8/2008. (Louden, Karen) (Entered: 11/25/2008)
- 11/25/2008 223 SEALED DECLARATION re 221 MOTION for Summary Judgment that Bally has a Valid License Defense to the '983 Patent , 219 MOTION for Summary Judgment of Invalidity of the Asserted Claims in U.S. Patents RE37,885 and RE38,812 , 220 Brief (Combined Opening and Answering), Brief (Combined Opening and Answering), 218 Answering Brief in Opposition, 217 Claim Construction Answering Brief, 222 Brief (Combined Opening and Answering), Brief (Combined Opening and Answering) Declaration of Dwight Crevelt by Bally Gaming International Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibits 5-9)(Louden, Karen) (Entered: 11/25/2008)
- 11/25/2008 224 SEALED DECLARATION re 221 MOTION for Summary Judgment that Bally has a Valid License Defense to the '983 Patent , 219 MOTION for Summary Judgment of Invalidity of the Asserted Claims in U.S. Patents RE37,885 and RE38,812 , 220 Brief (Combined Opening and Answering), Brief (Combined Opening and Answering), 218 Answering Brief in Opposition, 217 Claim Construction Answering Brief, 222 Brief (Combined Opening and Answering), Brief (Combined Opening and Answering) Declaration of Alexander Rudis by Bally Gaming International Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibits 26-50)(Louden, Karen) (Entered: 11/25/2008)

- 12/03/2008 225 CLAIM Construction Chart by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Blumenfeld, Jack) (Entered: 12/03/2008)
- 12/04/2008 226 REDACTED VERSION of 213 Answering Brief in Opposition by IGT. (Gaza, Anne) (Entered: 12/04/2008)
- 12/04/2008 227 REDACTED VERSION of 212 Claim Construction Answering Brief by IGT. (Gaza, Anne) (Entered: 12/04/2008)
- 12/04/2008 228 REDACTED VERSION of 214 Answering Brief in Opposition by IGT. (Gaza, Anne) (Entered: 12/04/2008)
- 12/04/2008 229 REDACTED VERSION of 215 Declaration of David G. Schwartz, PH.D. by IGT. (Attachments: # 1 Exhibit A, # 2 Exhibit B - E, # 3 Exhibit F - G, # 4 Certificate of Compliance H)(Gaza, Anne) (Entered: 12/04/2008)
- 12/04/2008 230 REDACTED VERSION of 216 Declaration, of David P. Dalke by IGT. (Attachments: # 1 Exhibit 84 - 87, # 2 Exhibit 88 - 90, # 3 Exhibit 91 - 93, # 4 Exhibit 94 - 98, # 5 Exhibit 99 - 100, # 6 Exhibit 101 - Part 1, # 7 Exhibit 101 - Part 2, # 8 Exhibit 102, # 9 Exhibit 103 - Part 1, # 10 Exhibit 103 - Part 2, # 11 Exhibit 104 - Part 1, # 12 Exhibit 104 - Part 2, # 13 Exhibit 104 - Part 3, # 14 Exhibit 105 - Part 1, # 15 Exhibit 105 - Part 2, # 16 Exhibit 105 - Part 3, # 17 Exhibit 105 - Part 4, # 18 Exhibit 105 - Part 5, # 19 Exhibit 106, # 20 Exhibit 107 - 108, # 21 Exhibit 109 - 110)(Gaza, Anne) (Additional attachment(s) added on 12/8/2008: # 22 Exhibit 111) (rw). (Entered: 12/04/2008)
- 12/04/2008 231 REDACTED VERSION of 218 Answering Brief in Opposition to IGT's Motion for Summary Judgment No. 1: Infringement by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 12/04/2008)
- 12/04/2008 232 REDACTED VERSION of 220 Brief (Combined Opening and Answering), Brief (Combined Opening and Answering) in Opposition to IGT's Motion for Summary Judgment No. 2: Validity of U.S. Patents RE37,885 and RE38,812 and in Support of Cross-Motion for Summary Judgment of Invalidity of the Asserted Claims in U.S. Patents RE37,885 and RE38,812 by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 12/04/2008)
- 12/04/2008 233 REDACTED VERSION of 222 Brief (Combined Opening and Answering), Brief (Combined Opening and Answering) in Opposition to IGT's Motion for Summary Judgment of No License Defense and in Support of Cross-Motion for Summary Judgment That It Has Valid License Defense to the '983 Patent by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 12/04/2008)
- 12/04/2008 234 REDACTED VERSION of 223 Declaration,, of Dwight Crevett by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibits 5-9)(Louden, Karen) (Entered: 12/04/2008)
- 12/04/2008 235 REDACTED VERSION of 224 Declaration,, of Alexander Rudis by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibits 26-29 (Part 1), # 2 Exhibit 29 (Part 2), # 3 Exhibits 30-40, # 4 Exhibits 41-43, # 5 Exhibits 44-50)(Louden, Karen) (Entered: 12/04/2008)
- 12/05/2008 236 SEALED Letter to The Honorable Sue L. Robinson from Anne Shea Gaza regarding Joint Appendix. (Gaza, Anne) (Entered: 12/05/2008)
- 12/05/2008 237 SEALED APPENDIX re 212 Claim Construction Answering Brief, 190 Claim Construction Opening Brief, 192 Opening Brief in Support, 189 Opening Brief in Support, 220 Brief (Combined Opening and Answering), Brief (Combined Opening and Answering), 214 Answering Brief in Opposition, 184 Claim Construction Opening Brief, 181 Opening Brief in Support, 194 Opening Brief in Support, 213 Answering Brief in Opposition, 218 Answering Brief in Opposition, 217 Claim Construction Answering Brief, 183 Opening Brief in Support, 222 Brief (Combined Opening and Answering), Brief (Combined Opening and Answering), 179 Opening Brief in Support (JOINT APPENDIX TO BRIEFS FOR SUMMARY JUDGMENT AND CLAIM CONSTRUCTION) by IGT, Bally Gaming Inc.. (Gaza, Anne) (Entered: 12/05/2008)
- 12/08/2008 -- CORRECTING ENTRY: added Exhibit 111 to DI# 230. (rw) (Entered: 12/08/2008)
- 12/11/2008 -- CORRECTING ENTRY:Docket clerk deleted NOTICE OF CONVENTIONAL FILING due to improper event code being used during filing of document. Counsel is advised to re-file document using the REDACTED DOCUMENT event code. Counsel is also advised that it is not necessary to send a copy of the redacted documents to the court. (lid) (Entered: 12/11/2008)
- 12/11/2008 238 REDACTED VERSION of 237 Appendix,, by IGT. (Attachments: # 1 Appendix JA00001-00057, # 2 Appendix JA00058-JA00137, # 3 Appendix JA00138-JA00268, # 4 Appendix JA00269-JA00392, # 5 Appendix JA00393-JA00402, # 6 Appendix JA00403-JA00460, # 7 Appendix JA00461-JA00537, # 8 Appendix JA00538-JA00650, # 9 Appendix JA00651-JA00662, # 10 Appendix JA00663-JA00741, # 11 Appendix JA00742-JA00833, # 12 Appendix JA00834-JA00934, # 13 Appendix JA00935-JA01053, # 14 Appendix JA01056-JA01155, # 15 Appendix JA01156-JA01253, # 16 Appendix JA01254-JA01277, # 17 Appendix JA01278-JA01366, # 18 Appendix JA01367-JA01384, # 19 Appendix JA01385-JA01497, # 20 Appendix JA01498-JA01579, # 21 Appendix JA01580-JA01593, # 22 Appendix JA01594-JA01652, # 23 Appendix JA01653-JA01712, # 24 Appendix JA01713-JA01770, # 25 Appendix JA01771, # 26 Appendix JA01772-JA01773, # 27 Appendix JA01774-JA01783, # 28 Appendix JA01784-JA01956, # 29

Appendix JA01957-JA01958, # 30 Appendix JA01959-JA02430, # 31 Appendix JA02431-JA02445, # 32 Appendix JA02446-JA02949, # 33 Appendix JA02950-JA03000, # 34 Appendix JA03001-JA03023, # 35 Appendix JA03024-JA03041, # 36 Appendix JA03042-JA03046, # 37 Appendix JA03047-JA03642, # 38 Appendix JA03643-JA03648, # 39 Appendix JA03649-JA03668, # 40 Appendix JA03669-JA03677, # 41 Appendix JA03678-JA03704, # 42 Appendix JA03705-JA04021, # 43 Appendix JA04022-JA04045, # 44 Appendix JA04046-JA04068, # 45 Appendix JA04069-JA04070, # 46 Appendix JA04071-JA04075, # 47 Appendix JA04076, # 48 Appendix JA04077-JA04081, # 49 Appendix JA04082-JA04086, # 50 Appendix JA04087-JA04091, # 51 Appendix JA04092-JA04093, # 52 Appendix JA04094-JA04097, # 53 Appendix JA04098-JA04100, # 54 Appendix JA04101-JA04103, # 55 Appendix JA04104-JA04106, # 56 Appendix JA04107-JA04109, # 57 Appendix JA04110-JA04114, # 58 Appendix JA04115-JA04116, # 59 Appendix JA04117-JA04118, # 60 Appendix JA04119-JA04121, # 61 Appendix JA04122-JA04179, # 62 Appendix JA04180-JA04210, # 63 Appendix JA04211-JA04240, # 64 Appendix JA04241-JA04279, # 65 Appendix JA04280-JA04295, # 66 Appendix JA04296-JA04451, # 67 Appendix JA04452-JA04585, # 68 Appendix JA04586-JA04597, # 69 Appendix JA04598-JA04612, # 70 Appendix JA04613-JA04644, # 71 Appendix JA04645-JA04665, # 72 Appendix JA04666-JA04681, # 73 Appendix JA04682-JA04684, # 74 Appendix JA04685-JA04844, # 75 Appendix JA04845, # 76 Appendix JA04846-JA04850, # 77 Appendix JA04851-JA04855, # 78 Appendix JA04856-JA04857, # 79 Appendix JA04858-JA04893, # 80 Appendix JA04894-JA04920, # 81 Appendix JA04921-JA04958, # 82 Appendix JA04959-JA04982, # 83 Appendix JA04983-JA05020, # 84 Appendix JA05021-JA05035, # 85 Appendix JA05036-JA05044, # 86 Appendix JA05045-JA05128, # 87 Appendix JA05129-JA05138, # 88 Appendix JA05139, # 89 Appendix JA05140-JA05178, # 90 Appendix JA05179-JA05215, # 91 Appendix JA05216-JA05254, # 92 Appendix JA05255-JA05263, # 93 Appendix JA05264-JA05278, # 94 Appendix JA05279-JA05282)(Gaza, Anne) (Entered: 12/11/2008)

- 12/16/2008 239 SEALED REPLY BRIEF re 178 MOTION for Summary Judgment No. 1: Infringement filed by IGT. (Gaza, Anne) (Entered: 12/16/2008)
- 12/16/2008 240 BRIEF (Combined Answering and Reply) (CONFIDENTIAL--FILED UNDER SEAL) re 219 MOTION for Summary Judgment of Invalidity of the Asserted Claims in U.S. Patent RE37,885 and RE38,812, 180 MOTION for Summary Judgment No. 2: Validity of U.S. Patent Numbers RE37,885 and RE38,812 filed by IGT.Reply Brief due date per Local Rules is 12/29/2008. (Gaza, Anne) (Entered: 12/16/2008)
- 12/16/2008 241 SEALED REPLY BRIEF re 182 MOTION for Summary Judgment No. 3: No Licensing Defense filed by IGT. (Gaza, Anne) (Entered: 12/16/2008)
- 12/16/2008 242 SEALED DECLARATION re 241 Reply Brief, 239 Reply Brief, 240 Brief (Combined Answering and Reply), Brief (Combined Answering and Reply) (SECOND SUPPLEMENTAL DECLARATION OF DAVID P. DALKE IN SUPPORT OF IGT'S REPLY BRIEFS IN SUPPORT OF ITS MOTIONS FOR SUMMARY JUDGMENT NOS. 1-3) by IGT. (Gaza, Anne) (Entered: 12/16/2008)
- 12/16/2008 243 SEALED REPLY BRIEF re 191 MOTION for Summary Judgment of Noninfringement filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 12/16/2008)
- 12/16/2008 244 SEALED REPLY BRIEF re 193 MOTION for Summary Judgment of Invalidity of U.S. Patent No. 6,431,983 filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 12/16/2008)
- 12/16/2008 245 SEALED DECLARATION re 244 Reply Brief, 243 Reply Brief of Alexander Rudis in Support of Bally's Reply Briefs in Support of Bally's Motions for Summary Judgment by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibits 51 through 58)(Louden, Karen) (Entered: 12/16/2008)
- 12/23/2008 246 REDACTED VERSION of 239 Reply Brief (No. 1: Infringement) by IGT. (Gaza, Anne) (Entered: 12/23/2008)
- 12/23/2008 247 REDACTED VERSION of 240 Brief (Combined Answering and Reply), Brief (Combined Answering and Reply) by IGT. (Gaza, Anne) (Entered: 12/23/2008)
- 12/23/2008 248 REDACTED VERSION of 241 Reply Brief (No. 3) by IGT. (Gaza, Anne) (Entered: 12/23/2008)
- 12/23/2008 249 REDACTED VERSION of 242 Declaration, by IGT. (Attachments: # 1 Exhibit 112, # 2 Exhibit 113, # 3 Exhibit 114 - Part 1, # 4 Exhibit 114 - Part 2, # 5 Exhibit 115, # 6 Exhibit 116, # 7 Exhibit 117, # 8 Exhibit 118, # 9 Exhibit 119)(Gaza, Anne) (Entered: 12/23/2008)
- 12/23/2008 250 SEALED APPENDIX re 237 Appendix,, (SUPPLEMENTAL JOINT APPENDIX TO BRIEFS FOR SUMMARY JUDGMENT AND CLAIM CONSTRUCTION) by IGT. (Gaza, Anne) (Entered: 12/23/2008)
- 12/23/2008 251 REDACTED VERSION of 243 Reply Brief Redacted/Defendants' Reply Brief In Support Of Their Motion For Summary Judgment Of Noninfringement by Bally Gaming International Inc.(a Delaware corporation), Bally Technologies Inc.(a Nevada corporation), Bally Gaming Inc.(a Nevada corporation). (Louden, Karen) (Entered: 12/23/2008)
- 12/23/2008 252 REDACTED VERSION of 244 Reply Brief Redacted/Defendants' Corrected Reply Brief In Support Of Their Motion For Summary Judgment Of Invalidity Of U.S. Patent No. 6,431,983 by Bally Gaming International Inc.(a Delaware corporation), Bally Technologies Inc.(a Nevada corporation), Bally Gaming Inc.(a Nevada corporation). (Louden, Karen) (Entered: 12/23/2008)

- 12/23/2008 253 REDACTED VERSION of 245 Declaration, Redacted/Dedation Of Alexander Rudis In Support Of Bally's Reply Briefs In Support Of Bally's Motions For Summary Judgment by Bally Gaming International Inc.(a Delaware corporation), Bally Technologies Inc.(a Nevada corporation), Bally Gaming Inc.(a Nevada corporation). (Attachments: # 1 Exhibit 51-58)(Louden, Karen) (Entered: 12/23/2008)
- 12/30/2008 -- CORRECTING ENTRY: Pursuant to request of counsel the pdf versions of D.I. numbers 190 and 217 have been modified to include amended versions of the documents. (lid) (Entered: 12/30/2008)
- 01/05/2009 254 Letter to The Honorable Sue L. Robinson from Jack B. Blumenfeld regarding submitting a disk containing electronic versions of Bally's summary judgment and claim construction briefs with hyperlinks. (Blumenfeld, Jack) (Entered: 01/05/2009)
- 01/05/2009 255 AMENDED DOCUMENT by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. Amendment to 205 Redacted Document. (Louden, Karen) (Entered: 01/05/2009)
- 01/05/2009 256 AMENDED DOCUMENT by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. Amendment to 206 Redacted Document. (Louden, Karen) (Entered: 01/05/2009)
- 01/05/2009 257 AMENDED DOCUMENT by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. Amendment to 231 Redacted Document. (Louden, Karen) (Entered: 01/05/2009)
- 01/05/2009 258 AMENDED DOCUMENT by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. Amendment to 232 Redacted Document,. (Louden, Karen) (Entered: 01/05/2009)
- 01/05/2009 259 AMENDED DOCUMENT by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. Amendment to 233 Redacted Document,. (Louden, Karen) (Entered: 01/05/2009)
- 01/06/2009 260 REDACTED VERSION of 250 Appendix by IGT. (Attachments: # 1 Appendix Part II)(Gaza, Anne) (Entered: 01/06/2009)
- 01/07/2009 261 Letter to The Honorable Sue L. Robinson from Anne Shea Gaza regarding submission of disk. (Gaza, Anne) (Entered: 01/07/2009)
- 01/08/2009 262 AMENDED DOCUMENT by IGT. Amendment to 197 Redacted Document. (Gaza, Anne) (Entered: 01/08/2009)
- 01/08/2009 263 AMENDED DOCUMENT by IGT. Amendment to 199 Redacted Document. (Gaza, Anne) (Entered: 01/08/2009)
- 01/08/2009 264 AMENDED DOCUMENT by IGT. Amendment to 198 Redacted Document. (Gaza, Anne) (Entered: 01/08/2009)
- 01/08/2009 265 AMENDED DOCUMENT by IGT. Amendment to 200 Redacted Document. (Gaza, Anne) (Entered: 01/08/2009)
- 01/16/2009 -- Minute Entry for proceedings held before Judge Sue L. Robinson - Oral Argument held on 1/16/2009. (Court Reporter V. Gunning.) (nmf) Modified on 1/30/2009 (nmf). (Entered: 01/20/2009)
- 01/29/2009 266 MOTION for Pro Hac Vice Appearance of Attorney R. Tulloss Delk - filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 01/29/2009)
- 01/30/2009 267 Official Transcript of hearing held on January 16, 2009 before Judge Robinson. Court Reporter/Transcriber Valerie Gunning, Telephone number (302) 573-6194. Transcript may be viewed at the court public terminal or purchased through the Court Reporter/Transcriber before the deadline for Release of Transcript Restriction. After that date it may be obtained through PACER. Redaction Request due 2/20/2009. Redacted Transcript Deadline set for 3/2/2009. Release of Transcript Restriction set for 4/30/2009. (vjg) (Entered: 01/30/2009)
- 01/30/2009 -- CORRECTING ENTRY: The minute entry for the oral argument was modified to reflect the fact that it was held on January 16, 2009. (nmf) (Entered: 01/30/2009)
- 01/30/2009 268 MOTION for Pro Hac Vice Appearance of Attorney Matthew A. Moses, Michael L. Myers and Polaphat Veravanich - filed by IGT. (Gaza, Anne) (Entered: 01/30/2009)
- 02/04/2009 269 REDACTED VERSION of 236 Letter by IGT. (Attachments: # 1 Attachment to Letter)(Gaza, Anne) (Entered: 02/04/2009)
- 02/10/2009 -- SO ORDERED- re 268 MOTION for Pro Hac Vice Appearance of Attorney Matthew A. Moses, Michael L. Myers and Polaphat Veravanich, 266 MOTION for Pro Hac Vice Appearance of Attorney R. Tulloss Delk. Signed by Judge Sue L. Robinson on 2/9/2009. (lid) (Entered: 02/10/2009)
- 02/17/2009 270 MOTION for Pro Hac Vice Appearance of Attorney J.P. Cody - filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 02/17/2009)
- 02/23/2009 -- CORRECTING ENTRY: D.I. 271 was deleted per request of counsel. They will be filing a notice of service of the document shortly. (nmf) (Entered: 02/23/2009)
- 02/23/2009 271 NOTICE OF SERVICE of Plaintiff's List of Potential Fact Witnesses by IGT.(Gaza, Anne) (Entered: 02/23/2009)

- 02/23/2009 272 NOTICE OF SERVICE of List of Witnesses It May Call at Trial by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc..(Louden, Karen) (Entered: 02/23/2009)
- 02/24/2009 -- SO ORDERED- re 270 MOTION for Pro Hac Vice Appearance of Attorney J.P. Cody. Signed by Judge Sue L. Robinson on 2/23/2009. (lid) (Entered: 02/24/2009)
- 03/04/2009 273 Letter to The Honorable Sue L. Robinson from Jack B. Blumenfeld regarding claim construction agreement - re Oral Argument. (Blumenfeld, Jack) (Entered: 03/04/2009)
- 03/20/2009 274 NOTICE OF SERVICE of Plaintiff IGT's List of Potential Rebuttal Fact Witnesses by IGT.(Wade, William) (Entered: 03/20/2009)
- 03/20/2009 275 NOTICE OF SERVICE of Bally's Rebuttal Witness List by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc..(Louden, Karen) (Entered: 03/20/2009)
- 04/08/2009 276 Letter to The Honorable Sue L. Robinson from Jack B. Blumenfeld regarding Action Closing Prosecution of the Inter Parties Reexamination of the '983 Patent. (Attachments: # 1 Exhibit) (Blumenfeld, Jack) (Entered: 04/08/2009)
- 04/09/2009 277 Letter to The Honorable Sue L. Robinson from William J. Wade regarding Response to Bally's April 8, 2009 letter regarding Action Closing Prosecution of the Inter Parties Reexamination of the '983 Patent - re 276 Letter. (Wade, William) (Entered: 04/09/2009)
- 04/23/2009 279 Proposed Pretrial Order CONFIDENTIAL FILED UNDER SEAL - JOINT PRETRIAL ORDER by IGT. (Gaza, Anne) (Entered: 04/23/2009)
- 04/24/2009 280 MOTION for Extension of Time to file proposed jury instructions, voir dire, verdict forms - filed by Bally Gaming International Inc.(a Delaware corporation), Bally Technologies Inc.(a Nevada corporation), Bally Gaming Inc.(a Nevada corporation). (Louden, Karen) (Entered: 04/24/2009)
- 04/28/2009 281 MEMORANDUM OPINION. Signed by Judge Sue L. Robinson on 4/28/2009. (lid) (Entered: 04/28/2009)
- 04/28/2009 282 ORDER - denying 221 MOTION for Summary Judgment that Bally has a Valid License Defense to the '983 Patent , denying 219 MOTION for Summary Judgment of Invalidity of the Asserted Claims in U.S. Patents RE37,885 and RE38,812 , granting 180 MOTION for Summary Judgment No. 2: Validity of U.S. Patent Numbers RE37,885 and RE38,812 , granting in part and denying in part 182 MOTION for Summary Judgment No. 3: No Licensing Defense , granting in part and denying in part 191 MOTION for Summary Judgment of Noninfringement , granting in part and denying in part 178 MOTION for Summary Judgment No. 1: Infringement , denying 193 MOTION for Summary Judgment of Invalidity of U.S. Patent No. 6,431,983 . Signed by Judge Sue L. Robinson on 4/28/2009. (lid) (Entered: 04/28/2009)
- 04/28/2009 283 MEMORANDUM AND ORDER. Signed by Judge Sue L. Robinson on 4/28/2009. (lid) (Entered: 04/28/2009)
- 04/29/2009 -- SO ORDERED- re 280 MOTION for Extension of Time. ORDER- Setting Deadlines: (Proposed Jury Instructions, voir dire and verdict forms due by 5/1/2009.). Signed by Judge Sue L. Robinson on 4/28/2009. (lid) (Entered: 04/29/2009)
- 04/29/2009 -- CORRECTING ENTRY: Official Transcript docketed as D.I 278 on 4/20/2009 has been deleted due to having been filed in wrong case. (lid) (Entered: 04/29/2009)
- 04/29/2009 -- Minute Entry for proceedings held before Judge Sue L. Robinson - Pretrial Conference held on 4/29/2009. (Court Reporter V. Gunning.) (nmf) (Entered: 04/30/2009)
- 04/29/2009 -- SO ORDERED, re 279 Proposed Pretrial Order. (nmf) (Entered: 04/30/2009)
- 04/30/2009 284 Order Setting Teleconference: a teleconference has been scheduled for Monday, May 4, 2009 at 9:00 a.m. with Judge Thyng to discuss the status of the case and the parties interest in court-assisted ADR. Plaintiffs counsel shall initiate the teleconference call to 302-573-6173. Local counsel are reminded of their obligations to inform out-of-state counsel of this Order. To avoid the imposition of sanctions, counsel shall advise the Court immediately of any problems regarding compliance with this Order. Signed by Judge Mary Pat Thyng on 4/30/2009. (cak) (Entered: 04/30/2009)
- 04/30/2009 285 REDACTED VERSION of 279 Proposed Pretrial Order by IGT. (Attachments: # 1 Exhibit 1 - 13)(Gaza, Anne) (Entered: 04/30/2009)
- 05/04/2009 286 Order Setting Teleconference: A teleconference has been scheduled for 5/6/2009 at 4:30 PM Eastern Time with Judge Thyng to discuss ADR. Signed by Judge Mary Pat Thyng on 5/4/2009. (cak) (Entered: 05/04/2009)
- 05/05/2009 287 Joint STIPULATION TO EXTEND TIME for various submissions if parties are unable to resolve the disputed issues to May 8, 2009 - filed by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Blumenfeld, Jack) (Entered: 05/05/2009)
- 05/08/2009 -- Set/Reset Hearings: Jury Trial re-set per request of counsel to begin 6/1/2009 09:30 AM in Courtroom 6B before Judge Sue L. Robinson. (nmf) (Entered: 05/08/2009)
- 05/08/2009 -- SO ORDERED- re 287 Joint STIPULATION TO EXTEND TIME for various submissions if parties are unable to resolve the disputed issues. ORDER- Setting Scheduling Order Deadlines: Proposed Jury Instructions, voir dire and verdict sheet due by 5/8/2009 (REFER TO STIPULATION FOR FURTHER DETAILS). Signed by Judge Sue L. Robinson on 5/8/2009. (lid) (Entered: 05/08/2009)

- 05/08/2009 288 ORDER Setting Mediation Conferences: Mediation Conference set for 5/28/2009 at 10:00 AM in Courtroom 2B before Judge Mary Pat Thyng. See Order for details. Signed by Judge Mary Pat Thyng on 5/9/2009. (cak) (Entered: 05/08/2009)
- 05/08/2009 289 SEALED Letter to The Honorable Sue L. Robinson from Anne Shea Gaza regarding Plaintiff IGT's Letter to the Court Concerning Willfulness (HIGHLY CONFIDENTIAL -- FILED UNDER SEAL). (Gaza, Anne) (Entered: 05/08/2009)
- 05/08/2009 290 STIPULATION TO EXTEND TIME to file proposed jury instructions, voir dire and verdict forms to May 11, 2009 - filed by IGT. (Gaza, Anne) (Entered: 05/08/2009)
- 05/12/2009 -- SO ORDERED- re 290 STIPULATION TO EXTEND TIME. ORDER- Setting Deadlines: (Proposed Jury Instructions, voir dire, verdict forms due by 5/11/2009.). Signed by Judge Sue L. Robinson on 5/11/2009. (liid) (Entered: 05/12/2009)
- 05/13/2009 -- The Jury Trial has been cancelled and removed from the court's calendar per counsel's email of 5/11/09. (nmf) (Entered: 05/13/2009)
- 05/13/2009 291 Joint STIPULATION TO EXTEND TIME for defendants to submit their response to IGT's letter concerning willfulness to May 15, 2009 and for Bally's claim for a declaratory judgment of invalidity of the '983 patent be dismissed without prejudice - filed by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Louden, Karen) (Entered: 05/13/2009)
- 05/13/2009 292 REDACTED VERSION of 289 Letter by IGT. (Attachments: # 1 Exhibit 1 - 20)(Gaza, Anne) (Entered: 05/13/2009)
- 05/15/2009 -- SO ORDERED- re 291 Joint STIPULATION TO EXTEND TIME for defendants to submit their response to IGT's letter concerning willfulness to May 15, 2009 and for Bally's claim for a declaratory judgment of invalidity of the '983 patent be dismissed without prejudice. Signed by Judge Sue L. Robinson on 5/15/2009. (liid) (Entered: 05/15/2009)
- 05/15/2009 293 SEALED Letter to The Honorable Sue L. Robinson from Jack B. Blumenfeld regarding whether Court should preclude IGT from asserting willful infringement - re 289 Letter. (Attachments: # 1 Exhibits A-1)(Blumenfeld, Jack) (Entered: 05/15/2009)
- 05/21/2009 294 ORDER Setting Mediation Conferences: the mediation conference scheduled for May 28, 2009 at 10:00 a.m. is rescheduled to Thursday, June 4, 2009 beginning at 9:30 a.m. The due date for submissions is changed to Friday, May 29, 2009 by no later than 12:00 Noon. All other provisions of the Courts May 8, 2009 Order remain in full force and effect. Signed by Judge Mary Pat Thyng on 5/21/2009. (cak) (Entered: 05/21/2009)
- 06/02/2009 295 REDACTED VERSION of 293 Letter to Judge Robinson regarding whether Court should preclude IGT from asserting willful infringement by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibits A-1)(Blumenfeld, Jack) (Entered: 06/02/2009)
- 06/15/2009 296 MOTION for Permanent Injunction - filed by IGT. (Attachments: # 1 7.1.1 Certificate, # 2 Text of Proposed Order)(Gaza, Anne) (Entered: 06/15/2009)
- 06/15/2009 297 SEALED OPENING BRIEF in Support re 296 MOTION for Permanent Injunction filed by IGT. Answering Brief/Response due date per Local Rules is 7/2/2009. (Gaza, Anne) (Entered: 06/15/2009)
- 06/15/2009 298 SEALED DECLARATION re 296 MOTION for Permanent Injunction (DECLARATION OF RICHARD J. SCHNEIDER) by IGT. (Gaza, Anne) (Entered: 06/15/2009)
- 06/15/2009 299 SEALED DECLARATION re 296 MOTION for Permanent Injunction (DECLARATION OF DAVID P. DALKE) by IGT. (Gaza, Anne) (Entered: 06/15/2009)
- 06/19/2009 300 NOTICE OF SERVICE of 1) Document Requests Relating to the Factual Assertions Set Forth in IGT's Motion for a Permanent Injunction; 2) Interrogatory Relating to the Factual Assertions Set Forth in IGT's Motion for a Permanent Injunction; and 3) Requests for Admission Relating to IGT's Motion for a Permanent Injunction by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc..(Blumenfeld, Jack) (Entered: 06/19/2009)
- 06/22/2009 301 REDACTED VERSION of 297 Opening Brief in Support of IGT's Motion for a Permanent Injunction by IGT. (Gaza, Anne) (Entered: 06/22/2009)
- 06/22/2009 302 REDACTED VERSION of 299 Declaration of David P. Dalke in Support of IGT's Motion for Permanent Injunction by IGT. (Attachments: # 1 Exhibit 10-19, # 2 Exhibit 20, # 3 Exhibit 21-22, # 4 Exhibit 23, # 5 Certificate of Compliance 24-33, # 6 Certificate of Compliance 34, # 7 Exhibit 35, # 8 Exhibit 36-37, # 9 Exhibit 38-40, # 10 Certificate of Compliance 41)(Gaza, Anne) (Entered: 06/22/2009)
- 06/22/2009 303 REDACTED VERSION of 298 Declaration of Richard J. Schneider in Support of IGT's Motion for a Permanent Injunction by IGT. (Attachments: # 1 Exhibit 1-3, # 2 Exhibit 4, # 3 Certificate of Compliance 5, # 4 Certificate of Compliance 6, # 5 Certificate of Compliance 7-9)(Gaza, Anne) (Entered: 06/22/2009)
- 06/26/2009 304 Joint STIPULATION regarding discovery and briefing re 296 MOTION for Permanent Injunction by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Blumenfeld, Jack) (Entered: 06/26/2009)

- 06/30/2009 -- SO ORDERED- re 304 Joint STIPULATION regarding discovery and briefing re 296 MOTION for Permanent Injunction. Set Briefing Schedule: re 296 MOTION for Permanent Injunction. (Answering Brief due 7/27/2009.). Signed by Judge Sue L. Robinson on 6/30/2009. (lid) (Entered: 06/30/2009)
- 07/20/2009 305 NOTICE OF SERVICE of Plaintiff IGT's Responses and Objections to Bally's Interrogatory Relating to Factual Assertions Set Forth in IGT's Motion for a Permanent Injunction by IGT.(Gaza, Anne) (Entered: 07/20/2009)
- 07/20/2009 306 NOTICE OF SERVICE of Plaintiff IGT's Responses and Objections to Bally's Document Requests Relating to Factual Assertions Set Forth in IGT's Motion for a Permanent Injunction by IGT.(Gaza, Anne) (Entered: 07/20/2009)
- 07/20/2009 307 NOTICE OF SERVICE of Plaintiff IGT's Responses and Objections to Bally's Requests for Admission Relating to Factual Assertions Set Forth in IGT's Motion for a Permanent Injunction by IGT.(Gaza, Anne) (Entered: 07/20/2009)
- 07/22/2009 308 STIPULATION Regarding Submission of New Briefing Schedule by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Blumenfeld, Jack) (Entered: 07/22/2009)
- 07/27/2009 -- SO ORDERED- re 308 STIPULATION Regarding Submission of New Briefing Schedule. Signed by Judge Sue L. Robinson on 7/27/2009. (lid) (Entered: 07/27/2009)
- 08/04/2009 309 STIPULATION TO EXTEND TIME FOR PERMANENT INJUNCTION ANSWERING AND REPLY BRIEFS TO ANSWERING - SEPTEMBER 18, 2009 and REPLY - OCTOBER 2, 2009 - filed by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Blumenfeld, Jack) (Entered: 08/04/2009)
- 08/06/2009 -- SO ORDERED- re 309 STIPULATION TO EXTEND TIME. Set Briefing Schedule: re 296 MOTION for Permanent Injunction. (Answering Brief due 9/18/2009., Reply Brief due 10/2/2009.). Signed by Judge Sue L. Robinson on 8/5/2009. (lid) (Entered: 08/06/2009)
- 09/18/2009 310 STIPULATION TO EXTEND TIME for Permanent Injunction Answering and Reply Briefs to September 25, 2009 (Answering) and October 16, 2009 (Reply) - filed by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Tigan, Jeremy) (Entered: 09/18/2009)
- 09/22/2009 -- SO ORDERED- re 310 STIPULATION TO EXTEND TIME. Set Briefing Schedule: re 296 MOTION for Permanent Injunction. (Answering Brief due 9/25/2009., Reply Brief due 10/16/2009.). Signed by Judge Sue L. Robinson on 9/21/2009. (lid) (Entered: 09/22/2009)
- 09/25/2009 311 STIPULATION TO EXTEND TIME to file answering and reply briefs in connection with IGT's Motion for a Permanent Injunction to September 29, 2009 (answering) and October 20, 2009 (reply) - filed by IGT, Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Tigan, Jeremy) (Entered: 09/25/2009)
- 09/29/2009 -- SO ORDERED- re 311 STIPULATION TO EXTEND TIME. Set Briefing Schedule: re 296 MOTION for Permanent Injunction. (Answering Brief due 9/29/2009., Reply Brief due 10/20/2009.). Signed by Judge Sue L. Robinson on 9/29/2009. (lid) (Entered: 09/29/2009)
- 09/29/2009 312 MOTION to Strike the Declaration of Richard J. Schneider Offered in Support of IGT's Motion for a Permanent Injunction - filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Blumenfeld, Jack) (Entered: 09/29/2009)
- 09/29/2009 313 SEALED OPENING BRIEF in Support re 312 MOTION to Strike the Declaration of Richard J. Schneider Offered in Support of IGT's Motion for a Permanent Injunction filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. Answering Brief/Response due date per Local Rules is 10/19/2009. (Attachments: # 1 Exhibits A-B)(Blumenfeld, Jack) (Entered: 09/29/2009)
- 09/29/2009 314 SEALED ANSWERING BRIEF in Opposition re 296 MOTION for Permanent Injunction filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. Reply Brief due date per Local Rules is 10/9/2009. (Blumenfeld, Jack) (Entered: 09/29/2009)
- 09/29/2009 315 SEALED DECLARATION re 314 Answering Brief in Opposition to IGT's Motion for a Permanent Injunction (Declaration of Edward J. DeFranco) by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibits 1-14)(Blumenfeld, Jack) (Entered: 09/29/2009)
- 09/29/2009 316 SEALED DECLARATION re 314 Answering Brief in Opposition to IGT's Motion for a Permanent Injunction (Declaration of Robert Randel) by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Blumenfeld, Jack) (Entered: 09/29/2009)
- 09/29/2009 317 SEALED DECLARATION re 314 Answering Brief in Opposition to IGT's Motion for a Permanent Injunction (Declaration of Paul Tjoumakaris) by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Blumenfeld, Jack) (Entered: 09/29/2009)
- 09/29/2009 318 SEALED DECLARATION re 314 Answering Brief in Opposition to IGT's Motion for a Permanent Injunction (Declaration of Kerry Smith) by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Blumenfeld, Jack) (Entered: 09/29/2009)

- 09/29/2009 319 SEALED DECLARATION re 314 Answering Brief in Opposition to IGT's Motion for a Permanent Injunction (Declaration of Michael Ray) by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Blumenfeld, Jack) (Entered: 09/29/2009)
- 09/29/2009 320 SEALED DECLARATION re 314 Answering Brief in Opposition to IGT's Motion for a Permanent Injunction (Declaration of Frank Silvestro) by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Blumenfeld, Jack) (Entered: 09/29/2009)
- 09/29/2009 321 SEALED DECLARATION re 314 Answering Brief in Opposition to IGT's Motion for a Permanent Injunction (Declaration of Sean Bybee) by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibits 1-35)(Blumenfeld, Jack) (Entered: 09/29/2009)
- 09/29/2009 322 SEALED DECLARATION re 314 Answering Brief in Opposition to IGT's Motion for a Permanent Injunction (Declaration of James Slattery) by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibits 1-5)(Blumenfeld, Jack) (Entered: 09/29/2009)
- 09/29/2009 323 SEALED DECLARATION re 314 Answering Brief in Opposition to IGT's Motion for a Permanent Injunction (Declaration of Derik Mooberry) by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibits 1-3)(Blumenfeld, Jack) (Entered: 09/29/2009)
- 09/29/2009 324 SEALED DECLARATION re 314 Answering Brief in Opposition to IGT's Motion for a Permanent Injunction (Declaration of Thomas A. Reilly) by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibits 1-4)(Blumenfeld, Jack) (Entered: 09/29/2009)
- 10/02/2009 325 REDACTED VERSION of 314 Answering Brief in Opposition Defendants' Answering Brief in Opposition to Plaintiff IGT's Motion for a Permanent Injunction by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Tigan, Jeremy) (Entered: 10/02/2009)
- 10/02/2009 326 REDACTED VERSION of 315 Declaration, of Edward J. DeFranco in Support of Bally's Answering Brief in Opposition to Plaintiff IGT's Motion for a Permanent Injunction by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibit [SEALED] Exhibits 1-14)(Tigan, Jeremy) (Entered: 10/02/2009)
- 10/02/2009 327 REDACTED VERSION of 316 Declaration of Robert Randel in Support of Bally's Opposition to IGT's Motion for a Permanent Injunction by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Tigan, Jeremy) (Entered: 10/02/2009)
- 10/02/2009 328 REDACTED VERSION of 317 Declaration of Paul Tjoumakian (Borgata Hotel and Casino) by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Tigan, Jeremy) (Entered: 10/02/2009)
- 10/02/2009 329 REDACTED VERSION of 318 Declaration of Kerry Smith (Lincoln Park Racino) by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Tigan, Jeremy) (Entered: 10/02/2009)
- 10/02/2009 330 REDACTED VERSION of 319 Declaration of Michael Ray (Mount Airy Casino Report) by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Tigan, Jeremy) (Entered: 10/02/2009)
- 10/02/2009 331 REDACTED VERSION of 320 Declaration of Frank Silvestro in Support of Bally's Opposition to IGT's Motion for a Permanent Injunction by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Tigan, Jeremy) (Entered: 10/02/2009)
- 10/02/2009 332 REDACTED VERSION of 321 Declaration, of Sean Bybee in Support of Bally's Opposition to IGT's Motion for a Permanent Injunction by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibit [SEALED] Exhibits 1-35)(Tigan, Jeremy) (Entered: 10/02/2009)
- 10/02/2009 333 REDACTED VERSION of 322 Declaration, of James Slattery in Support of Bally's Opposition to IGT's Motion for a Permanent Injunction by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibit [SEALED] Exhibits 1-5)(Tigan, Jeremy) (Entered: 10/02/2009)
- 10/02/2009 334 REDACTED VERSION of 323 Declaration, of Derik Mooberry in Support of Bally's Opposition to IGT's Motion for a Permanent Injunction by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibit [SEALED] Exhibits 1-3)(Tigan, Jeremy) (Entered: 10/02/2009)
- 10/02/2009 335 REDACTED VERSION of 324 Declaration, of Thomas A. Reilly in Support of Bally's Opposition to IGT's Motion for a Permanent Injunction by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibit [SEALED] Exhibits 1-4)(Tigan, Jeremy) (Entered: 10/02/2009)
- 10/06/2009 336 REDACTED VERSION of 313 Opening Brief in Support, 312 MOTION to Strike the Declaration of Richard J. Schneider Offered in Support of IGT's Motion for a Permanent Injunction by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibits A-B)(Tigan, Jeremy) (Entered: 10/06/2009)

- 10/16/2009 337 STIPULATION TO EXTEND TIME Plaintiff's answering brief in opposition to defendants' motion to strike; and Plaintiff's reply brief re: motion for permanent injunction to October 27, 2009 - filed by IGT. (Wade, William) (Entered: 10/16/2009)
- 10/21/2009 -- SO ORDERED- re 337 STIPULATION TO EXTEND TIME. Set Briefing Schedule: re 312 MOTION to Strike the Declaration of Richard J. Schneider Offered in Support of IGT's Motion for a Permanent Injunction . (Answering Brief due 10/27/2009., Reply Brief due 10/27/2009.). Signed by Judge Sue L. Robinson on 10/21/2009. (lid) (Entered: 10/21/2009)
- 10/27/2009 338 SEALED ANSWERING BRIEF in Opposition re 312 MOTION to Strike the Declaration of Richard J. Schneider Offered in Support of IGT's Motion for a Permanent Injunction filed by IGT. Reply Brief due date per Local Rules is 11/6/2009. (Wade, William) (Entered: 10/27/2009)
- 10/27/2009 339 SEALED REPLY BRIEF re 296 MOTION for Permanent Injunction filed by IGT. (Wade, William) (Entered: 10/27/2009)
- 10/27/2009 340 SEALED DECLARATION re 339 Reply Brief (DECLARATION OF DAVID P. DALKE IN SUPPORT OF IGT'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR A PERMANENT INJUNCTION) by IGT. (Wade, William) (Entered: 10/27/2009)
- 10/30/2009 341 Letter to Hon. Sue L. Robinson from Jack B. Blumenfeld regarding request oral argument. (Blumenfeld, Jack) (Entered: 10/30/2009)
- 10/30/2009 342 REDACTED VERSION of 338 Answering Brief in Opposition, by IGT. (Gaza, Anne) (Entered: 10/30/2009)
- 10/30/2009 343 REDACTED VERSION of 339 Reply Brief by IGT. (Gaza, Anne) (Entered: 10/30/2009)
- 10/30/2009 344 REDACTED VERSION of 340 Declaration by IGT. (Attachments: # 1 Exhibit 42 - 51)(Gaza, Anne) (Entered: 10/30/2009)
- 10/30/2009 345 REQUEST for Oral Argument by IGT re 296 MOTION for Permanent Injunction. (Gaza, Anne) (Entered: 10/30/2009)
- 11/06/2009 346 NOTICE of WITHDRAWAL OF COUNSEL (JP Cody of Bally Technologies, Inc. as counsel for Defendants) by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc. (Blumenfeld, Jack) (Entered: 11/06/2009)
- 11/06/2009 347 NOTICE requesting Clerk to remove R. Tullose Delk as co-counsel. Reason for request: no longer affiliated with Quinn Emanuel Urquhart Oliver & Hedges, LLP. (Blumenfeld, Jack) (Entered: 11/06/2009)
- 11/06/2009 348 SEALED REPLY BRIEF re 312 MOTION to Strike the Declaration of Richard J. Schneider Offered in Support of IGT's Motion for a Permanent Injunction filed by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Tigan, Jeremy) (Entered: 11/06/2009)
- 11/06/2009 349 SEALED DECLARATION re 348 Reply Brief, in Support of Motion to Strike the Declaration of Richard J. Schneider (of Alexander Rudis) by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibit 1)(Tigan, Jeremy) (Entered: 11/06/2009)
- 11/13/2009 350 REDACTED VERSION of 348 Reply Brief, in Support of Defendants' Motion to Strike the Declaration of Richard J. Schneider by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Tigan, Jeremy) (Entered: 11/13/2009)
- 11/13/2009 351 REDACTED VERSION of 349 Declaration, of Alexander Rudis in Support of Bally's Reply Brief in Support of Their motion to Strike the Declaration of Richard J. Schneider by Bally Gaming International Inc., Bally Technologies Inc., Bally Gaming Inc.. (Attachments: # 1 Exhibit 1)(Tigan, Jeremy) (Entered: 11/13/2009)
- 12/22/2009 352 MEMORANDUM OPINION. Signed by Judge Sue L. Robinson on 12/22/2009. (nmf) (Entered: 12/22/2009)
- 12/22/2009 353 ORDER denying 296 MOTION for Permanent Injunction, denying as moot 312 MOTION to Strike the Declaration of Richard J. Schneider Offered in Support of IGT's Motion for a Permanent Injunction . Signed by Judge Sue L. Robinson on 12/22/2009. (nmf) (Entered: 12/22/2009)
- 02/23/2010 354 NOTICE of Request for Judicial Notice by IGT (Attachments: # 1 Exhibit A-B)(Gaza, Anne) (Entered: 02/23/2010)
- 02/23/2010 355 MOTION to Dismiss Based upon Plaintiff IGT's Renewed Motion To Dismiss Bally's Non-Patent Counterclaims IV, V and VI, or In the Alternative, To Enter A Scheduling Order to Adjudicate Patent Damages - filed by IGT. (Attachments: # 1 Text of Proposed Order)(Gaza, Anne) (Entered: 02/23/2010)
- 02/23/2010 356 OPENING BRIEF in Support re 355 MOTION to Dismiss Based upon Plaintiff IGT's Renewed Motion To Dismiss Bally's Non-Patent Counterclaims IV, V and VI, or In the Alternative, To Enter A Scheduling Order to Adjudicate Patent Damages filed by IGT. Answering Brief/Response due date per Local Rules is 3/12/2010. (Attachments: # 1 Exhibit A-B)(Gaza, Anne) (Entered: 02/23/2010)
- 02/24/2010 357 Letter to The Honorable Sue L. Robinson from Anne Shea Gaza regarding enclosing electronic, text searchable disc of D.I. Nos. 354, 355 and 356 - re 355 MOTION to Dismiss Based upon Plaintiff IGT's Renewed Motion To Dismiss Bally's Non-Patent Counterclaims IV, V and VI, or In the Alternative, To Enter A Scheduling Order to Adjudicate Patent Damages, 354 Notice

(Other), 356 Opening Brief in Support,. (Gaza, Anne) (Entered: 02/24/2010)

03/06/2010 358 STIPULATION TO EXTEND TIME for defendants to file their answering brief in opposition to IGT's renewed motion to dismiss to March 19, 2010 - filed by Bally Gaming Inc., Bally Gaming International Inc., Bally Technologies Inc., IGT. (Louden, Karen) (Entered: 03/06/2010)

03/09/2010 -- SO ORDERED- re 358 STIPULATION TO EXTEND TIME. Set Briefing Schedule: re 355 MOTION to Dismiss. (Answering Brief due 3/19/2010.). Signed by Judge Sue L. Robinson on 3/9/2010. (lid) (Entered: 03/09/2010)

03/18/2010 359 NOTICE OF FIRM NAME CHANGE (Quinn Emanuel Urquhart Oliver & Hedges, LLP is now known as Quinn Emanuel Urquhart & Sullivan, LLP) by Bally Gaming Inc., Bally Gaming International Inc., Bally Technologies Inc. (Blumenfeld, Jack) (Entered: 03/18/2010)

03/19/2010 360 SEALED ANSWERING BRIEF in Opposition re 355 MOTION to Dismiss Based upon Plaintiff IGT's Renewed Motion To Dismiss Bally's Non-Patent Counterclaims IV, V and VI, or In the Alternative, To Enter A Scheduling Order to Adjudicate Patent Damages Defendants' Answering Brief In Opposition To Plaintiff's Renewed Motion To Dismiss Bally's Non-Patent Counterclaims IV, V And VI, Or, In The Alternative, To Enter A Scheduling Order To Adjudicate Patent Damages filed by Bally Gaming Inc.(a Nevada corporation), Bally Gaming International Inc.(a Delaware corporation), Bally Technologies Inc..Reply Brief due date per Local Rules is 3/29/2010. (Attachments: # 1 Exhibit A-H)(Louden, Karen) (Entered: 03/19/2010)

03/29/2010 361 REPLY BRIEF re 355 MOTION to Dismiss Based upon Plaintiff IGT's Renewed Motion To Dismiss Bally's Non-Patent Counterclaims IV, V and VI, or In the Alternative, To Enter A Scheduling Order to Adjudicate Patent Damages filed by IGT. (Gaza, Anne) (Entered: 03/29/2010)

03/29/2010 362 NOTICE of Request For Judicial Notice in Support of Plaintiff IGT's Reply Brief In Support Of Its Renewed Motion To Dismiss Bally's Non-Patent Counterclaims IV, V and VI, Or In The Alternative, To Enter A Scheduling Order To Adjudicate Patent Damages by IGT re 361 Reply Brief, (Attachments: # 1 Exhibit A - B)(Gaza, Anne) (Entered: 03/29/2010)

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US District Court Civil Docket**U.S. District - Nevada
(Las Vegas)****2:97cv1383****Mikohn Gaming Corporation v. Acres Gaming, Inc****This case was retrieved from the court on Monday, April 12, 2010**

Date Filed: 10/02/1997
Assigned To: Evan J Wallach
Referred To: Magistrate Judge Lawrence R Leavitt
Nature of suit: Patent (830)
Cause: 28 USC 220
Lead Docket: None
Other Docket: None
Jurisdiction: Federal Question

Class Code: CLOSED
Closed: Yes
Statute:
Jury Demand: Defendant
Demand Amount: \$0
NOS Description: Patent

Litigants

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Plaintiff

Acres Gaming, Inc
Defendant

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(702) 699-7500
Fax: (702) 699-7555
Email: Fedct@juww.com

Date	#	Proceeding Text
10/10/2000	419	ORDER SEE HARD DOCKET SHEET FOR DOCKET ENTRIES 1 - 4180PINION/ORDER(EJW) ORD Ds mtn to stay pending completn of reissue applications is denied. (Cps dst) (Entered: 02/10/2003)
10/18/2000	422	DECLARATION of William K. Bertram, PH.D. obo D Acres Gaming. (fed ex) (Entered: 02/10/2003)
10/18/2000	423	CERTIFICATE OF SERVICE re #420, #421, 422 & 423 by fed ex on 10/17/00 obo D Acres Gaming. (Entered: 02/10/2003)
10/24/2000	425	ORDER OPINION (EJW) ORD that the Mag's ord (#396) ia affirmed. (EOD 10/24/00) (Entered: 02/10/2003)
10/24/2000	426	ORDER (EJW) ORD re #414 (See doc for spfcfs) (Cps dst) (EOD 10/25/00) (Entered: 02/10/2003)
12/28/2000	427	ORDER (EJW) ORD that Casino Data Systems lettr of 12/21/00 re exhibit numbers is granted; ORD that a jnt trl shall be held 3/14 - 30/01 @ 10am in Lv, NV; FUR ORD that the time for trl shall not be ext & it is FUR ORD that the crt's revious oral ord that (Entered: 02/10/2003)
01/03/2001	428	DESIGNATION OF LOCAL COUNSEL (LSW/jr) obo Eric R. Olsen as lcl cnsl for D Acres Gaming. (Cps dst) (Entered: 02/10/2003)
01/11/2001	430	ORDER OPINION(EJW) ORD re #149 is denied. (Cps dst) (EOD 1/16/01) (Entered: 02/10/2003)
01/11/2001	429	ORDER (EJW) ORD that Mtn #149 is deined. (Cps dst) (EOD 1/16/01) (Entered: 02/10/2003)
01/20/2001	434	MISCELLANEOUS HEARING (EJW) (C/Rcdr Michelle Lindi) ORD that cnsl will meet w/trt the Crt in NY on 2/21/01 & 2/22/01 @ 10am. (Cps dst) (Entered: 02/10/2003)
01/22/2001	431	NOTICE (OTHER) of change of firm name re Ps cnsl Schreck Brignone Godfrey (m) (Entered: 02/10/2003)
01/23/2001	446	CERTIFICATE OF SERVICE and recpt of copy re prttr order to all parties obo D Acres. (Entered: 02/10/2003)
01/24/2001	432	NOTICE OF HEARING on 1/29/01 @ 12:30pm by telephone (Cps dst) (Entered: 02/10/2003)
01/25/2001	447	MISCELLANEOUS DOCUMENT CITATION OF SUPPLEMENTAL AUTHORITY to its mtn for s/j of non-infringement obo Ds CDS & Sunset Hotel & Casino. (m) resp #433 (Entered: 02/10/2003)
01/29/2001	433	RESPONSE TO MOTION to CDS's citation of supplmntl authority to its mtn for s/j of non-infringement obo D Acres. (Entered: 02/10/2003)
02/05/2001	435	JURY INSTRUCTIONS w/out cites obo D Acres. (m) (FLD SEP DUE TO SIZE) (Entered: 02/10/2003)
02/05/2001	436	JURY INSTRUCTIONS with Cites obo D Acres. (m) (FLD SEP DUE TO SIZE) (Entered: 02/10/2003)
02/05/2001	437	JURY INSTRUCTIONS obo P (m) (FLD SEP DUE TO SIZE) (Entered: 02/10/2003)
02/06/2001	438	CERTIFICATE OF SERVICE re #435 & #436 by mail on parties obo D Acres Gaming. (Entered: 02/10/2003)
02/07/2001	439	PRETRIAL NOTICE ORDER (EJW) ORD that trl is sched 3/14/01 @ 10am w/j/instructns due 2/5/01. (Cps dst) (FLD SEP DUE TO SIZE) (Entered: 02/10/2003)

02/07/2001 440 CERTIFICATE OF SERVICE re #437 by fed ex and roc'd to the parties obo P (Entered: 02/10/2003)

02/16/2001 441 JURY INSTRUCTIONS obo D Acres Gaming, Inc. (m) (Entered: 02/10/2003)

02/20/2001 442 JURY INSTRUCTIONS AMENDED obo Ds CDS & Sunset Station Hotel & Casino. (m) (Entered: 02/10/2003)

02/27/2001 443 RESPONSE IN OPPOSITION TO MOTION to mtn in lim re CDS's exprt Leroy A. Prohofsky (# (Entered: 02/10/2003)

03/02/2001 444 TRIAL BRIEF obo D. (m) (Entered: 02/10/2003)

03/02/2001 445 MOTION IN LIMINE re prosecution history estoppel obo P. (m)(DISPO: oppo #451, reply #460 (Entered: 02/10/2003)

03/02/2001 450 MOTION IN LIMINE re J/Instrutns concerning SEC regulations obo Mikohn Gaming Corporation. (m)(DISPO:oppo #453 (Entered: 02/10/2003)

03/02/2001 449 MOTION FOR MISCELLANEOUS RELIEF in Lim re hypothetical claims obo Mikohn Gaming Corporation. (m)(DISPO: (Entered: 02/10/2003)

03/02/2001 448 TRIAL BRIEF obo P Mikohn Gaming (m/f) (Entered: 02/10/2003)

03/07/2001 451 RESPONSE IN OPPOSITION TO MOTION to Mikohns mtn in lim re prosecution history estoppel (#445) obo Acres Gaming, Inc. (m) (Entered: 02/10/2003)

03/07/2001 452 RESPONSE IN OPPOSITION TO MOTION to Mikohn's mtn in lim re hypothetical claims (#447) obo Acres Gaming. (m) (Entered: 02/10/2003)

03/07/2001 453 RESPONSE IN OPPOSITION TO MOTION to Mikohn's mtn in lim re j/instructions concerning SEC regulations (#450) obo Acres Gaming, Inc. (Entered: 02/10/2003)

03/08/2001 454 NOTICE TO TAKE DEPOSITION AMENDED of Jose Vegas on 1/25/99; Ali Saffari on 1/7/99; Neil Spencer on 3/30/00; Elizabeth Borchard on 8/31/98; Lyle L. Bell on 7/22/99 obo Ds CDS & Sunset Stations. (m) (Entered: 02/10/2003)

03/09/2001 456 NOTICE TO TAKE DEPOSITION AMENDED of Robert Galvin on 7/21/99 obo Ds CDS & Sunset Hotel. (m) (Entered: 02/10/2003)

03/09/2001 457 NOTICE TO TAKE DEPOSITION AMENDED of Treasure Island through Tracy J. Wormdahl on 7/13/99 obo Ds CDS & Sunset Station Hotel & Casino. (m) (Entered: 02/10/2003)

03/09/2001 459 NOTICE TO TAKE DEPOSITION (AMENDED) of Girard P. Miller on 8/21/98 obo Ds CDS & Sunset Hotel & Casino. (m) (Entered: 02/10/2003)

03/09/2001 455 NOTICE TO TAKE DEPOSITION (AMENDED) of Mary Ann Wismer on 2/25/99 obo Ds CDS. (m) (Entered: 02/10/2003)

03/09/2001 458 NOTICE TO TAKE DEPOSITION AMENDED of Neil Spencer on 6/22/01 obo Ds CDS & Sunset Hotel. (m) (Entered: 02/10/2003)

03/09/2001 461 PROPOSED VOIR DIRE obo CDS (m) (Entered: 02/10/2003)

03/09/2001 460 REPLY TO RESPONSE TO MOTION to mtn/lim re prosecution history estoppel #445 obo Ds CDS & Sunset Station Hotel & Casino. (m) (Entered: 02/10/2003)

03/12/2001 462 MOTION FOR MISCELLANEOUS RELIEF for separate trl purs to FRCP 42(b) obo Acres Gaming. (m)(DISPO: (Entered: 02/10/2003)

03/12/2001 463 MISCELLANEOUS DOCUMENT Cert/Facsimile & recpt of copy re mtn for separate trl obo Acres. (m) (Entered: 02/10/2003)

03/13/2001 -- MISCELLANEOUS DOCUMENT Stip/ord of disml -- to EJW (Entered: 02/10/2003)

03/13/2001 464 TRANSCRIPT of hearing 3/9/01 re pretrial matters. (Entered: 02/10/2003)

03/13/2001 468 REPLY TO RESPONSE TO MOTION to Acres supplmntl brf re reconfiguration commands obo Mikohn. (m) (Entered: 02/10/2003)

03/13/2001 465 OBJECTION TO REPORT AND RECOMMENDATIONS to Acres Trial Exhibits obo Ds CDS & Sunset Hotel & Casino. (m) (Entered: 02/10/2003)

03/13/2001 469 MISCELLANEOUS HEARING DATED 3/9/01(EJW) (C/Rcdr Erica Davis) ORD (see ord for spfcfs) (Cps dst) (Entered: 02/10/2003)

03/13/2001 466 REPLY TO RESPONSE TO MOTION to Acres supplmntl brf re "responsive" obo Mikohn Gaming Corp. (m) (Entered: 02/10/2003)

03/13/2001 467 RESPONSE TO MOTION to Acres resp re prosecutn history estoppel obo Mikohn. (m) (Entered: 02/10/2003)

03/14/2001 470 ORDER ON STIPULATION (EJW) ORD that P Acres Gaming, Inc & D Sunset Station Hotel & Casino agree and stipulate to the disml, w/prej, of all claims between them in this actn. Acres & Sunset Station shall each bear their own costs & fees incurred in this (Entered: 02/10/2003)

03/14/2001 471 ORDER ON STIPULATION (EJW) ORD that all claims & cntclms between Acres & CDS be dism w/prej. Acres & CDS shall bear their own costs & feed incurred in this case. (Cps dst) (Entered: 02/10/2003)

03/15/2001 472 TRANSCRIPT (DAY 1 - dated 3/14/01) bef EJW. (C/Rptr Lucille M. Litsheim) (FLD SEP) (Entered: 02/10/2003)

03/16/2001 474 JURY TRIAL - HELD (EJW)(DAY 2 - Dated 3/15/01) (C/Rptr Lucille Litsheim & Felicia Rene Zabin) ORD that crt is recessed to 3/16/01 @ 9am. (Cps dst) (Entered: 02/10/2003)

03/16/2001 473 JURY TRIAL - HELD (EJW)(DAY 1 - Dated 3/14/01) (C/Rptr Lucille Litsheim & Felicia Rene Zabin) ORD that CDS must be contacted bef any of its confidential materials used @ tri. The crt signs on the rec the stip/ord od disml re CDS. FUR ORD that the mt (Entered: 02/10/2003)

03/16/2001 475 TRANSCRIPT DAY 2 - dated 3/15/01 bef EJW (C/Rptr Lucille Litsheim) (FLD SEP) (Entered: 02/10/2003)

03/19/2001 479 MOTION FOR MISCELLANEOUS RELIEF for directed verdict & for judgmt as a matter of law obo P Mikohn. (m)(DISPO: GRANTED PER #478 (Entered: 02/10/2003)

03/19/2001 476 TRANSCRIPT (DAY 3 - Dated 3/16/01)(C/Rptr Lucille Litsheim) bef EJW (Entered: 02/10/2003)

03/19/2001 -- MISCELLANEOUS DOCUMENT Acres proposed special verdict form -- to EJW (Entered: 02/10/2003)

03/19/2001 -- MISCELLANEOUS DOCUMENT Mikohn's special verdict -- to EJW (Entered: 02/10/2003)

03/20/2001 482 MOTION FOR MISCELLANEOUS RELIEF to exclude software that Mikohn Gaming Corp first prod on the 3rd day of tri obo Acres. (m) (FLD SEP)(DISPO: (Entered: 02/10/2003)

03/20/2001 480 ORDER (LRL) ORD that re privilege log docs (see doc for spcfcs) (Cps dst) (Entered: 02/10/2003)

03/20/2001 477 JURY TRIAL - HELD (EJW) (DAY 3 - Dated 3/16/01) (C/Rptr Lucille Litsheim & Felicia Rene Zabin) ORD that Crt is recessed to 3/19/01 @ 9am. (Cps dst) (Entered: 02/10/2003)

03/20/2001 -- MISCELLANEOUS DOCUMENT Acres prop special verdict form (Amended) -- to EJW (Entered: 02/10/2003)

03/20/2001 481 TRANSCRIPT (DAY 4 - Dated 3/19/01) (C/Rptr Lucille Litsheim and Felicia Zabin) bef EJW (FLD SEP) (Entered: 02/10/2003)

03/20/2001 -- MISCELLANEOUS DOCUMENT Prop ord granting Acres Gaming Inc.'s Mtn to exclude software that Mikohn Gaming Corp first produced on the Third Day of Trial -- to EJW (Entered: 02/10/2003)

03/20/2001 478 JURY TRIAL - HELD (EJW)(DAY 4 - Dated 3/19/01) (C/Rptr Lucille Litsheim & Felicia Rene Zabin) ORD that the 822 actn is dism w/prej. FUR ORD that Mikohn's mtn for directed verdict as to the 882 patent is granted. The mtn as to the 961 patent is denied. (Entered: 02/10/2003)

03/21/2001 483 TRANSCRIPT (DAY 5 - Dated 3/20/01) (C/Rptr Lucille Litsheim and Felicia Zabin) bef EJW (FLD SEP) (Entered: 02/10/2003)

03/22/2001 486 MISCELLANEOUS DOCUMENT re outstanding issues re j/instructions obo Mikohn Gaming. (Entered: 02/10/2003)

03/22/2001 485 JURY TRIAL - HELD (EJW)(DAY 6 - Dated 3/21/01) (C/Rptr Lucille Litsheim and Felicia Zabin) ORD that crt is recessed til 3/22/01 @ 9am. (Cps dst) (Entered: 02/10/2003)

03/22/2001 487 TRANSCRIPT (DAY 6 - DATED 3/21/01)(C/Rptr Lucille Litsheim and Felicia Zabin) bef EJW (FLD SEP) Volume 6 (Entered: 02/10/2003)

03/22/2001 484 JURY TRIAL - HELD (EJW) (DAY 5 - Dated 3/20/01) (C/Rptr Lucille Litsheim and Felicia Rene Zabin) ORD that Mikohn has to 3/21/01 to resp to Mtn (#482). Crt is recessed to 3/21/01 @ 9:30am. (Cps dst) (Entered: 02/10/2003)

03/22/2001 -- MISCELLANEOUS DOCUMENT Acres prop special verdict form (Second Amendmnt) -- to KJD (Entered: 02/10/2003)

03/22/2001 -- MISCELLANEOUS DOCUMENT Acres prop language for the jury re w/drawal of the "459" patent -- to KJD (Entered: 02/10/2003)

03/23/2001 488 MOTION FOR MISCELLANEOUS RELIEF for judgmt as a matter of law on the validity of the '817, '459 & '882 patents obo Acres Gaming Inc. (DISPO: (Entered: 02/10/2003)

03/23/2001 492 MOTION FOR MISCELLANEOUS RELIEF for directed verdict & for judgmt as a matter of law obo Mikohn. (DISPO: (Entered: 02/10/2003)

03/23/2001 489 MEMORANDUM re j/instructn concerning '817 patent obo Mikohn Gaming (Entered: 02/10/2003)

03/23/2001 491 RESPONSE TO MOTION to mtn re outstanding issues re: j/instructions by Mikohn obo Acres Gaming. (FLD SEP) (Entered: 02/10/2003)

03/23/2001 490 OBJECTION TO REPORT AND RECOMMENDATIONS to prop j/instructns obo Mikohn Gaming (Entered: 02/10/2003)

03/23/2001 493 TRANSCRIPT (DAY 7 - DATED 3/22/01) (C/Rptr Lucille Litschheim and Felicia Zabin) bef EJW (FLD SEP) Volume 7 (Entered: 02/10/2003)

03/26/2001 500 JURY INSTRUCTIONS AGREED (FLD SEP) (Entered: 02/10/2003)

03/26/2001 495 MISCELLANEOUS DOCUMENT re Burdens of proof for amendmnt-based estoppel under festo obo Acres Gaming Inc. (Entered: 02/10/2003)

03/26/2001 497 RESPONSE TO MOTION (JOINT) to question posed by juror Donovan obo Acres Gaming Inc. (Entered: 02/10/2003)

03/26/2001 496 MISCELLANEOUS DOCUMENT re applicatn of the doctrine of equivalents to the term "Bonus Payout Table" obo Acres Gaming Inc. (Entered: 02/10/2003)

03/26/2001 498 MISCELLANEOUS DOCUMENT re "Bonus Payout Schedule" obo Mikohn (Entered: 02/10/2003)

03/26/2001 499 REPLY TO RESPONSE TO MOTION memorandum re propose prosecution history estoopeel instructions obo Mikohn Gaming Inc. (Entered: 02/10/2003)

03/26/2001 501 TRANSCRIPT (DAY 8 - Dated 3/23/01) (C/Rptr Lucille Litschheim and Felicia Zabin) bef EJW (FLD SEP) Volume 8 (Entered: 02/10/2003)

03/26/2001 -- MISCELLANEOUS DOCUMENT Special Verdict Form -- to EJW (Entered: 02/10/2003)

03/26/2001 494 JURY TRIAL - HELD (EJW)(DAY 7 - Dated 3/22/01) (C/Rptr Lucille Litschheim and Felicia Zabin) ORD that Acres orally renews his mtn for judgmt as a matter of law re the 459 patent infringement. FUR ORD that purs to the Ds pending mtn, judgmt as a matte (Entered: 02/10/2003)

03/27/2001 502 JURY TRIAL - HELD (EJW)(DAY 8 - DATED 3/23/01) (C/Rptr Lucille Litschheim and Felicia Zabin) ORD that Acres Gaming files in open crt mtn for judgmt as a mtter of law on the validity of the '817, '459 & '882 patents. FUR ORD that the renewed mtn for jud (Entered: 02/10/2003)

03/28/2001 505 JURY INSTRUCTIONS AGREED (FLD SEP) (Entered: 02/10/2003)

03/28/2001 506 JURY VERDICT SPECIAL VERDICT FORM - found in favor of Acres. (Entered: 02/10/2003)

03/28/2001 504 JURY TRIAL - HELD (EJW)(DAY 10 - DATED 3/27/01) (C/Rptr Felicia Zabin) ORD that Verdict is found in favor of Acres & judgmt is to be entered. Mikohn advises the crt they will be making post verdict mtms. Ps and Ds exhibit lists attached and also CDS (Entered: 02/10/2003)

03/28/2001 503 JURY TRIAL - HELD (EJW) (DAY 9 - DATED 3/26/01) (C/Rptr Lucille Litschiem and Felicia Zabin) ORD that Mikohns mtn #498 is denied due to lack of argumnt. Crt directs cnsl to subm brfs re the iss of prescutn history & the crt will sched oral argumnts. (Entered: 02/10/2003)

03/28/2001 508 TRANSCRIPT (DAY 9 - DATED 3/26/01) (C/Rptr Lucille Litschheim and Felicia Zabin) bef EJW (FLD SEP) (Entered: 02/10/2003)

03/29/2001 507 JUDGMENT (LSW/jr) ORD that the Special Verdict Form is fld. IT IS SO ORDERED AND ADJUDGED that judgmt is entered against Mikohn Gaming Corporation and in favor of Acres Gaming Inc. in the amnt of \$1,500,000.00 for damages. (Cps dst) (Entered: 02/10/2003)

04/02/2001 509 TRANSCRIPT dated 3/14/01 w/jury voir dire included (C/Rptr Lucille Litschheim and Felicia Zabin) (Entered: 02/10/2003)

04/02/2001 510 TRANSCRIPT dated 3/27/01 (C/Rptr Lucille & Felicia Zabin) (Entered: 02/10/2003)

04/09/2001 511 MOTION FOR MISCELLANEOUS RELIEF RENEWED mtn for judgmt as a matt of law obo P Mikohn. (m)(DISPO: (Entered: 02/10/2003)

04/11/2001 -- MISCELLANEOUS DOCUMENT Stip re stay of executn of judgmt entered 3/29/01 -- to EJW (Entered: 02/10/2003)

04/11/2001 -- MISCELLANEOUS DOCUMENT Stip re Acres BOC -- to KJD (Entered: 02/10/2003)

04/12/2001 512 MOTION TO DISMISS RENEWED MOTION for judgmt as a matt of law & mtn for new trial obo P Mikohn. (m)(DISPO:oppo #520, reply #530 - DENIED PER #537/544/545 (Entered: 02/10/2003)

04/12/2001 513 MOTION FOR MISCELLANEOUS RELIEF for entry of permanent injunctn re Mikohn's Moneytime system obo Acres Gaming. (m)(DISPO:oppo #522, reply #528 - GRANTED PER #537/544/545 (Entered: 02/10/2003)

04/12/2001 514 MOTION FOR MISCELLANEOUS RELIEF to amend judgmt & for an accounting of sales obo Acres Gaming, Inc. (m)(DISPO:dec #515, oppo #523, oppo #524, reply #531 - GRANTED PER #544/545 (Entered: 02/10/2003)

04/13/2001 515 DECLARATION Original declaration of Raymond S. Sims, a cpy of which had prev ben fld as Exhibit 4 to Acres Gaming, Inc.'s Mtn to amend judgmt for an award of prejudgmt Interest (#514) (Entered: 02/10/2003)

04/13/2001 516 CERTIFICATE OF SERVICE & rcpt of cpy re mtn #513 & #514 obo Acres Gaming, Inc. (Entered: 02/10/2003)

04/13/2001 517 CERTIFICATE OF SERVICE by mail on 4/13/01 to all parties obo Acres Gaming #515 (Entered: 02/10/2003)

04/18/2001 518 ORDER ON STIPULATION (EJW) ORD that the BOC to be fld by 5/2/01. (Cps dst) (Entered: 02/10/2003)

04/18/2001 519 ORDER ON STIPULATION (EJW) ORD that any EXECUTION OF JUDGMENT entered by this crt on 3/29/01 will be stayed until the earlier of 5/24/01, or the date on which this Cr rules on the mtn & renewed mtn fld by Mikohn Gaming for judgmt as a matt'r of law. (C (Entered: 02/10/2003)

04/27/2001 520 RESPONSE IN OPPOSITION TO MOTION to Mkhohn's renewed mtn for judgmt as a matter of law & Mtn for a new trial (#512) obo Acres Gaming. (m) (FLD SEP) (Entered: 02/10/2003)

04/27/2001 521 CERTIFICATE OF SERVICE by mail & recpt of copy 4/27/01 to all parties re #520 obo Acres Gaming. (Entered: 02/10/2003)

04/27/2001 522 RESPONSE IN OPPOSITION TO MOTION to Mtn for perm/injunctn (#513) obo Mikohn. (m) (Entered: 02/10/2003)

04/27/2001 523 RESPONSE IN OPPOSITION TO MOTION to Mtn for award of prejudgmnt interest (#514) obo Mikohn Gaming (m) (Entered: 02/10/2003)

04/27/2001 524 RESPONSE IN OPPOSITION TO MOTION to Mtn for accounting (#514) obo Mikohn Gaming (m) (Entered: 02/10/2003)

05/02/2001 526 BILL OF COSTS (copy) to be taxed obo Acres Gaming, Inc. (Eric Olsen) (m) (Entered: 02/10/2003)

05/02/2001 525 BILL OF COSTS (copy) to be taxed obo Acres Gaming, Inc. (Michael Broaddus) (m) (Entered: 02/10/2003)

05/02/2001 527 CERTIFICATE OF SERVICE re BOC by mail and recpt of copy obo Acres Gaming, Inc. (Entered: 02/10/2003)

05/08/2001 528 REPLY TO RESPONSE TO MOTION to Mtn #513 obo Acres Gaming Inc. (m) (Entered: 02/10/2003)

05/08/2001 530 REPLY TO RESPONSE TO MOTION to renewed mtn for judgmt (#512) obo Mikohn Gaming Corporation. (m) (Entered: 02/10/2003)

05/08/2001 531 REPLY TO RESPONSE TO MOTION to mtn to amend jdgmnt & for an accounting of sales (#514) obo Acres Gaming (Entered: 02/10/2003)

05/08/2001 529 CERTIFICATE OF SERVICE re #528 obo Acres Gaming Inc. (Entered: 02/10/2003)

05/08/2001 532 REPLY TO RESPONSE TO MOTION to mtn to amend judgmt & for an award of prejudgmnt interest (#) obo Acres gaming, Inc. (Entered: 02/10/2003)

05/21/2001 533 MOTION FOR EXTENSION OF TIME Ex Parte mtn to stay execution of jdgmnt pending ruling on postjdgmnt mtms obo P. (m/f) (DISPO: (Entered: 02/10/2003)

06/22/2001 534 NOTICE OF HEARING re accounting sched for 6/25/01 @ 12pm bef EJW. (Cps dst) (Entered: 02/10/2003)

06/25/2001 536 RESPONSE IN OPPOSITION TO MOTION to Mtn #535 obo Acres Gaming (m) (Entered: 02/10/2003)

06/25/2001 535 MOTION FOR MISCELLANEOUS RELIEF to stay execution of judgmnt pending ruling on Post-judgmnt mtms & for stay of execution pending appeal obo Mikohn Gaming. (m)(DISPO: oppo #536 (Entered: 02/10/2003)

06/26/2001 537 MISCELLANEOUS HEARING (EJW)(Crt/Rcdr Alana Kamaka) ORD that Ps mtn #512 is denied. Mtn #535 is granted. ORD that Ds Acres mtn for entry of permanent injunctn (#513) is granted. Crf finds the P will not be req to post an additnl bond on the injunctn si (Entered: 02/10/2003)

06/29/2001 -- MISCELLANEOUS DOCUMENT Stip/ORD re stay of executn of judgmnt & stay of injunctn -- to EJW (Entered: 02/10/2003)

06/29/2001 538 NOTICE OF APPEAL obo P Mikohn Gaming Corporation re judgmnt #507 (m) (FEES NOT PAID) (Entered: 02/10/2003)

07/06/2001 539 ORDER ON STIPULATION ORD that the time for posting the bond required for a cont'd stay of execution of this crts judgmnt is gmt'd. and ext'd to 7/12/01. cpsy dist. (Entered: 02/10/2003)

07/12/2001 540 CERTIFICATE OF CASH DEPOSIT of supersedeas & cost on appeal bond. obo P's. (cpy on left-hand side of file) (Entered: 02/10/2003)

07/13/2001 541 NOTICE (OTHER) NOTICE of appeal obo P (m) (Entered: 02/10/2003)

07/13/2001 550 NOTICE (OTHER) of posting bond w/the crt on 7/12/01. obo P. (m) (Entered: 02/10/2003)

07/19/2001 542 BOND SURETY BOND/SUPERCEDEAS COST BOND in the amnt of \$1,500,000.00 - in supprt of Mtn to stay execution & for appeal by Contractors Bonding & Insurance Company for Mikohn Gaming Corp. (Cps dst) (Entered: 02/10/2003)

07/20/2001 543 TRANSMITTAL of Not/Appeal (Orig to C/A) w/docketing fee notification form re no fees have been paid. This appeal is filed w/the Federal Circuit of Appeals. (Cps dst) (Entered: 02/10/2003)

08/02/2001	544	ORDER (EJW) ORD that Mikohn Gaming Corp's Renewed Mtn for judgment as a matter of law & Mtn for new trial (#512) is denied; FUR ORD that Acres Gaming Inc.'s Mtn to amend judgment & for an award of prejudgment % (#514) is granted; FUR ORD that the rate of pre (Entered: 02/10/2003)
08/02/2001	545	ORDER OPINION(EJW) See ord #544 (Cps dist) (Entered: 02/10/2003)
12/11/2001	546	MOTION FOR MISCELLANEOUS RELIEF for entry of amend judgment obo D Acres. (m) (DISPO: (Entered: 02/10/2003)
12/11/2001	547	MOTION FOR MISCELLANEOUS RELIEF for entry of entry of amend/judgment obo D Acres. (m)DISPO: confidential material in sealed room (Entered: 02/10/2003)
01/16/2002	548	NOTICE OF HEARING CALENDAR SETTING for telephonic hmg re consent decree set for 1/25/02 @10am. cps dist. (Entered: 02/10/2003)
01/22/2002	555	NOTICE (OTHER) Notice of w/drawal of mtn for entry of amd judgment obo Acres Gaming, Inc. (found loose & docketed 3/15/04. efm (Entered: 03/15/2004)
02/19/2002	549	ORDER CONSENT DECREE (see doc for specs) cps dist. (Entered: 02/10/2003)
03/06/2002	551	ORDER ON STIPULATION ORDER supersedeas and cost on appeal bond (#540) is exonerated. cps dist. (Entered: 02/10/2003)
03/07/2003	552	ORDER ORD: Prys to pick up exhibits by 4-4-03, or they will be destroyed. cps dis (Entered: 03/10/2003)
03/27/2003	553	ORDER ORD: Ds' have picked up exhibits 3-27-03. cps dis (Entered: 03/28/2003)
04/08/2003	554	ORDER ORD: Ds' exhibits destroyed 4-8-03. cps dis (Entered: 04/08/2003)

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123: CLAIMS(R)/Current Legal Status_1980-2010/Mar 30

1 PN=US 5655961

670: LitAlert_1973-2010/UD=201015

1 PN=US 5655961

TOTAL: FILES 123,670

S1 2 PN=US 5655961

? t/7/all

Dialog eLink: [Order File History](#)

1/7/1 (Item 1 from file: 123)

DIALOG(R)File 123: CLAIMS(R)/Current Legal Status

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2870898

Status Changes: • **REASSIGNED** • **REISSUE REQUESTED**

Assignee: Acres Gaming Inc (REASSIGNED)

Patent Number: **US 5655961** Issue Date: **19970812**

Reissue Request

Request Number	Request Date	O.G. Date	Examination Group	Reissue Patent No.
09/373034	19990811	19991005	3711	

Reassignment(s):

1. Recorded: 20000824

Action: SECURITY AGREEMENT

Assignor: ACRES GAMING, INCORPORATED A NEVADA CORPORATION DATE SIGNED: 07/21/2000

AGI DISTRIBUTION, INC. A NEVADA CORPORATION DATE SIGNED: 07/21/2000

Assignee: WELLS FARGO BANK MINNESOTA, NATIONAL ASSOCIATION SIXTH STREET AND MARGUETTE AVENUE MINNEAPOLIS MINNESOTA 55479

Reel: 011190

Frame: 0948

Contact: GUST ROSENFELD, PLC CAROL DAHLBERG 201 N. CENTRAL AVENUE SUITE 3300 PHOENIX, ARIZONA 85073-3300

2. Recorded: 20000824

Action: SECURITY INTEREST

Assignor: ACRES GAMING, INCORPORATED, A NEVADA CORPORATION DATE SIGNED: 07/21/2000

AGI DISTRIBUTION, INC., A NEVADA CORPORATION DATE SIGNED: 07/21/2000

Assignee: WELLS FARGO BUSINESS CREDIT, INC., A MINNESOTA CORPORATION MAC S4101-076 100 W. WASHINGTON STREET, 7TH FLOOR PHOENIX ARIZONA 85003

Reel: 011190

Frame: 0933

Contact: GUST ROSENFELD, PLC CAROL DAHLBERG 201 N. CENTRAL AVENUE SUITE 3300 PHOENIX, ARIZONA 85073-3300

3. Recorded: 20060524

Action: ASSIGNMENT OF ASSIGNORS INTEREST

Assignor: ACRES GAMING INCORPORATED, DATE SIGNED: 06/15/2006

Assignor: ACRES GAMING INCORPORATED, DATE SIGNED: 05/15/2000

Assignee: IGT, 9295 PROTOTYPE DRIVE, RENO, NEVADA, 89521-8986

Reel: 017663

Frame: 0341

Contact: BEYER WEAVER & THOMAS LLP, P.O. BOX 70250, OAKLAND, CA 94612-0250

Dialog eLink: [Order File History](#)

1/7/2 (Item 1 from file: 670)

DIALOG(R)File 670: LitAlert

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00044343

LitAlert Number: P1997-43-17

Record (Document) Type: Patent (Utility)

Patent Title: Gaming system with progressive jackpot

Patent Number (Date): US 5280909 (19940125)

Patent Assignee: Mikohn Incorporated, NV

Inventor: Tracy Daniel A, Las Vegas NV

US Class Titles (Codes): Amusement devices: games (273138000)

Court - Docket Number: Nevada - CV-S-97-01383-HDM(LRL)

Plaintiff: Mikohn Gaming Corporation

Defendant: Acres Gaming Incorporated

Filing Date: 19971002

Action Taken: A complaint was filed.

Notes: (DA)

Other Patent Numbers: US 5655961